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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	HOOPMAN et al.	)	Group Art Unit: 1722
		)	
Serial No.:	09/955,604	)	Examiner: Joseph DelSole
Confirmation No.:	1214	)	
		)	
Filed:	19 September 2001	)	
		)	
For:	TOOLS TO MANUFACTURE ABRASIVE ARTICLES		

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APPELLANTS' BRIEF ON APPEAL

Assistant Commissioner for Patents  
**Mail Stop Appeal Brief – Patents**  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Brief is presented in support of the Appeal filed herewith, from the rejection of claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 of the above-identified application under 35 U.S.C. § 102 (claims 23, 30, 31, 89, 92, 134-136, 138-143, and 145-148) and 35 U.S.C. § 103 (claims 23, 24, 31, 32, 89, 90, 92, 93, 134-136, 138-143, and 145-148), as set forth in the Office Action mailed August 26, 2003. The current claims have been twice rejected (in the Final Rejection dated July 22, 2002, followed by the Advisory Action dated October 4, 2002, and the current Office Action dated August 26, 2003).

This Brief is being submitted in triplicate, as set forth in 37 C.F.R. § 1.192(a). Appellants hereby authorize a charge to Deposit Account No. 13-4894 in the amount of \$330.00 for filing this Brief under 37 C.F.R. § 1.17(f).

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**I. REAL PARTY IN INTEREST**

The real party in interest of the above-identified patent application is the assignee, 3M Innovative Properties Company.

**II. RELATED APPEALS AND INTERFERENCES**

Appellants note that in the parent application (U.S. Patent Application Serial No. 09/520,032) a Notice of Appeal, Request for Oral Hearing, and an Appeal Brief are being filed on even date herewith.

**III. STATUS OF CLAIMS**

The claims in the present application are claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143, and 145-148. Therefore, claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 (Appendix I), reflect the pending claims from the Amendment and Response filed September 23, 2002 (Appendix VI), which are the subject of this Appeal.

**IV. STATUS OF AMENDMENTS**

This application is a continuation of Serial No. 09/520,032, filed March 6, 2000, which is a divisional application of Serial No. 09/259,488, filed February 26, 1999, issued as U.S. Patent 6,076,248 on June 20, 2000, which is a divisional application of Serial No. 08/940,267, filed September 29, 1997, issued as 6,129,540 on October 10, 2000, which is a continuation application of Serial No. 08/450,814, filed May 25, 1995, now abandoned, which is a divisional application of Serial No. 08/120,300, filed September 13, 1993, now abandoned.

A Communication (dated September 19, 2001, a copy enclosed, see Appendix II) was filed concurrently with the Request for Filing a Continuation Application Under Rule §1.53(b). A first Office Action (dated January 30, 2002, a copy enclosed, see Appendix III) was received, in which claims 56, 57, 63, 64, 113, 114, and 149-153 were withdrawn from consideration in response to a Restriction Requirement by the Examiner. Claims 133, 137, and

144 were objected to under 37 U.S.C. § 1.75, claims 23, 30, 31, 89, 92, and 133-148 were rejected under 35 U.S.C. § 102(b), claims 23, 24, 31, 32, 89, 90, 92, 93, and 133-148 were rejected under 35 U.S.C. § 103(a), and claims 23, 24, 30-32, 89, 90, 92, 93, and 133-148 were provisionally rejected under an obviousness-type double patenting rejection.

An Amendment and Response (dated April 30, 2002, a copy enclosed, see Appendix IV) was filed in which claims 23, 24, 30-32, 56, 57, 63, 64, 92, 93, 113, 114, 136, 143, and 151-153 were amended to recite a production tool comprising a plurality of cavities, " . . . wherein each of the cavities has a single opening".

A final Office Action (dated July 22, 2002, a copy enclosed, see Appendix V) was received, in which the 35 U.S.C. §§ 102, 103 and provisional obviousness-type double patenting rejections and the objection to claims 133, 137, and 144 were maintained as described in the first nonfinal Office Action (Appendix III) mailed on January 30, 2002.

An Amendment and Response (dated September 23, 2002, a copy enclosed, see Appendix VI) cancelled claims 56, 57, 63, 64, 113, 114, 133, 137, 144, and 149-153. An Advisory Action (a copy enclosed, see Appendix VII) was mailed on October 4, 2002, in which the Examiner: (1) maintained the rejections from the final Office Action (Appendix V); (2) indicated that all rejections of claims 133, 137, and 144 had been overcome due to their cancellation; and (3) indicated that the proposed amendments in the Amendment and Response (Appendix VI) would be entered for purposes of Appeal. The pending claims (upon entry of the Amendment and Response dated September 23, 2002 (Appendix VI)) are claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143, and 145-148. An Appellants' Brief on Appeal (dated December 23, 2002, a copy enclosed, see Appendix IX) presented arguments in support of a Notice of Appeal (dated October 22, 2002, a copy enclosed, see Appendix VIII). A Reply Brief (dated March 12, 2003, a copy enclosed, see Appendix XI) was filed in response to the Examiner's Answer (mailed on January 14, 2003, a copy enclosed, see Appendix X).



Finally, a Request for Continued Examination (RCE) under 37 C.F.R. §1.114 and Information Disclosure Statement (dated June 30, 2003, a copy enclosed, see Appendix XII) were filed. Appellants received an Order Dismissing Appeal (dated July 23, 2003, a copy enclosed, see Appendix XIII) in order to reopen prosecution of the application before the Examiner. Appellants received an Office Action (dated August 26, 2003, a copy enclosed, see Appendix XIV) in response to the RCE.

All amendments were entered.

#### **V. SUMMARY OF THE INVENTION**

Appellants' invention is directed to a production tool for manufacturing an abrasive article. The production tool includes a plurality of cavities, each of which has a single opening. Various embodiments of the production tool are claimed.

Support for the pending claims can be found throughout the specification, including the originally filed claims and drawings, as would be clearly understood by one of skill in the art. Examples of locations of support for the pending claims are listed in the table below.

Claim 23	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 20, line 27 through page 21, line 2; at page 26, line 16 through page 27, line 7; and in Figures 6 and 7 as originally filed.
Claim 24	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 20, line 27 through page 21, line 2; at page 26, line 16 through page 27, line 7; and in Figures 6 and 7 as originally filed.
Claim 30	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 26, line 16 through page 27, line 7; and in Figures 6 and 7 as originally filed.
Claim 31	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page

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	26, line 16 through page 27, line 7; and in Figures 6 and 7 as originally filed.
Claim 32	Support can be found, e.g., at page 6, lines 18-25; at page 7, lines 6-15; at page 26, line 16 through page 27, line 7; in originally filed claim 1; and in Figures 6 and 7 as originally filed.
Claim 89, 92	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and in Figures 6 and 7 as originally filed.
Claim 90, 93	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and in Figures 6 and 7 as originally filed.
Claim 134	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 135	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 136	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; at page 22, lines 14-16; and in Figures 6 and 7 as originally filed.
Claim 138	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 139	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page

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	10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 140	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 141	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 142	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 143	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and in Figures 6 and 7 as originally filed.
Claim 145	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 146	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 147	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 148	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page

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	10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
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**VI. ISSUE(S) PRESENTED FOR REVIEW**

1. Whether claims 23, 30, 31, 89, 92, 134-136, 138-143, and 145-148 are anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 3,312,583 (Rochlis '583, Appendix XV).

2. Whether claim 23, 24, 31, 32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 are obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 3,312,583 (Rochlis '583).

Appellants do not wish to appeal the provisional obviousness-type double patenting rejection of the claims over the parent (U.S. Patent Application Serial No. 09/520,032) of the present application in view of Rochlis '583. In fact, Appellants acknowledge the pending provisional obviousness-type double patent rejection over copending Application No. 09/520,032. After patentability of the instant invention is confirmed, a Terminal Disclaimer will be filed if such a rejection is maintained. This is not an admission that a Terminal Disclaimer is necessary; rather, Appellants will make such a submission merely to expedite prosecution.

**VII. GROUPING OF CLAIMS**

For the purpose of this appeal, claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 stand or fall together.

**VIII. ARGUMENT****A. Claims 23, 30, 31, 89, 92, 134-136, 138-143, and 145-148 are not anticipated under 35 U.S.C. § 102(b) by Rochlis '583.**

The standard for anticipation is one of strict identity. "It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention . . . ." Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

"In determining that quantum of prior art disclosure which is necessary to declare an appellant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure' . . . ." In re Hoeksema, 399 F.2d 269, 158 U.S.P.Q. 596, 600 (CCPA 1968). "A reference contains an 'enabling disclosure' if the public was in possession of the claimed invention before the date of invention." M.P.E.P. § 2121.01.

**1. Rochlis '583 does not disclose every element of the claimed invention.**

Each of Appellants' independent claims recites a production tool for manufacturing an abrasive article having a plurality of cavities, each of which has a single opening. In contrast, the mold disclosed in Rochlis '583 requires a laminate construction with multiple openings (i.e., openings between the layers in addition to the opening through which mold material enters the cavity) (col. 3, lines 40-49). Specifically, these openings between the mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). There is no disclosure in Rochlis '583, however, that any cavity, let alone each of the cavities, has only a single opening. That is, there is no disclosure that Rochlis '583 has laminated mold constructions without openings between the mating surfaces of the laminations. Furthermore, there is no disclosure that Rochlis '583 has mold constructions with a single opening.

In the Advisory Action (Appendix VII), the Examiner alleged that Appellants do not preclude multiple openings in the instant claims. This is respectfully traversed.

Each of Appellants' independent claims recites a production tool for manufacturing an abrasive article, wherein the production tool has a plurality of cavities, each of which has a single opening. Appellants' claims recite that each cavity has a single opening. According to the Random House College Dictionary, "single" is defined as "one only; only one in number" (a copy enclosed, see Appendix XVI).

In contrast, the mold disclosed in Rochlis '583 requires a laminate construction with multiple openings (i.e., openings between the layers in addition to the opening through which mold material enters the cavity) (col. 3, lines 40-49). Specifically, these openings between the mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). There is no disclosure in Rochlis '583, however, that any cavity, let alone each of the cavities, has only a single opening. That is, there is no disclosure that Rochlis '583 has laminated mold constructions without openings between the mating surfaces of the laminations. Furthermore, there is no disclosure that Rochlis '583 has mold constructions with cavities having a single opening.

Appellants also traverse the Examiner's assertion that the vent openings are not part of the mold cavities simply because they do "not perform any shaping function" (page 9 of the Examiner's Answer, Appendix X). Rochlis '583 clearly states that the vent openings are provided to prevent entrapment of gas "in the mold cavity in a manner to possibly alter the shape or size of the pile elements" (column 3, lines 47-48). In other words, the vent openings allow gas to escape from the cavities to allow them to fill properly. As a result, any assertion that the vent openings are not located in the cavities is simply not supported by Rochlis '583 and must be withdrawn.

In response to the Examiner's statement at page 12 of the Examiner's Answer (Appendix X) that Rochlis '583 does not disclose that allowing air or gas to escape is critical or

required for the operation of the apparatus, Appellants disagree. At column 14, lines 19-26, Rochlis '583 states that allowing air and gas to escape is an "important aspect" of the invention and that no gas can accumulate in "any embodiment":

An important aspect of the present invention, in regard to method and apparatus, resides in the fact that the assembly of a lamination of notched mold plates permits air or other gas to escape during the molding and setting operation. Thus, there is no possibility of such gas accumulation tending to mar the individual outlines of the pile elements or components, in any embodiment of the product (emphasis added).

Furthermore, Appellants respectfully submit that it is inappropriate for the Examiner to allege that a positive teaching of embodiments with a single opening results from the use of the phrase "most embodiments" in the context of permitting air or gas to escape (column 3, lines 40-46 of Rochlis) and the term "may" in the context of air or gas escaping (column 13, lines 70-75). That is, it is inappropriate for the Examiner to take these statements out of context and necessarily interpret them to mean that "in the embodiments (in opposition to 'most embodiments') where there are no openings to permit air or other evolved gas to escape, each cavity has a single opening" (page 10 of Examiner's Answer, Appendix X).

It is respectfully submitted that the entire document must be read for a positive teaching of the "embodiments in opposition to most embodiments." There is no such teaching. Rochlis '583 does not disclose any embodiments of mold constructions that would not be laminated and that would not have openings between the mating surfaces of the laminations. Thus, the Examiner's assertion at page 11 of the Examiner's Answer (Appendix X) that Rochlis '583 "is enabling for making a laminated mold or production tool without vent openings which would define each mold cavity with a single opening" must be withdrawn.

**2. Rochlis '583 does not contain an enabling disclosure.**

As stated above, Rochlis '583 does not disclose a production tool with any cavity, let alone each of a plurality of cavities, having only a single opening. Furthermore, Rochlis '583 does not teach how one of skill in the art would make a production tool for manufacturing an abrasive article with even one cavity having a single opening. Rochlis '583 is enabling for a laminated mold construction that includes openings between the mating surfaces of the laminations. There is no enabling disclosure in Rochlis '583 of how one of skill in the art would make a mold or production tool with only a single opening.

Although in the Advisory Action (Appendix VII), the Examiner alleges that Rochlis '583 does not disclose that such openings between the mating surfaces are not critical for the operation of the apparatus, Appellants submit that Rochlis '583 does not teach anything other than a laminate construction with such multiple openings.

**B. Claims 23, 24, 31, 32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 are not obvious under 35 U.S.C. § 103 over Rochlis '583.**

"When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined." M.P.E.P. § 2141 (citations omitted).



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**1. Rochlis '583 does not teach or suggest the claimed invention.**

Rochlis '583 does not explicitly teach or suggest a production tool with any cavity having only a single opening, let alone each of a plurality of cavities having only a single opening. Furthermore, Rochlis '583 does not explicitly teach or suggest how one of skill in the art would make a production tool for manufacturing an abrasive article with a cavity having a single opening in each cavity. Rochlis '583 teaches how to make a laminated mold construction with openings between the mating surfaces of the laminations. From the disclosure of Rochlis '583, one of skill in the art would not know how to make a mold with only a single opening in each cavity.

Rochlis '583 does not explicitly teach or suggest a production tool with any cavity having only a single opening, let alone each of a plurality of cavities having only a single opening.

The Examiner stated at pages 11-12 of the Examiner's Answer (Appendix X) that "modifying the production tool of Rochlis (-583) with the alternatives disclosed by Rochlis (-583) has clear motivation since Rochlis (-583) explicitly discloses that the production tool can be modified with such disclosed alternatives." Although it is not entirely clear from the Examiner's Answer, it is believed that these "alternatives" are those that are discussed above – "in the embodiments (in opposition to 'most embodiments') where there are no openings to permit air or other evolved gas to escape, each cavity has a single opening." Again, even in an obviousness rejection, it is inappropriate for the Examiner to make such a definitive inference from the use of the words "most" and "may" instead of depending on the specific disclosure of a description of what those "other" embodiments would be. There is no such disclosure in Rochlis '583. Thus, one of skill in the art would not be motivated to make a mold or production tool for manufacturing an abrasive article with a single opening as a result of the teachings of Rochlis '583 based on the "disclosed alternatives". This rejection must be withdrawn.

**2. When considered as a whole, Rochlis '583 teaches away from the claimed invention.**

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 353 F.2d 238, 147 U.S.P.Q. 391, 393 (CCPA 1965). A single statement in the prior art reference should not be taken out of context and relied upon with the benefit of hindsight to show obviousness; rather, a reference should be considered as a whole. Bausch & Lomb, Inc. v. Barnes-Hind/Hycrocurve, Inc., 796 F.2d 443, 230 U.S.P.Q. 416, 419-420 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987), on remand, 10 U.S.P.Q. 2d 1929 (N.D. Calif. 1989).

One of skill in the art would not be motivated to make a mold or production tool for manufacturing an abrasive article with a single opening as a result of the teachings of Rochlis '583. In fact, one of skill in the art would expect that a mold with only a single opening in each cavity would not be functional since the openings between the mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). In effect, Rochlis '583 teaches away from Appellants' invention when its disclosure is considered as a whole.

**3. It is impermissible to use hindsight as an obviousness test.**

Appellants respectfully submit that the use of Rochlis '583 alone in an obviousness rejection can only occur by the impermissible use of hindsight reasoning. In order to establish a *prima facie* case of obviousness, the references must teach or suggest all the claim limitations. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 at 93 ("Focusing on the obviousness of substitutions and differences instead of on the invention as a whole, . . . was a legally improper way to simplify the difficult determination of obviousness.").

One cannot "simply [to] engage in a hindsight reconstruction of the claimed invention, using the Appellant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F.2d 982, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). Further, both the suggestion for combining the teachings of the prior art to make the invention and the reasonable likelihood of its success must be founded in the prior art and not in the teachings of Appellants' disclosure. In re Dow Chem., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Here, the cited art neither suggests the combination of its teachings nor suggests the reasonable likelihood that such a combination would result in the present invention.

Appellants respectfully submit that the teachings of Rochlis '583 are woefully inadequate to teach or suggest any mold or production tool for manufacturing an abrasive article, wherein the tool has a plurality of cavities, each of which as a single opening. Impermissible hindsight was used to sift through the prior art in order to reconstruct the claimed invention using Appellants' specification as a template for selecting a particular teaching.

Furthermore, there is simply no teaching, suggestion, or incentive in Rochlis '583 to provide a motivation to modify its teachings to provide a mold or tool with cavities having only single openings, specifically in view of the fact that Rochlis '583 emphasizes the importance of the openings between the mating surfaces of the laminations (they allow for air or gas to be evolved in the molding or hardening procedure, col. 13, lines 70-73).

### **C. Summary**

For the many foregoing reasons, it is respectfully submitted that *prima facie* cases of anticipation and obviousness have not been established. It is earnestly requested that the Board reverse the Examiner's rejections, and that all of the claims be allowed. Appellants acknowledge the pending obviousness-type double patent rejection over copending Application No. 09/520,032 and, after patentability of the instant invention is confirmed, a Terminal

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Disclaimer will be filed if such a rejection is maintained. It is assumed that Appellants would be allowed to file a Terminal Disclaimer if needed.

Respectfully submitted,  
HOOPMAN et al.,  
By their attorneys,

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By: Rachel Gaylord - Gebhardt  
Name: Rachel Gaylord - Gebhardt

(LARGE ENTITY TRANSMITTAL UNDER RULE 1.10)

## APPENDIX I

Serial No.: 09/955,604

Docket No.: 49933US032

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Claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 are provided below.

23. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, and the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second and third plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first and third plurality of angles, and wherein each of the cavities has a single opening.

24. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape and fourth plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second, third, and fourth plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first, third, and fourth plurality of angles, wherein at least one of the angles of the third plurality is different from all of the angles of the first, second, and fourth plurality of angles, and wherein each of the cavities has a single opening.

30. A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first shape, a second group of cavities has a second shape, a third group of cavities has a third shape, wherein the first, second, and third shapes are all different, and wherein each of the cavities has a single opening.
31. A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first size, a second group of cavities has a second size, a third group of cavities has a third size, wherein the first, second, and third sizes are all different, and wherein each of the cavities has a single opening.
32. A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defined by substantially distinct and discernible boundaries which include substantially specific dimensions, wherein a first cavity has specific first dimensions, a second cavity has specific second dimensions, and a third cavity has specific third dimensions, each of said cavities has a boundary defined by at least four planar surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein at least one angle of intersection of said first cavity is different from all the angles of intersection of said second and third cavities, wherein at least one angle of intersection of said second cavity is different from all the angles of intersection of said first and third cavities, and wherein each of the cavities has a single opening.
89. The production tool of claim 23, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and second plurality of base edge lengths, wherein the third geometric shape includes a base and third

plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, and wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths.

90. The production tool of claim 24, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and second plurality of base edge lengths, wherein the third geometric shape includes a base and third plurality of base edge lengths, wherein the fourth geometric shape includes a base and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, and wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths.

92. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, and the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different

from all of the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening.

93. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape including a base and fourth plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths, and wherein each of the cavities has a single opening.

134. The production tool of claim 92, wherein the first, second, and third geometric shapes are pyramidal.

135. The production tool of claim 92, wherein the first, second, and third geometric shapes are truncated pyramidal.



136. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third row of cavities, wherein the cavities each have a geometric shape including a base and a plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first row of cavities is different from all the base edge lengths of the second and third rows of cavities, wherein at least one of the base edge lengths of the second row of cavities is different from all the base edge lengths of the first and third row of cavities, and wherein each of the cavities has a single opening.

138. The production tool of claim 136, wherein the geometric shape of the cavities in the first, second, and third rows are pyramidal.

139. The production tool of claim 136, wherein the geometric shape of the cavities in the first, second, and third rows are truncated pyramidal.

140. The production tool of claim 136, wherein the first, second, and third rows of cavities extend in parallel to one another.

141. The production tool of claim 136, wherein the base edge lengths of the first row of cavities have a first base edge length extending parallel to the first row and a second base edge length extending perpendicular to the first row, and wherein the second base length of all the cavities in the first row is the same.

142. The production tool of claim 141, wherein at least some of the first base lengths of the cavities in the first row are different from one another.

143. A production tool suitable for use in manufacturing an abrasive article comprising first, second, and third cavities, wherein the first cavity has a first geometric shape including a base and a first plurality of base edge lengths forming the base of the geometric shape, the second cavity has a second geometric shape including a base and a second plurality of base edge lengths forming the base of the geometric shape, and the third cavity has a third geometric shape including a base and a third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality of base edge lengths is different from all the base edge lengths of the second and third plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality of base edge lengths is different from all the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening.

145. The production tool of claim 143, wherein the geometric shapes of the first, second, and third cavities are pyramidal.

146. The production tool of claim 143, wherein the geometric shapes of the first, second, and third cavities are truncated pyramidal.

147. The production tool of claim 143, wherein the first cavity is located adjacent to the second cavity.

148. The production tool of claim 147, wherein the second cavity is located adjacent to the third cavity.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): HOOPMAN et al. )  
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 )  
Serial No.: Unassigned )  
Serial No. of Parent: 09/520,032 )  
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Confirmation No.: Unknown )  
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For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES

Group Art Unit:  
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Examiner: Unknown  
Examiner of Parent: Joseph Leyson

COMMUNICATION

Assistant Commissioner for Patents  
Attn: Box Patent Application  
Washington, D.C. 20231

Sir:

Prior to taking up the above-identified patent application, the Examiner is requested to consider the accompanying remarks. The pending claims are claims 23-24, 30-32, 56-57, 63-64, 89-90, 92-93, 113-114, and 133-153. Support for these claims can be found throughout the specification, including the originally filed claims and drawings, as would be clearly understood by one of skill in the art. Examples of locations of support for these new claims are listed in the table below.

Claim 1-21	Support can be found, e.g., in the originally filed claims in the parent application Serial No. 09/520,032 (filed March 6, 2000).
Claim 22	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 20, line 27 through page 21, line 2; and at page 26, line 16 through page 27, line 7.
Claim 23	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page

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	10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 20, line 27 through page 21, line 2; and at page 26, line 16 through page 27, line 7.
Claim 24	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 20, line 27 through page 21, line 2; and at page 26, line 16 through page 27, line 7.
Claim 25	Support can be found, e.g., at page 6, lines 18-25; at page 20, line 27 through page 21, line 18; and at page 26, line 16 through page 27, line 7.
Claim 26	Support can be found, e.g., at page 6, lines 18-25; at page 20, line 27 through page 21, line 18; and at page 26, line 16 through page 27, line 7.
Claim 27	Support can be found, e.g., at page 6, lines 18-25; at page 20, line 27 through page 21, line 18; and at page 26, line 16 through page 27, line 7.
Claim 28	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 19, lines 14-20; at page 20, line 27 through page 21, line 18; and at page 26, line 16 through page 27, line 7.
Claim 29	Support can be found, e.g., at page 6, lines 18-25; at page 10, lines 5-10; at page 11, lines 19-28; at page 21, lines 19-26; and at page 26, line 16 through page 27, line 7.
Claim 30	Support can be found, e.g., at page 6, line 18 through page 7, line 15; and at page 26, line 16 through page 27, line 7.
Claim 31	Support can be found, e.g., at page 6, line 18 through page 7, line 15; and at page 26, line 16 through page 27, line 7.
Claim 32	Support can be found, e.g., at page 6, lines 18-25; at page 7, lines 6-15; at page 26, line 16 through page 27, line 7; and in originally filed claim 1.
Claim 33-43	Support can be found, e.g., at page 28, lines 12-17; and above with respect to claims 22-32.
Claim 44-54	Support can be found, e.g., at page 28, lines 12-17; and above with respect to

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	claims 22-32.
Claim 55	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 19, lines 14-20; at page 20, line 27 through page 21, line 2; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 56	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 57	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 58	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 59	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 60	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 61	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 19, lines 14-20; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 62	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 10, lines 5-10; at page 11, lines 19-28; at page 21, lines 19-26; and at page 26, line 16 through page 27, line 7; and in originally filed claim 6.

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Claim 63	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 64	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 65	Support can be found, e.g., at page 6, lines 18 through page 8, line 24; at page 26, line 16 through page 27, line 7; and in originally filed claims 1 and 6.
Claim 66-76	Support can be found, e.g., at page 28, lines 12-17; and above with respect to claims 55-65.
Claim 77-87	Support can be found, e.g., at page 28, lines 12-17; and above with respect to claims 55-65.
Claim 88, 91	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 19, lines 14-20; at page 20, line 27 through page 21, line 2; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 89, 92	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 90, 93	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 94	Support can be found, e.g., at page 6, lines 18-25; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 95	Support can be found, e.g., at page 6, lines 18-25; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 96	Support can be found, e.g., at page 6, lines 18-25; at page 20, line 27 through

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	page 21, line 18; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 97	Support can be found, e.g., at page 6, lines 18-25; at page 10, lines 5-10; at page 11, lines 19-28; at page 21, lines 19-26; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claims 98-104	Support can be found, e.g., at page 28, lines 12-17; and above with respect to claims 91-97.
Claims 105-111	Support can be found, e.g., at page 28, lines 12-17; and above with respect to claims 91-97.
Claim 112	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 19, lines 14-20; at page 20, line 27 through page 21, line 2; at page 26, line 16 through page 27, line 7; in originally filed claim 6; and at page 10, lines 23-27.
Claim 113	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; in originally filed claim 6; and at page 10, lines 23-27.
Claim 114	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; in originally filed claim 6; and at page 10, lines 23-27.
Claim 115	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; in originally filed claim 6; and at page 10, lines 23-27.
Claim 116	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; in originally filed claim 6; and at page 10, lines 23-27.
Claim 117	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 20, line 27 through page 21, line 18; at page 26, line 16

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	through page 27, line 7; in originally filed claim 6; and at page 10, lines 23-27.
Claim 118	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 10, lines 5-10; at page 11, lines 19-28; at page 21, lines 19-26; and at page 26, line 16 through page 27, line 7; in originally filed claim 6; and at page 10, lines 23-27.
Claim 119-125	Support can be found, e.g., at page 28, lines 12-17; and above with respect to claims 112-118.
Claim 126-132	Support can be found, e.g., at page 28, lines 12-17; and above with respect to claims 112-118.
Claim 133	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 134	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 135	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 136	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 137	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 138	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16



	through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 139	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 140	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 141	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 142	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 143	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 144	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 145	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 146	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 147	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page

	10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 148	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 149	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 150	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 151	Support can be found, e.g., at page 6, lines 18-25; at page 7, lines 6-15; at page 26, line 16 through page 27, line 7; and in originally filed claim 1.
Claim 152	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 153	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.

**Remarks**

In the parent application, Serial No. 09/520,032, filed March 6, 2000, claims 14-16, 18, 22-24, 29-32, 88-93, and 97 were rejected under §102(e) in view of Calhoun et al. (U.S. Patent No. 5,437,754). Such claims are being re-presented herein as claims 14-16, 18, 22-24, 29-32, 88-93, and 97, respectively, except claims 14-16, 18, 22, 29, 88, 91, and 97 have been cancelled in the accompanying Request for Filing a Continuation Application, and the following claims have been amended: 30 (to recite a third group of cavities having a third shape), 31 (to recite a third

group of cavities having a third size), 32 (to recite a third cavity having third dimensions). Additional amendments have been made, the majority of which are primarily typographical in nature.

Also being presented are new claims 133-148, which are directed to a production tool, as well as former claims 56-57, 63-64, and 113-114, which are all independent claims directed to a method of making a production tool, and new claims 149-153, which are also method claims.

In view of the §102(e) (anticipation) rejection in the parent application based on Calhoun et al. the following comments are being provided to explain why a §102(e) (anticipation) rejection based on Calhoun et al. would not be proper for the instant claims.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. §2131 (quoting Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” M.P.E.P. §2131 (quoting Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

“The standards of anticipation are strict. The invention must be disclosed within the four corners of a single reference. If a reference is silent or ambiguous with respect to an element or feature of the invention, that gap cannot be filled by an assumption or by combining one reference with another. An anticipating reference must teach the invention. It is not sufficient to point to silence or ambiguity after the invention and argue that the invention could be made out from the reference.” Plastering Development Center, Inc. v. Perma Glas-Mesh Corp., 371 F.Supp. 939, 943, 944, 179 USPQ 838, 841 (N.D. Ohio 1973) (quoting General Tire & Rubber Co. v. The Firestone Tire & Rubber Co., 349 F.Supp. 345, 356, 174 USPQ 427, 442, 443 (N.D. Ohio 1972)). Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture. W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303 (Fed. Cir. 1983).

“Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Jamesbury Corp. v. Litton Industrial Products, 756 F.2d 1556, 1560, 225 USPQ 253, 256 (Fed. Cir. 1985) (quoting Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983)); Soundsciber Corp. v. U.S., 175 Ct.Cl. 644, 360 F.2d 954, 960, 148 USPQ 298, 301 (1966). A prior art disclosure that ‘almost’ meets that standard may render the claim invalid under §103; it does not ‘anticipate.’ Jamesbury Corp. v. Litton Industrial Products, 225 USPQ 253, 256 (Fed. Cir. 1985) (quoting from Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983)).

Although Calhoun et al. do generally disclose a production tool having three-dimensional cavities that can be of different sizes and/or shapes, such shapes being truncated cones, truncated pyramids, cubes, cylinders, elongated troughs, chevrons, intersecting grooves, hemispheres, and combinations thereof, there is no specific disclosure of Applicants’ invention as claimed. For example:

Calhoun et al. do not specifically teach the presence of at least three pluralities of cavities having a plurality of angles forming a geometric shape, wherein at least one of the angles of the first plurality is different from all the angles of each of the second and third plurality of angles, and at least one of the angles of the second plurality is different from all the angles of each of the first and third plurality of angles (see claims 23 and 56).

Calhoun et al. do not specifically teach the presence of at least four pluralities of cavities having a plurality of angles forming a geometric shape, wherein at least one of the angles of the first plurality is different from all the angles of each of the second, third, and fourth plurality of angles, at least one of the angles of the second plurality is different from all the angles of each of the first, third, and fourth plurality of angles, and at least one of the angles of the third plurality is different from all the angles of each of the first, second, and fourth plurality of angles (see claims 24 and 57).

Calhoun et al. do not specifically teach the presence of at least three pluralities of cavities having different shapes (see claims 30 and 63) or at least three pluralities of cavities having different

sizes (see claims 31 and 64).

Calhoun et al. do not specifically teach the presence of at least three cavities each having a boundary defined by at least four planar surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein at least one angle of intersection of the first cavity is different from all the angles of intersection of the second and third cavities, and at least one angle of intersection of the second cavity is different from all the angles of intersection of the first and third cavities (see claims 32 and 151).

Calhoun et al. do not specifically teach the presence of at least three pluralities of cavities having a plurality of base edge lengths forming the base of a geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all the base edge lengths of each of the second and third plurality of base edge lengths, and at least one of the base edge lengths of the second plurality is different from all the base edge lengths of each of the first and third plurality of base edge lengths (see claims 92 and 113).

Calhoun et al. do not specifically teach the presence of at least four pluralities of base edge lengths forming the base of a geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all the base edge lengths of each of the second, third, and fourth plurality of base edge lengths, at least one of the base edge lengths of the second plurality is different from all the base edge lengths of each of the first, third, and fourth plurality of base edge lengths, and at least one of the base edge lengths of the third plurality is different from all the base edge lengths of each of the first, second, and fourth plurality of base edge lengths (see claims 93 and 114).

Calhoun et al. do not specifically teach the presence of at least three rows of cavities each having a geometric shape including a base and a plurality of base edge lengths forming the base, wherein at least one of the base edge lengths of the first row of cavities is different from all the base edge lengths of each of the second and third row of cavities, and at least one of the base edge lengths of the second row of cavities is different from all the base edge lengths of each of

the first and third row of cavities (see claims 136 and 152).

Calhoun et al. do not specifically teach the presence of at least three cavities each of which has a geometric shape including a base and a plurality of base edge lengths forming the base, wherein at least one of the base edge lengths of the first plurality is different from all the base edge lengths of each of the second and third plurality of base edge lengths, and at least one of the base edge lengths of the second plurality is different from all the base edge lengths of each of the first and third plurality of base edge lengths (see claims 143 and 153).

Thus, Calhoun et al. do not teach each and every element of Applicants' claims. That is, there are claim elements recited in Applicants' independent claims missing from Calhoun et al. Thus, it is respectfully submitted that Calhoun et al. is not suitable for use in an anticipation rejection; rather, it is at most (if even that) suitable for an obviousness rejection.

**Communication**

Serial No.: Unassigned

Filed: Herewith

For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES

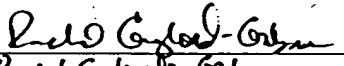
Page 13 of 13

**CONCLUSION**

The application should now be in condition for examination and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

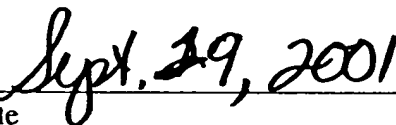
**CERTIFICATE UNDER 37 C.F.R. §1.10:**

The undersigned hereby certifies that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §1.10 on the date indicated below and is addressed to the Assistant Commissioner for Patents, Attn: Box Patent Application, Washington, D.C. 20231.

  
Rachel Gagliardi-Gebben

"Express Mail" mailing label number:  
EL888271625US

Date of Deposit: September 19, 2001

  
Date

Respectfully submitted for

**HOOPMAN et al.**

By

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Direct Dial (612)305-1217

### **APPENDIX III**

Serial No.: 09/955,604

Docket No.: 49933US032

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Office Action and Restriction Requirement mailed from the U.S. Patent and Trademark Office on January 30, 2002.





UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,604	09/19/2001	Timothy L. Hoopman	49933US032	1214

7590 01/30/2002  
Office of Intellectual Property Counsel  
3M Innovative Properties Company  
P.O. Box 33427  
St. Paul, MN 55133-3427

EXAMINER

LEYSON, JOSEPH S

ART UNIT	PAPER NUMBER
----------	--------------

1722

DATE MAILED: 01/30/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

in 2/1/02

# Office Action Summary

Application No.

09/955,604

Applicant(s)

HOOPMAN ET AL.

Examiner

Joseph Leyson

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 23,24,30-32,56,57,63,64,89,90,92,93,113,114 and 133-153 is/are pending in the application.
- 4a) Of the above claim(s) 56,57,63,64,113,114 and 149-153 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23,24,30-32,89,90,92,93 and 133-148 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other.

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 23, 24, 30-32, 89, 90, 92, 93 and 133-148, drawn to a production tool, classified in class 425, subclass 470.
- II. Claims 56, 57, 63, 64, 113, 114 and 149-153, drawn to a method of making a production tool, classified in class 264, subclass 219.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as a process which does not include creating a design wherein the production tool is made in a random fashion by cutting randomly or by randomly placing elements on a substrate.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by

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their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Ann Muetting on 16 January 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 23, 24, 30-32, 89, 90, 92, 93 and 133-148. Affirmation of this election must be made by applicant in replying to this Office action. Claims 56, 57, 63, 64, 113, 114 and 149-153 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The disclosure is objected to because of the following informalities: The cross reference to the related applications on p. 1, lines 7-11, should be deleted in view of the cross reference inserted by the amendment in the transmittal papers filed on 19 September 2001.

Appropriate correction is required.

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7. Claims 133, 137 and 144 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 133 is redundant to claim 92 because if at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality and if at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality, then it is INHERENT that at least one of the base edge lengths of the third plurality is different from all the base edge lengths of the first and second plurality.

Claim 137 is redundant to claim 136 because if at least one of the base edge lengths of the first row is different from all of the base edge lengths of the second and third rows and if at least one of the base edge lengths of the second row is different from all of the base edge lengths of the first and third rows, then it is INHERENT that at least one of the base edge lengths of the third row is different from all the base edge lengths of the first and second rows.

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Claim 144 is redundant to claim 143 because if at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality and if at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality, then it is INHERENT that at least one of the base edge lengths of the third plurality is different from all the base edge lengths of the first and second plurality.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 23, 30, 31, 89, 92 and 133-148 are rejected under 35 U.S.C. 102(b) as being anticipated by Rochlis(-583).

Rochlis(-583) teaches a production tool suitable for use in manufacturing an abrasive article (col. 1, lines 50-56) which includes a plurality of cavities having different geometric shapes, angles and dimensions. The production tool can be a coating roll (fig. 19) or an etched (engraved) metal roll (col. 3, lines 52-63; col. 13, lines 15-17 and 62-67). The production

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tool can have parallel rows of cavities as shown in figs. 21 and 22 with a first plurality of rectangular cavities, a second plurality of circular cavities, and a third plurality of triangular cavities. At least one of the angles or base edge lengths of the first plurality is different from all the angles or base edge lengths of the second plurality and of the third plurality. At least one of the angles or base edge lengths of the second plurality is different from all the angles or base edge lengths of the first plurality and of the third plurality. Rochlis(-583) discloses that the cavities of the production tool can have different sizes (col. 2, lines 66-70; col. 6, lines 17-22; col. 9, line 61, to col. 10, line 52; i.e., different heights). Rochlis(-583) discloses that the cavities and products can have pyramidal or truncated pyramidal shapes (i.e., figs. 10-13; col. 13, lines 51-58). Rochlis(-583) discloses that the production tool can have a plurality of different types (shapes) of cavities (col. 13, lines 29-35). Figs. 21 and 22 show a first row of cavities with a rectangular cross section which defines a first base edge length extending parallel to the first row and a second base edge length extending perpendicular to the first row, wherein the second base length of all the cavities in the first row is the same (of course they also can be different sizes as mentioned above), and show a first

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rectangular cavity adjacent a second circular cavity, the second circular cavity being adjacent a third triangular cavity.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 23, 24, 31, 32, 89, 90, 92, 93 and 133-148 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rochlis(-583).



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The 102 rejection above is based upon the interpretation of the alternatives for the production tool disclosed by Rochlis(-583) as being anticipatory. If applicants believe that the disclosed alternatives are NOT anticipatory, then it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the production tool of Rochlis(-583) with the alternatives disclosed by Rochlis(-583) because Rochlis(-583) explicitly discloses that the production tool can be modified with such disclosed alternatives.

Rochlis(-583) discloses a production tool having 3 different types or shapes of cavities defining three pluralities or groups of cavities (figs. 21 and 22), but does NOT explicitly disclose a fourth plurality or group of cavities having a fourth different type of cavity. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the production tool to have four pluralities or group of cavities having four different types of cavity because Rochlis(-583) discloses that the production tool can have a plurality of different types of cavities and/or because Rochlis(-583: figs. 21 and 22) discloses a production tool example having not just two but three pluralities or groups of cavities having three different types of cavities. Note that different shapes will read on the respective instant claims.

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For example, if the three different types had cross sections of a square, a pentagon, and a hexagon, then each of the cavities would have a boundary defined by at least four surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein the at least one angle of intersection of the first cavity is different from all the angles of the second and third cavities, and wherein at least one angle of intersection of the second cavity is different from all the angles of intersection of the first and third cavities. Various different types would also provide different base edge lengths.

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 23, 24, 30-32, 89, 90, 92, 93 and 133-148 are provisionally rejected under the judicially created doctrine of

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obviousness-type double patenting as being unpatentable over claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time of the invention to eliminate the limitation of each cavity having a single opening of claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 because it is well within the artisan of ordinary skill to make integral that which was separable or to make separable that which was integral. Generally there is no invention in making integral that which was before in several parts, In re Lockhart, 90 USPQ 214; In re Larson, 144 USPQ 347. The mere fact that a given structure is integral does not preclude its consisting of various elements, Howard v. Detroit Stove Works, 150 U.S. 164.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Leyson whose telephone number is (703) 308-2647. The examiner can normally be reached on M-F(8:30-6:00) First Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (703) 308-3322. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*h*

j1

January 18, 2002



NAM NGUYEN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

<b>Notice of References Cited</b>	Application/Control No. 09/955,604	Applicant(s)/Patent Under Reexamination HOOPMAN ET AL.	
	Examiner Joseph Leyson	Art Unit 1722	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-3312583	04-1967	Rochlis	-/-
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

**APPENDIX IV**

Serial No.: 09/955,604

Docket No.: 49933US032

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Amendment and Response filed with the U. S. Patent and Trademark Office on  
April 30, 2002.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s):	Timothy L. HOOPMAN et al.	)	Group Art Unit:	1722
		)		
Serial No.:	09/955,604	)	Examiner:	Joseph Leyson
Confirmation No.:	1214	)		
		)		
Filed:	19 September 2001	)		
For:	TOOLS TO MANUFACTURE ABRASIVE ARTICLES			

**AMENDMENT AND RESPONSE**

Assistant Commissioner for Patents  
Washington D.C. 20231

Dear Sir:

In response to the Office Action mailed 30 January 2002, please amend the above-identified application as follows:

**In the Specification**

Please replace the paragraph beginning at page 1, line 7, with the following rewritten paragraph. Per 37 C.F.R. § 1.121, this paragraph is also shown in Appendix A with notations to indicate the changes made.

-- This application is a continuation of Application No. 09/520,032 (filed March 6, 2000), pending, which is a division of Application No. 09/259,488 (filed February 26, 1999), issued as U.S. Patent NO. 6,076,248, which application is a division of Application No. 08/940,267 (filed September 29, 1997), issued as U.S. Patent No. 6,129,540, which is a continuation of Application No. 08/450,814 (filed May 25, 1995), abandoned, which is a division of Application No. 08/120,300 (filed September 13, 1993), abandoned. --

**In the Claims**

Please amend claims 23, 24, 30-32, 56, 57, 63, 64, 92, 93, 113, 114, 136, 143, and 151-153. The amended claims are provided below in clean form. Per 37 C.F.R. § 1.121, amended claims are also shown in Appendix A with notations to indicate changes made (for convenience, all pending claims are provided in Appendix A).

23. **(Amended)** A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, and the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second and third plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first and third plurality of angles, and wherein each of the cavities has a single opening.

24. **(Amended)** A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape and fourth plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second, third, and fourth plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first, third, and fourth plurality of angles, wherein at least one of the angles of



the third plurality is different from all of the angles of the first, second, and fourth plurality of angles, and wherein each of the cavities has a single opening.

30. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first shape, a second group of cavities has a second shape, a third group of cavities has a third shape, wherein the first, second, and third shapes are all different, and wherein each of the cavities has a single opening.

31. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first size, a second group of cavities has a second size, a third group of cavities has a third size, wherein the first, second, and third sizes are all different, and wherein each of the cavities has a single opening.

32. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defined by substantially distinct and discernible boundaries which include substantially specific dimensions, wherein a first cavity has specific first dimensions, a second cavity has specific second dimensions, and a third cavity has specific third dimensions, each of said cavities has a boundary defined by at least four planar surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein at least one angle of intersection of said first cavity is different from all the angles of intersection of said second and third cavities, wherein at least one angle of intersection of said second cavity is different from all the angles of intersection of said first and third cavities, and wherein each of the cavities has a single opening.

56. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, and the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second and third plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first and third plurality of angles, and wherein each of the cavities has a single opening; and  
forming the production tool using the design.

57. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape and fourth plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second, third, and fourth plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first, third, and fourth plurality of angles, wherein at least one of the angles of the third plurality is different from all of the angles of the first, second, and fourth plurality of angles, and wherein each of the cavities has a single opening; and  
forming the production tool using the design.

63. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a plurality of cavities defining at least a first, a second group, and a third group, wherein a first group of cavities has a first shape, a second group of cavities has a second shape, a third group of cavities has a third shape, wherein the first, second, and third shapes are all different, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

64. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a plurality of cavities defining at least a first, a second group, and a third group, wherein a first group of cavities has a first size, a second group of cavities has a second size, a third group of cavities has a third size, wherein the first, second, and third sizes are all different, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

92. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, and the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening.

93. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape including a base and fourth plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths, and wherein each of the cavities has a single opening.

113. (Amended) A method of making a production tool, the method comprising:  
creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, and the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, wherein at least one of the base edge lengths of the second

plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening; and  
forming the production tool using the design.

114. **(Amended)** A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape including a base and fourth plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

136. **(Amended)** A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third row of cavities, wherein the cavities each have a geometric shape including a base and a plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first row of cavities is different from all the base edge lengths of the second and third rows of cavities, wherein at least one of the base edge lengths of

the second row of cavities is different from all the base edge lengths of the first and third row of cavities, and wherein each of the cavities has a single opening.

143. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising first, second, and third cavities, wherein the first cavity has a first geometric shape including a base and a first plurality of base edge lengths forming the base of the geometric shape, the second cavity has a second geometric shape including a base and a second plurality of base edge lengths forming the base of the geometric shape, and the third cavity has a third geometric shape including a base and a third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality of base edge lengths is different from all the base edge lengths of the second and third plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality of base edge lengths is different from all the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening.

151. (Amended) A method of making a production tool, the method comprising:  
creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a plurality of cavities defined by substantially distinct and discernible boundaries which include substantially specific dimensions, wherein a first cavity has specific first dimensions, a second cavity has specific second dimensions, and a third cavity has specific third dimensions, each of said cavities has a boundary defined by at least four planar surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein at least one angle of intersection of said first cavity is different from all the angles of intersection of said second and third cavities, wherein at least one angle of intersection of said second cavity is different from all the angles of intersection of said first and third cavities, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

152. **(Amended)** A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, and third row of cavities, wherein the cavities each have a geometric shape including a base and a plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first row of cavities is different from all the base edge lengths of the second and third rows of cavities, wherein at least one of the base edge lengths of the second row of cavities is different from all the base edge lengths of the first and third row of cavities, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

153. **(Amended)** A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising first, second, and third cavities, wherein the first cavity has a first geometric shape including a base and a first plurality of base edge lengths forming the base of the geometric shape, the second cavity has a second geometric shape including a base and a second plurality of base edge lengths forming the base of the geometric shape, and the third cavity has a third geometric shape including a base and a third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality of base edge lengths is different from all the base edge lengths of the second and third plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality of base edge lengths is different from all the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

**Amendment and Response**

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**Remarks**

The Office Action mailed 30 January 2002 has been received and reviewed. Claims 23, 24, 30-32, 56, 57, 63, 64, 92, 93, 113, 114, 136, 143, and 151-153 have been amended. The pending claims are claims 23-24, 30-32, 56-57, 63-64, 89-90, 92-93, 113-114, and 133-153. Reconsideration and withdrawal of the rejections are respectfully requested.

Pursuant to the Examiner's request, the specification has been amended herein to correctly identify the cross reference information.

**Response to Restriction Requirement**

Pursuant to the telephone conversation between the Examiner and Applicants' Representative, Ann Muetting, election of Group I (claims 23, 24, 30-32, 89, 90, 92, 93, and 133-148) is hereby affirmed.

Applicants' Representatives reserve the right to pursue examination of the non-elected claims in continuation or divisional applications. Applicants respectfully request reconsideration of the restrictions in this case and submit that the inventions as claimed can be readily evaluated in one search without placing undue burden on the Examiner.

**The 35 U.S.C. § 102(b) Rejection**

Claims 23, 30-31, 89, 92, and 133-148 were rejected under 35 U.S.C. § 102(b) as being anticipated by Rochlis ('583). Applicants respectfully traverse this rejection.

Each of the independent claims recites that each of the cavities has a single opening. In contrast, the mold disclosed in Rochlis ('583) requires a laminate construction with multiple openings (i.e., one opening per layer). Specifically, these openings between the mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). There is no enabling disclosure in Rochlis ('583), however, that any cavity, let alone each of the cavities, has a single opening. That is, there is no enabling



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disclosure that Rochlis ('583) has laminated mold constructions without openings between the mating surfaces of the laminations.

For at least the above reasons, Applicants submit that claims 23, 30-31, 89, 92, and 133-148 are patentable over Rochlis ('583). Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

### **The 35 U.S.C. § 103(a) Rejection**

Claims 23-24, 31-32, 89-90, 92-93, and 133-148 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rochlis ('583). Applicants respectfully traverse this rejection.

Again, each of the independent claims recites that each of the cavities has a single opening. In contrast, the mold disclosed in Rochlis ('583) requires a laminate construction with multiple openings (i.e., one opening per layer). Specifically, these openings between the mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). There is no enabling disclosure in Rochlis ('583), however, that any cavity, let alone each of the cavities, has a single opening. That is, there is no enabling disclosure that Rochlis ('583) has laminated mold constructions without openings between the mating surfaces of the laminations.

For at least the above reasons, claims 23-24, 31-32, 89-90, 92-93, and 133-148 are patentable over Rochlis ('583). Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

### **Double Patenting Rejection**

Claims 23-24, 30-32, 89-90, 92-93, and 133-148 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17, 20-21, 25-28, 33-54, 94-96, and 98-111 of copending Application No. 09/520,032. Upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response.

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Summary

It is respectfully submitted that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for  
HOOPMAN et al.

By:

Muetting, Raasch & Gebhardt, P.A.

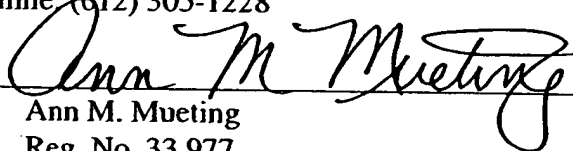
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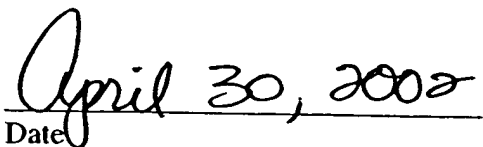
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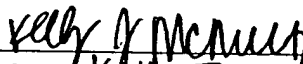
  
Date

AMM/kjm

CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on this 30<sup>th</sup> day of APRIL, 2002, at 3:10 pm (Central Time).

By:



Printed Name:

Kelly J. McNulty

**APPENDIX A - SPECIFICATION/CLAIM AMENDMENTS INCLUDING NOTATIONS  
TO INDICATE CHANGES MADE**

**Serial No.: 09/955,604  
Docket No.: 49933 US 032**

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Amendments to the following are indicated by underlining what has been added and bracketing what has been deleted. The amendments have also been shaded.

**In the Specification**

The paragraph beginning at page 1, line 7, has been replaced with the following paragraph:

~~This application is a continuation of Application No. 09/521,932, filed Nov. 14, 2001, which is a continuation of Application No. 09/259,463, filed Feb. 26, 1999, which is a continuation of Application No. 08/410,447, filed Aug. 14, 1995, which is a continuation of Application No. 08/410,447, filed Aug. 25, 1995, which is a continuation of Application No. 08/410,300, filed Sep. 13, 1995, abandoned.~~

**In the Claims**

For convenience, all pending claims are shown below.

23. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, and the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second and third plurality of angles, [and] wherein at least one of the angles of the second plurality is different from all of the angles of the first and third plurality of angles, ~~and wherein each of the cavities has a single opening.~~

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24. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape and fourth plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second, third, and fourth plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first, third, and fourth plurality of angles, [redacted] wherein at least one of the angles of the third plurality is different from all of the angles of the first, second, and fourth plurality of angles, [redacted] and wherein each of the cavities has a single opening.

30. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first shape, a second group of cavities has a second shape, a third group of cavities has a third shape, [redacted] wherein the first, second, and third shapes are all different, [redacted] wherein each of the cavities has a single opening.

31. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first size, a second group of cavities has a second size, a third group of cavities has a third size, [redacted] wherein the first, second, and third sizes are all different, [redacted] and wherein each of the cavities has a single opening.

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32. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defined by substantially distinct and discernible boundaries which include substantially specific dimensions, wherein a first cavity has specific first dimensions, a second cavity has specific second dimensions, and a third cavity has specific third dimensions, each of said cavities has a boundary defined by at least four planar surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein at least one angle of intersection of said first cavity is different from all the angles of intersection of said second and third cavities, [redacted] wherein at least one angle of intersection of said second cavity is different from all the angles of intersection of said first and third cavities [redacted] [redacted].

56. (Amended) A method of making a production tool, the method comprising:  
creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, and the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second and third plurality of angles, [redacted] wherein at least one of the angles of the second plurality is different from all of the angles of the first and third plurality of angles [redacted]; and  
forming the production tool using the design.

57. (Amended) A method of making a production tool, the method comprising:  
creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of

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cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape and fourth plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second, third, and fourth plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first, third, and fourth plurality of angles, [REDACTED] wherein at least one of the angles of the third plurality is different from all of the angles of the first, second, and fourth plurality of angles, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

63. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a plurality of cavities defining at least a first, a second group, and a third group, wherein a first group of cavities has a first shape, a second group of cavities has a second shape, a third group of cavities has a third shape, [REDACTED] wherein the first, second, and third shapes are all different, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

64. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a plurality of cavities defining at least a first, a second group, and a third group, wherein

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a first group of cavities has a first size, a second group of cavities has a second size, a third group of cavities has a third size, [REDACTED] wherein the first, second, and third sizes are all different [REDACTED]

[REDACTED]; and

forming the production tool using the design.

89. The production tool of claim 23, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and second plurality of base edge lengths, wherein the third geometric shape includes a base and third plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, and wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths.

90. The production tool of claim 24, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and second plurality of base edge lengths, wherein the third geometric shape includes a base and third plurality of base edge lengths, wherein the fourth geometric shape includes a base and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, and wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths.

92. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each

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have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, and the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, [REDACTED] wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths, [REDACTED].

93. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape including a base and fourth plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, [REDACTED] wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths, [REDACTED] and wherein each of the cavities has a single opening.



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113. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, and the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, [REDACTED] wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths ~~and wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first and second plurality of base edge lengths~~; and forming the production tool using the design.

114. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape including a base and fourth plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all

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of the base edge lengths of the first, third, and fourth plurality of base edge lengths, [REDACTED] wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths [REDACTED]

[REDACTED]; and

forming the production tool using the design.

133. The production tool of claim 92, wherein at least one of the base edge lengths of the third plurality of base edge lengths is different from all the base edge lengths of the first and second plurality of base edge lengths.

134. The production tool of claim 92, wherein the first, second, and third geometric shapes are pyramidal.

135. The production tool of claim 92, wherein the first, second, and third geometric shapes are truncated pyramidal.

136. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third row of cavities, wherein the cavities each have a geometric shape including a base and a plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first row of cavities is different from all the base edge lengths of the second and third rows of cavities, [REDACTED] wherein at least one of the base edge lengths of the second row of cavities is different from all the base edge lengths of the first and third row of cavities [REDACTED].

137. The production tool of claim 136, wherein at least one of the base edge lengths of the third row of cavities is different from all the base edge lengths of the first and second row of cavities.

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138. The production tool of claim 136, wherein the geometric shape of the cavities in the first, second, and third rows are pyramidal.

139. The production tool of claim 136, wherein the geometric shape of the cavities in the first, second, and third rows are truncated pyramidal.

140. The production tool of claim 136, wherein the first, second, and third rows of cavities extend in parallel to one another.

141. The production tool of claim 136, wherein the base edge lengths of the first row of cavities have a first base edge length extending parallel to the first row and a second base edge length extending perpendicular to the first row, and wherein the second base length of all the cavities in the first row is the same.

142. The production tool of claim 141, wherein at least some of the first base lengths of the cavities in the first row are different from one another.

143. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising first, second, and third cavities, wherein the first cavity has a first geometric shape including a base and a first plurality of base edge lengths forming the base of the geometric shape, the second cavity has a second geometric shape including a base and a second plurality of base edge lengths forming the base of the geometric shape, and the third cavity has a third geometric shape including a base and a third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality of base edge lengths is different from all the base edge lengths of the second and third plurality of base edge lengths, ~~and~~ wherein at

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least one of the base edge lengths of the second plurality of base edge lengths is different from all the base edge lengths of the first and third plurality of base edge lengths. ~~only when the first and third~~  
~~values has a sum of zero.~~

144. The production tool of claim 143, wherein at least one of the base edge lengths of the third plurality of base edge lengths is different from all the base edge lengths of the first and second plurality of base edge lengths.

145. The production tool of claim 143, wherein the geometric shapes of the first, second, and third cavities are pyramidal.

146. The production tool of claim 143, wherein the geometric shapes of the first, second, and third cavities are truncated pyramidal.

147. The production tool of claim 143, wherein the first cavity is located adjacent to the second cavity.

148. The production tool of claim 147, wherein the second cavity is located adjacent to the third cavity.

149. The method claim of 56, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and second plurality of base edge lengths, wherein the third geometric shape includes a base and third plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, and wherein at least one of

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the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths.

150. The method claim of 57, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and second plurality of base edge lengths, wherein the third geometric shape includes a base and third plurality of base edge lengths, wherein the fourth geometric shape includes a base and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, and wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths.

151. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a plurality of cavities defined by substantially distinct and discernible boundaries which include substantially specific dimensions, wherein a first cavity has specific first dimensions, a second cavity has specific second dimensions, and a third cavity has specific third dimensions, each of said cavities has a boundary defined by at least four planar surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein at least one angle of intersection of said first cavity is different from all the angles of intersection of said second and third cavities, [REDACTED] wherein at least one angle of intersection of said second cavity is different from all the angles of intersection of said first and third cavities, [REDACTED] and [REDACTED] forming the production tool using the design.

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152. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, and third row of cavities, wherein the cavities each have a geometric shape including a base and a plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first row of cavities is different from all the base edge lengths of the second and third rows of cavities, [REDACTED] wherein at least one of the base edge lengths of the second row of cavities is different from all the base edge lengths of the first and third row of cavities [REDACTED]; and

forming the production tool using the design.

153. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising first, second, and third cavities, wherein the first cavity has a first geometric shape including a base and a first plurality of base edge lengths forming the base of the geometric shape, the second cavity has a second geometric shape including a base and a second plurality of base edge lengths forming the base of the geometric shape, and the third cavity has a third geometric shape including a base and a third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality of base edge lengths is different from all the base edge lengths of the second and third plurality of base edge lengths, [REDACTED] wherein at least one of the base edge lengths of the second plurality of base edge lengths is different from all the base edge lengths of the first and third plurality of base edge lengths [REDACTED] and wherein each of the

[REDACTED] has a single opening; and

forming the production tool using the design.

**APPENDIX V**

Serial No.: 09/955,604

Docket No.: 49933US032

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Office Action mailed from the U. S. Patent and Trademark Office on July 22,  
2002.



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,604	09/19/2001	Timothy L. Hoopman	49933US032	1214

7590 07/22/2002

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
P.O. Box 33427  
St. Paul, MN 55133-3427

EXAMINER

LEYSON, JOSEPH S

ART UNIT	PAPER NUMBER
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1722

6

DATE MAILED: 07/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



1-D

# Office Action Summary

Application No.

09/955,604

Applicant(s)

HOOPMAN ET AL

Examiner

Joseph Leyson

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 23, 24, 30-32, 56, 57, 63, 64, 89, 90, 92, 93, 113, 114 and 133-153 is/are pending in the application.
- 4a) Of the above claim(s) 56, 57, 63, 64, 113, 114 and 149-153 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23, 24, 30-32, 89, 90, 92, 93 and 133-148 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Applicant's affirmation of the election with traverse of Group I, apparatus claims 23, 24, 30-32, 89, 90, 92, 93 and 133-148, in Paper No. 5 filed on 30 April 2002 is acknowledged. The traversal is on the ground(s) that the inventions as claimed can be readily evaluated in one search without undue burden on the Examiner. This is not found persuasive because the search and examination of both inventions would not be coextensive. The issues raised in the examination of apparatus claims are divergent from those raised in the examination of process claims. Further, while there may be some overlap in the searches of the two inventions, there is no reason to believe that the searches would be identical. Therefore, based on the additional work involved in searching and examining both distinct inventions together, restriction of the distinct inventions is clearly proper.

The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claims 56, 57, 63, 64, 113, 114 and 149-153 drawn to an invention nonelected with traverse. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

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3. Claims 133, 137 and 144 are objected to under 37

CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 133 is redundant to claim 92 because if at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality and if at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality, then it is INHERENT that at least one of the base edge lengths of the third plurality is different from all the base edge lengths of the first and second plurality.

Claim 137 is redundant to claim 136 because if at least one of the base edge lengths of the first row is different from all of the base edge lengths of the second and third rows and if at least one of the base edge lengths of the second row is different from all of the base edge lengths of the first and third rows, then it is INHERENT that at least one of the base edge lengths of the third row is different from all the base edge lengths of the first and second rows.

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Claim 144 is redundant to claim 143 because if at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality and if at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality, then it is INHERENT that at least one of the base edge lengths of the third plurality is different from all the base edge lengths of the first and second plurality.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 23, 30, 31, 89, 92 and 133-148 are rejected under 35 U.S.C. 102(b) as being anticipated by Rochlis(-583).

Rochlis(-583) teaches a production tool suitable for use in manufacturing an abrasive article (col. 1, lines 50-56) which includes a plurality of cavities having different geometric shapes, angles and dimensions. The production tool can be a coating roll (fig. 19) or an etched (engraved) metal roll (col. 3, lines 52-63; col. 13, lines 15-17 and 62-67). The production

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tool can have parallel rows of cavities as shown in figs. 21 and 22 with a first plurality of rectangular cavities, a second plurality of circular cavities, and a third plurality of triangular cavities. At least one of the angles or base edge lengths of the first plurality is different from all the angles or base edge lengths of the second plurality and of the third plurality. At least one of the angles or base edge lengths of the second plurality is different from all the angles or base edge lengths of the first plurality and of the third plurality. Rochlis(-583) discloses that the cavities of the production tool can have different sizes (col. 2, lines 66-70; col. 6, lines 17-22; col. 9, line 61, to col. 10, line 52; i.e., different heights). Rochlis(-583) discloses that the cavities and products can have pyramidal or truncated pyramidal shapes (i.e., figs. 10-13; col. 13, lines 51-58). Rochlis(-583) discloses that the production tool can have a plurality of different types (shapes) of cavities (col. 13, lines 29-35). Figs. 21 and 22 show a first row of cavities with a rectangular cross section which defines a first base edge length extending parallel to the first row and a second base edge length extending perpendicular to the first row, wherein the second base length of all the cavities in the first row is the same (of course they also can be different sizes as mentioned above), and show a first

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rectangular cavity adjacent a second circular cavity, the second circular cavity being adjacent a third triangular cavity. Each of the cavities has a single opening.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claims 23, 24, 31, 32, 89, 90, 92, 93 and 133-148 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rochlis(-583).

The 102 rejection above is based upon the interpretation of the alternatives for the production tool disclosed by Rochlis(-583) as being anticipatory. If applicants believe that the disclosed alternatives are NOT anticipatory, then it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the production tool of Rochlis(-583) with the alternatives disclosed by Rochlis(-583) because Rochlis(-583) explicitly discloses that the production tool can be modified with such disclosed alternatives.

Rochlis(-583) discloses a production tool, as mentioned above, having 3 different types or shapes of cavities defining three pluralities or groups of cavities (figs. 21 and 22), but does NOT explicitly disclose a fourth plurality or group of cavities having a fourth different type of cavity. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the production tool to have four pluralities or group of cavities having four different types of cavity because Rochlis(-583) discloses that the production tool can have a plurality of different types of cavities and/or because Rochlis(-583: figs. 21 and 22) discloses

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a production tool example having not just two but three pluralities or groups of cavities having three different types of cavities. Note that different shapes will read on the respective instant claims. For example, if the three different types had cross sections of a square, a pentagon, and a hexagon, then each of the cavities would have a boundary defined by at least four surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein the at least one angle of intersection of the first cavity is different from all the angles of the second and third cavities, and wherein at least one angle of intersection of the second cavity is different from all the angles of intersection of the first and third cavities. Various different types would also provide different base edge lengths.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).



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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 23, 24, 30-32, 89, 90, 92, 93 and 133-148 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 in view of Rochlis(-583). Claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 disclose the production tool substantially as instantly claimed. Rochlis(-583) discloses a production tool as mentioned above. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify the production tool of claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 such that the cavities have a first, second, third, or more plurality of cavities, each plurality having a different shape because such a modification would produce a product having a first, second, third, or more plurality of different shapes on the product as disclosed by Rochlis(-583). Note that the possible different shapes and combinations thereof disclosed by Rochlis(-583) would provide the dimensions, planar surfaces, angles, edges, boundaries and shapes as recited by the instant claims.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Applicant's arguments with respect to the instant claims have been considered but are moot in view of the new ground(s) of rejection.

Applicants argue that Rochlis(-583) does not disclose each cavity having a single opening. The examiner respectfully disagrees. The examiner does agree that the mold disclosed by Rochlis(-583) in figs. 21 and 22 is a laminate construction and that each layer has multiple openings. The multiple openings of each layer correspond to the multiple cavities. And, when the layers are assembled to form the mold, corresponding multiple openings define a single cavity having a single opening. Thus, the layers separately have multiple openings, whereas a single cavity has a single opening. If there are any openings between the layers, they are used for venting. These vent openings are part of the mold, and are NOT part of the mold cavity.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1722

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Leyson whose telephone number is (703) 308-2647. The examiner can normally be reached on M-F(8:30-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Silbaugh can be reached on (703) 308-3829. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Art Unit: 1722

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*ja*

j1

July 18, 2002

*Jan H. Silbaugh*

JAN H. SILBAUGH  
SUPERVISORY PATENT EXAMINER  
ART UNIT 1722

*07/18/02*

**APPENDIX VI**

Serial No.: 09/955,604

Docket No.: 49933US032

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Amendment and Response Under 37 C.F.R. §1.116 filed with the U.S. Patent and Trademark Office on September 23, 2002 via facsimile transmission.

**OFFICIAL**  
Expedited Examining Procedure  
Group 1722

**PATENT**  
Docket No. 49933US032

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s):	Timothy L. HOOPMAN et al.)	Group Art Unit: 1722
	)	
Serial No.:	09/955,604	Examiner: Joseph S. Leyson
Confirmation No.:	1214	
	)	
Filed:	19 September 2001	
	)	
For:	TOOLS TO MANUFACTURE ABRASIVE ARTICLES	

**AMENDMENT AND RESPONSE UNDER 37 CFR §1.116**

Assistant Commissioner for Patents  
**Attn: BOX AF**  
Washington D.C. 20231

Dear Sir:

In response to the Final Office Action mailed 22 July 2002, please amend the above-identified application as follows:

**In the Claims**

Please cancel claims 56, 57, 63, 64, 113, 114, 133, 137, 144, and 149-153.

Serial No.: 09/955,604

Confirmation No.: 1214

Filed: 19 September 2001

For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES

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### **Remarks**

The Final Office Action mailed 22 July 2002 has been received and reviewed. Claims 56, 57, 63, 64, 113, 114, 133, 137, 144, and 149-153 having been cancelled, the pending claims are claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143, and 145-148.

Reconsideration and withdrawal of the rejections in view of the cancellation of the claims above-indicated and the following comments are respectfully requested.

### **Obviousness-Type Double Patenting Rejection**

Claims 23, 24, 30-32, 89-90, 92, 93 and 133-148 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of co-pending application No. 09/520,032 in view of Rochlis (U.S. Patent No. 3,312,583). The cancellation of claims 133, 137, and 144 renders the rejection as to these claims moot. As to the remaining claims, upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response.

### **The 37 U.S.C. §1.75 Objection**

The Examiner objected to claims 133, 137, and 144 under 37 U.S.C. §1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicants do not agree that claims 133, 137, and 144 are of improper dependent form. However, in the interest of furthering prosecution of the application, these claims have been cancelled.

Withdrawal of the objection is respectfully requested.

**The 35 U.S.C. §102 Rejection**

The Examiner rejected claims 23, 30, 31, 89, 92, and 133-148 under 35 U.S.C. §102(b) as being anticipated by Rochlis (U.S. Patent No. 3,312,583).

Applicants submit that the cancellation of claims 133, 137, and 144 renders the rejection as to these claims moot. As to claims 23, 30, 31, 89, 92, 134-136, 138-143, and 145-148, Applicants respectfully traverse this rejection.

Applicants' invention is directed to a production tool for manufacturing an abrasive article. The production tool includes a plurality of cavities, each of which has a single opening. Various embodiments of the production tool are claimed.

**Claims 23, 30, 31, 89, 92, 134-136, 138-143, and 145-148 are not anticipated under 35 U.S.C. § 102(b) by Rochlis '583.**

The standard for anticipation is one of strict identity. "It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention . . . ."

Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

"In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure' . . . ." In re Hoeksema, 399 F.2d 269, 158 U.S.P.Q. 596, 600 (CCPA 1968). "A reference contains an 'enabling disclosure' if the public was in possession of the claimed invention before the date of invention." M.P.E.P. § 2121.01.

**1. Rochlis '583 does not disclose every element of the claimed invention.**

Each of Applicants' independent claims recites a production tool for manufacturing an abrasive article having a plurality of cavities, each of which has a single



opening. In contrast, the mold disclosed in Rochlis '583 requires a laminate construction with multiple openings (i.e., openings between the layers in addition to the opening through which mold material enters the cavity) (col. 3, lines 40-49). Specifically, these openings between the mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). There is no disclosure in Rochlis '583, however, that any cavity, let alone each of the cavities, has only a single opening. That is, there is no disclosure that Rochlis '583 has laminated mold constructions without openings between the mating surfaces of the laminations. Furthermore, there is no disclosure that Rochlis '583 has mold constructions with a single opening in each cavity.

Applicants also traverse the assertion that the vent openings are not part of the mold cavities. Rochlis '583 clearly states that the vent openings are provided to prevent entrapment of gas "in the mold cavity in a manner to possibly alter the shape or size of the pile elements" (column 3, lines 47-48). In other words, the vent openings allow gas to escape from the cavities to allow them to fill properly. As a result, any assertion that the vent openings are not located in the cavities is simply not supported by Rochlis '583 and must be withdrawn.

**2. Rochlis '583 does not contain an enabling disclosure.**

As stated above, Rochlis '583 does not disclose a production tool with any cavity, let alone each of a plurality of cavities, having only a single opening. Furthermore, Rochlis '583 does not teach how one of skill in the art would make a production tool for manufacturing an abrasive article with even one cavity having a single opening. Rochlis '583 is enabling for a laminated mold construction that includes openings between the mating surfaces of the laminations. There is no enabling disclosure in Rochlis '583 of how one of skill in the art would make a mold or production tool with only a single opening.

**The 35 U.S.C. §103 Rejection**

The Examiner rejected claims 23, 24, 31, 32, 89, 90, 92, 93, and 133-148 under 35 U.S.C. §103(a) as being unpatentable over Rochlis (U.S. Patent No. 3,312,583).

Applicants submit that the cancellation of claims 133, 137, and 144 renders the rejection as to these claims moot. As to claims 23, 24, 31, 32, 89, 90, 92, 93, 134-136, 138-143, and 145-148, Applicants respectfully traverse this rejection.

**Claims 23, 24, 31, 32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 are not obvious under 35 U.S.C. § 103 over Rochlis '583.**

"When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined." M.P.E.P. § 2141 (citations omitted).

**1. Rochlis '583 does not teach or suggest the claimed invention.**

Rochlis '583 does not explicitly teach or suggest a production tool with any cavity having only a single opening, let alone each of a plurality of cavities having only a single opening. Furthermore, Rochlis '583 does not explicitly teach or suggest how one of skill in the art would make a production tool for manufacturing an abrasive article with a cavity having a single opening in each cavity. Rochlis '583 teaches how to make a laminated mold construction with openings between the mating surfaces of the laminations. From the disclosure of Rochlis '583, one of skill in the art would not know how to make a mold with only a single opening in each cavity.

Applicants also submit that the Office Action fails to establish a prima facie case of obviousness as no motivation is identified as to why one of skill in the art would modify the teachings of Rochlis '583 to reach the claimed invention.

**2. When considered as a whole, Rochlis '583 teaches away from the claimed invention.**

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 353 F.2d 238, 147 U.S.P.Q. 391, 393 (CCPA 1965). A single statement in the prior art reference should not be taken out of context and relied upon with the benefit of hindsight to show obviousness; rather, a reference should be considered as a whole. Bausch & Lomb, Inc. v. Barnes-Hind/Hycrocurve, Inc., 796 F.2d 443, 230 U.S.P.Q. 416, 419-420 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987), on remand, 10 U.S.P.Q. 2d 1929 (N.D. Calif. 1989).

One of skill in the art would not be motivated to make a mold or production tool for manufacturing an abrasive article with a single opening as a result of the teachings of Rochlis '583. In fact, one of skill in the art would expect that a mold with only a single opening in each cavity would not be functional since the openings between the mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). In effect, Rochlis '583 teaches away from Applicants' invention when its disclosure is considered as a whole.

**3. It is impermissible to use hindsight as an obviousness test.**

Applicants respectfully submit that the use of Rochlis '583 alone in an obviousness rejection can only occur by the impermissible use of hindsight reasoning. In order

to establish a *prima facie* case of obviousness, the references must teach or suggest all the claim limitations. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 at 93 ("Focusing on the obviousness of substitutions and differences instead of on the invention as a whole, . . . was a legally improper way to simplify the difficult determination of obviousness."). One cannot "simply [to] engage in a hindsight reconstruction of the claimed invention, using the Applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F.2d 982, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). Further, both the suggestion for combining the teachings of the prior art to make the invention and the reasonable likelihood of its success must be founded in the prior art and not in the teachings of Applicants' disclosure. In re Dow Chem., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Here, the cited art neither suggests the combination of its teachings nor suggests the reasonable likelihood that such a combination would result in the present invention.

Applicants respectfully submit that the teachings of Rochlis '583 are woefully inadequate to teach or suggest any mold or production tool for manufacturing an abrasive article, wherein the tool has a plurality of cavities, each of which as a single opening. Impermissible hindsight was used to sift through the prior art in order to reconstruct the claimed invention using Applicants' specification as a template for selecting a particular teaching.

Furthermore, there is simply no teaching, suggestion, or incentive in Rochlis '583 to provide a motivation to modify its teachings to provide a mold or tool with cavities having only single openings, specifically in view of the fact that Rochlis '583 emphasizes the importance of the openings between the mating surfaces of the laminations (they allow for air or gas to be evolved in the molding or hardening procedure, col. 13, lines 70-73).

Serial No.: 09/955,604

Confirmation No.: 1214

Filed: 19 September 2001

For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES

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### Summary

For the many foregoing reasons, it is respectfully submitted that the pending claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 are in condition for allowance and notification to that effect is respectfully requested.

The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for  
HOOPMAN et al.

By  
Mueting, Raasch & Gebhardt, P.A.  
P.O. Box 581415  
Minneapolis, MN 55458-1415  
Phone: (612) 305-1220  
Facsimile: (612) 305-1228  
Customer Number 26813



**26813**

PATENT TRADEMARK OFFICE

23 SEPT. 2002  
Date

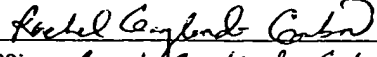
By: 

Kevin W. Raasch  
Reg. No. 35,651  
Direct Dial (612)305-1217

---

#### CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Attn: Box AF, Washington, D.C. 20231, on this 23<sup>rd</sup> day of September, 2002, at 3:57 p.m. (Central Time).

By:   
Name: Rachel Gaylord Guban

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**APPENDIX A - SPECIFICATION/CLAIM AMENDMENTS INCLUDING NOTATIONS  
TO INDICATE CHANGES MADE**

**Serial No.: 09/955,604**

**Docket No.: 49933 US 032**

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Amendments to the following are indicated by underlining what has been added and bracketing what has been deleted. The amendments have also been marked in bold typeface.

**In the Claims**

For convenience, all pending claims are shown below.

23. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, and the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second and third plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first and third plurality of angles, and wherein each of the cavities has a single opening.

24. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape and fourth plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second, third, and fourth plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first, third, and fourth plurality of angles, wherein at least one of the angles of the third plurality is

different from all of the angles of the first, second, and fourth plurality of angles, and wherein each of the cavities has a single opening.

30. A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first shape, a second group of cavities has a second shape, a third group of cavities has a third shape, wherein the first, second, and third shapes are all different, and wherein each of the cavities has a single opening.

31. A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first size, a second group of cavities has a second size, a third group of cavities has a third size, wherein the first, second, and third sizes are all different, and wherein each of the cavities has a single opening.

32. A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defined by substantially distinct and discernible boundaries which include substantially specific dimensions, wherein a first cavity has specific first dimensions, a second cavity has specific second dimensions, and a third cavity has specific third dimensions, each of said cavities has a boundary defined by at least four planar surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein at least one angle of intersection of said first cavity is different from all the angles of intersection of said second and third cavities, wherein at least one angle of intersection of said second cavity is different from all the angles of intersection of said first and third cavities, and wherein each of the cavities has a single opening.

56. Cancelled

57. Cancelled

63. Cancelled

64. Cancelled

89. The production tool of claim 23, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and second plurality of base edge lengths, wherein the third geometric shape includes a base and third plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, and wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths.

90. The production tool of claim 24, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and second plurality of base edge lengths, wherein the third geometric shape includes a base and third plurality of base edge lengths, wherein the fourth geometric shape includes a base and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, and wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths.

92. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a



base and second plurality of base edge lengths forming the base of the geometric shape, and the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening.

93. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape; the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape including a base and fourth plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths, and wherein each of the cavities has a single opening.

113. Cancelled

114. Cancelled

133. Cancelled

134. The production tool of claim 92, wherein the first, second, and third geometric shapes are pyramidal.

135. The production tool of claim 92, wherein the first, second, and third geometric shapes are truncated pyramidal.

136. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third row of cavities, wherein the cavities each have a geometric shape including a base and a plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first row of cavities is different from all the base edge lengths of the second and third rows of cavities, wherein at least one of the base edge lengths of the second row of cavities is different from all the base edge lengths of the first and third row of cavities, and wherein each of the cavities has a single opening.

137. Cancelled

138. The production tool of claim 136, wherein the geometric shape of the cavities in the first, second, and third rows are pyramidal.

139. The production tool of claim 136, wherein the geometric shape of the cavities in the first, second, and third rows are truncated pyramidal.

140. The production tool of claim 136, wherein the first, second, and third rows of cavities extend in parallel to one another.

141. The production tool of claim 136, wherein the base edge lengths of the first row of cavities have a first base edge length extending parallel to the first row and a second base edge length extending perpendicular to the first row, and wherein the second base length of all the cavities in the first row is the same.

142. The production tool of claim 141, wherein at least some of the first base lengths of the cavities in the first row are different from one another.

143. A production tool suitable for use in manufacturing an abrasive article comprising first, second, and third cavities, wherein the first cavity has a first geometric shape including a base and a first plurality of base edge lengths forming the base of the geometric shape, the second cavity has a second geometric shape including a base and a second plurality of base edge lengths forming the base of the geometric shape, and the third cavity has a third geometric shape including a base and a third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality of base edge lengths is different from all the base edge lengths of the second and third plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality of base edge lengths is different from all the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening.

144. Cancelled

145. The production tool of claim 143, wherein the geometric shapes of the first, second, and third cavities are pyramidal.

146. The production tool of claim 143, wherein the geometric shapes of the first, second, and third cavities are truncated pyramidal.

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**Confirmation No.: 1214**

**Filed: 19 September 2001**

**For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES**

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147. The production tool of claim 143, wherein the first cavity is located adjacent to the second cavity.

148. The production tool of claim 147, wherein the second cavity is located adjacent to the third cavity.

149. Cancelled

150. Cancelled

151. Cancelled

152. Cancelled

153. Cancelled

**APPENDIX VII**

Serial No.: 09/955,064

Docket No.: 49933US032

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Advisory Action mailed from the U.S. Patent and Trademark Office on October 4,  
2002.



**UNITED STATES PATENT AND TRADEMARK OFFICE**

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20230  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,604	09/19/2001	Timothy L. Hoopman	49933US032	1214

7390 10/04/2002  
Office of Intellectual Property Counsel  
3M Innovative Properties Company  
P.O. Box 33427  
St. Paul, MN 55133-3427

EXAMINER

LEYSON, JOSEPH S

ART UNIT PAPER NUMBER

1722

DATE MAILED: 10/04/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/955,604

Applicant(s)

HOOPMAN ET AL.

Examiner

Joseph Layson

Art Unit

1722

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 23 September 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): all the rejections to canceled claims 133, 137 and 144.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 23,24,30-32,88,90,92,93,134-136,138-143 and 145-148.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Attachment

1. The request for reconsideration has been considered but does not place this application in condition for allowance because the arguments filed on 23 September 2002 are not persuasive.

Applicant argues that each cavity having a single opening as disclosed the instant claims is not disclosed by the prior art and that Rochlis (-583) discloses a mold with a laminate construction with multiple openings including openings between layers of the laminate mold which are vent openings to allow air or gas to escape. The examiner agrees that Rochlis (-583) discloses a mold with a laminate construction with multiple openings. However, applicants do NOT preclude these openings in the instant claims. Note that the instant claims recite each mold cavity having a single opening. Clearly, each mold cavity in Rochlis(-583) is defined by a single opening. If the mold cavity had multiple openings, then multiple products produced by the multiple openings would be shown in the product. As clearly shown in Rochlis(-583) a single product is produced from each cavity. Therefore, applicant is arguing that the instant claims preclude other openings made by the laminate construction, but the instant claims do not require such limitations.

Applicant argues that Rochlis(-583) does not contain an enabling disclosure of how to make a mold or production tool



Art Unit: 1722

with only a single opening and actually teaches away from the claimed invention. Again, a mold having a single opening is NOT claimed. The instant claims recite each mold cavity having a single opening, as mentioned above.

Applicant argues that Rochlis(-583) emphasizes the importance of the openings between the mating surfaces of the laminations to allow for air or gas to be evolved in the molding or hardening procedure (col. 13, lines 70-73). However, Rochlis(-583) does not disclose that such openings between the mating surfaces to allow for air or gas to be evolved are CRITICAL for the operation of the apparatus.

2. The amendment filed on 23 September 2002 only cancels claims, and therefore the rejection of the remaining pending claims has NOT changed.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Leyson whose telephone number is (703) 308-2647. The examiner can normally be reached on M-F(8:30-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Silbaugh can be reached on (703) 308-3829. The fax phone numbers for the organization where this application or proceeding is assigned

Application/Control Number: 09/955,604

Page 4

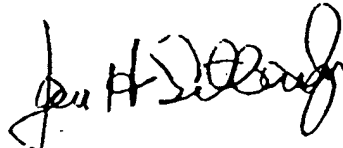
Art Unit: 1722

are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

j1

October 2, 2002

  
JAN H. SIDOROVICH  
SUPERVISORY SENIOR ENGINEER  
ART UNIT # 1722

10/03/02

**APPENDIX VIII**

Serial No.: 09/955,064

Docket No.: 49933US032

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Notice of Appeal to the Board of Patent Appeals and Interferences filed with the  
U.S. Patent and Trademark Office on October 22, 2002 via facsimile transmission.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	HOOPMAN et al.	)	Group Art Unit:	1722
		)		
Serial No.:	09/955,604	)	Examiner:	Joseph Leyson
Confirmation No.:	1214	)		
		)		
Filed:	19 September 2001	)		
		)		
For:	<u>TOOLS TO MANUFACTURE ABRASIVE ARTICLES</u>			

**NOTICE OF APPEAL**  
**TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Assistant Commissioner for Patents  
Attn: BOX AF  
Washington, D.C. 20231

Sir:

Applicants hereby appeal to the Board of Appeals from the decisions dated 22 July 2002 and 4 October 2002, of the Primary Examiner rejecting claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 of the above-identified application under 37 C.F.R. §§1.113 and 1.191. Please charge Deposit Account No. 13-4895 in the amount of \$320.00 to cover the Notice of Appeal fee.

Please charge any additional fees or credit any over-payment to PTO Deposit Account No. 13-4895.

**CERTIFICATE UNDER 37 C.F.R. 1.8:**

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Attn: BOX AF, Washington, D.C. 20231, on this 22nd day of October, 2002, at 3:34 p.m. (Central Time).

Signature: Rachel Gylind-Griban  
Name: Rachel Gylind-Griban

Respectfully submitted for  
HOOPMAN et al.  
By  
Muetting, Raasch & Gebhardt, P.A.  
P.O. Box 581415  
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Facsimile: (612)305-1228  
Customer Number 26813



26813

PATENT TRADEMARK OFFICE

Oct. 22, 2002  
Date

By: Ann M. Muetting  
Ann M. Muetting  
Reg. No. 33,977  
Direct Dial (612)305-1217

**APPENDIX IX**

Serial No.: 09/955,064

Docket No.: 49933US032

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Appellants' Brief on Appeal filed with the U.S. Patent and Trademark Office on  
December 23, 2002.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): HOOPMAN et al.	)	Group Art Unit: 1722
	)	
Serial No.: 09/955,604	)	Examiner: J. Leyson
Confirmation No.: 1214	)	
	)	
Filed: 19 September 2001	)	
	)	
For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES		

---

APPELLANTS' BRIEF ON APPEAL

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

This Brief is presented in support of the Appeal filed on October 22, 2002, from the final rejection of claims 23, 24, 30-32, 89, 90, 92, 93, and 133-148 of the above-identified application under 35 U.S.C. § 102 (23, 30, 31, 89, 92 and 133-148) and 35 U.S.C. § 103 (claims 23, 24, 31, 32, 89, 90, 92, 93 and 133-148), as set forth in the Final Office Action mailed July 22, 2002 and maintained in the Advisory Action mailed October 4, 2002.

This Brief is being submitted in triplicate, as set forth in 37 C.F.R. § 1.192(a). Applicants hereby authorize a charge to Deposit Account No. 13-4894 in the amount of \$320.00 for filing this Brief under 37 C.F.R. § 1.17(f).

I. REAL PARTY IN INTEREST

The real party in interest of the above-identified patent application is the assignee,

**APPELLANTS' BRIEF ON APPEAL**

Serial No.: 09/955,604

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Filed: 19 September 2002

For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES

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3M Innovative Properties Company..

**II. RELATED APPEALS AND INTERFERENCES**

There are no appeals or interferences known to Appellants' Representatives which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

**III. STATUS OF CLAIMS**

The claims in the present application are claims 23, 24, 30-32, 89, 90, 92, 93, and 133-148. The amendments made in the Amendment and Response filed September 23, 2002 (Appendix VI) will be entered herewith as indicated by the Examiner's Advisory Action (Appendix VII). Therefore, claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 (Appendix I), reflect the pending claims from the Amendment and Response filed September 23, 2002 (Appendix VI), which are the subject of this Appeal.

**IV. STATUS OF AMENDMENTS**

This application is a continuation of Serial No. 09/520,032, filed 6 March 2000, which is a divisional application of Serial No. 09/259,488, filed February 26, 1999, issued as U.S. Patent 6,076,248 on June 20, 2000, which is a divisional application of Serial No. 08/940,267, filed September 29, 1997, issued as 6,129,540 on October 10, 2000, which is a

continuation application of Serial No. 08/450,814, filed May 25, 1995, now abandoned, which is a divisional application of Serial No. 08/120,300, filed September 13, 1993, now abandoned.

A Communication (dated September 19, 2001, a copy enclosed, see Appendix II) was filed concurrently with the Request for Filing a Continuation Application Under Rule §1.53(b). A first Office Action (a copy enclosed, see Appendix III) was mailed January 30, 2002, in which claims 56, 57, 63, 64, 113, 114, and 149-153 were withdrawn from consideration in response to a Restriction Requirement by the Examiner. Claims 133, 137, and 144 were objected to under 37 U.S.C. § 1.75, claims 23, 30, 31, 89, 92, and 133-148 were rejected under 35 U.S.C. § 102(b), claims 23, 24, 31, 32, 89, 90, 92, 93, and 133-148 were rejected under 35 U.S.C. § 103(a), and claims 23, 24, 30-32, 89, 90, 92, 93, and 133-148 were provisionally rejected under an obviousness-type double patenting rejection.

An Amendment and Response (dated April 30, 2002, a copy enclosed, see Appendix IV) was filed in which claims 23, 24, 30-32, 56, 57, 63, 64, 92, 93, 113, 114, 136, 143, and 151-153 were amended to recite a production tool comprising a plurality of cavities, " . . . wherein each of the cavities has a single opening".

A final Office Action (a copy enclosed, see Appendix V) was mailed July 22, 2002, in which the 35 U.S.C. §§ 102, 103 and provisional obviousness-type double patenting rejections and the objection to claims 133, 137, and 144 were maintained as described in the first nonfinal Office Action mailed on January 30, 2001.



An Amendment and Response (dated September 23, 2002, a copy enclosed, see Appendix VI) cancelled claims 56, 57, 63, 64, 113, 114, 133, 137, 144, and 149-153. An Advisory Action (a copy enclosed, see Appendix VII) was mailed on October 4, 2002, in which the Examiner (1) maintained the rejections from the final Office Action (Appendix V); (2) indicated that all rejections to claims 133, 137, and 144 had been overcome; and (3) indicated that the proposed amendments in the Amendment and Response (Appendix VI) would be entered for purposes of Appeal. The pending claims (upon entry of the Amendment and Response dated September 23, 2002 (Appendix VI)) are claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143, and 145-148.

All amendments were entered.

#### **V. SUMMARY OF THE INVENTION**

Appellants' invention is directed to a production tool for manufacturing an abrasive article. The production tool includes a plurality of cavities, each of which has a single opening. Various embodiments of the production tool are claimed.

Support for the pending claims can be found throughout the specification, including the originally filed claims and drawings, as would be clearly understood by one of skill in the art. Examples of locations of support for the pending claims are listed in the table below.

Claim 23	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 20, line 27
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	through page 21, line 2; at page 26, line 16 through page 27, line 7; and in Figures 6 and 7 as originally filed.
Claim 24	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 20, line 27 through page 21, line 2; at page 26, line 16 through page 27, line 7; and in Figures 6 and 7 as originally filed.
Claim 30	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 26, line 16 through page 27, line 7; and in Figures 6 and 7 as originally filed.
Claim 31	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 26, line 16 through page 27, line 7; and in Figures 6 and 7 as originally filed.
Claim 32	Support can be found, e.g., at page 6, lines 18-25; at page 7, lines 6-15; at page 26, line 16 through page 27, line 7; in originally filed claim 1; and in Figures 6 and 7 as originally filed.
Claim 89, 92	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and in Figures 6 and 7 as originally filed.
Claim 90, 93	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and in Figures 6 and 7 as originally filed.
Claim 134	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 135	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16

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	through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 136	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; at page 22, lines 14-16; and in Figures 6 and 7 as originally filed.
Claim 138	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 139	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 140	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 141	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 142	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 143	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and in Figures 6 and 7 as originally filed.
Claim 145	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page

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	10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 146	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 147	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 148	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.

**VI. ISSUE(S) PRESENTED FOR REVIEW**

1. Whether claims 23, 30, 31, 89, 92, 134-136, 138-143, and 145-148 are anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 3,312,583 (Rochlis '583, Appendix VIII).

2. Whether claim 23, 24, 31, 32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 are obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 3,312,583 (Rochlis '583).

**VII. GROUPING OF CLAIMS**

For the purpose of this appeal, claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 stand or fall together.

## **VIII. ARGUMENT**

### **A. Claims 23, 30, 31, 89, 92, 134-136, 138-143, and 145-148 are not anticipated under 35 U.S.C. § 102(b) by Rochlis '583.**

The standard for anticipation is one of strict identity. "It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention . . . ."

Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

"In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure' . . . ." In re Hoeksema, 399 F.2d 269, 158 U.S.P.Q. 596, 600 (CCPA 1968). "A reference contains an 'enabling disclosure' if the public was in possession of the claimed invention before the date of invention." M.P.E.P. § 2121.01.

#### **1. Rochlis '583 does not disclose every element of the claimed invention.**

Each of Appellants' independent claims recites a production tool for manufacturing an abrasive article having a plurality of cavities, each of which has a single opening. In contrast, the mold disclosed in Rochlis '583 requires a laminate construction with multiple openings (i.e., openings between the layers in addition to the opening through which mold material enters the cavity) (col. 3, lines 40-49). Specifically, these openings between the

mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). There is no disclosure in Rochlis '583, however, that any cavity, let alone each of the cavities, has only a single opening. That is, there is no disclosure that Rochlis '583 has laminated mold constructions without openings between the mating surfaces of the laminations. Furthermore, there is no disclosure that Rochlis '583 has mold constructions with a single opening.

In the Advisory Action (Appendix VII), the Examiner alleged that Appellants do not preclude multiple openings in the instant claims. This is respectfully traversed. Appellants' claims recite that each cavity has a single opening. According to the Random House College Dictionary, "single" is defined as "one only; only one in number" (Appendix IX).

Appellants also traverse the assertion that the vent openings are not part of the mold cavities. Rochlis '583 clearly states that the vent openings are provided to prevent entrapment of gas "in the mold cavity in a manner to possibly alter the shape or size of the pile elements" (column 3, lines 47-48). In other words, the vent openings allow gas to escape from the cavities to allow them to fill properly. As a result, any assertion that the vent openings are not located in the cavities is simply not supported by Rochlis '583 and must be withdrawn.

**2. Rochlis '583 does not contain an enabling disclosure.**

As stated above, Rochlis '583 does not disclose a production tool with any cavity,

let alone each of a plurality of cavities, having only a single opening. Furthermore, Rochlis '583 does not teach how one of skill in the art would make a production tool for manufacturing an abrasive article with even one cavity having a single opening. Rochlis '583 is enabling for a laminated mold construction that includes openings between the mating surfaces of the laminations. There is no enabling disclosure in Rochlis '583 of how one of skill in the art would make a mold or production tool with only a single opening.

Although in the Advisory Action (Appendix VII), the Examiner alleges that Rochlis '583 does not disclose that such openings between the mating surfaces are not critical for the operation of the apparatus, Appellants submit that Rochlis '583 does not teach anything other than a laminate construction with such multiple openings.

**B. Claims 23, 24, 31, 32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 are not obvious under 35 U.S.C. § 103 over Rochlis '583.**

adhered to: "When applying 35 U.S.C. § 103, the following tenets of patent law must be

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined." M.P.E.P. § 2141 (citations omitted).

**1. Rochlis '583 does not teach or suggest the claimed invention.**

Rochlis '583 does not explicitly teach or suggest a production tool with any cavity having only a single opening, let alone each of a plurality of cavities having only a single opening. Furthermore, Rochlis '583 does not explicitly teach or suggest how one of skill in the art would make a production tool for manufacturing an abrasive article with a cavity having a single opening in each cavity. Rochlis '583 teaches how to make a laminated mold construction with openings between the mating surfaces of the laminations. From the disclosure of Rochlis '583, one of skill in the art would not know how to make a mold with only a single opening in each cavity.

**2. When considered as a whole, Rochlis '583 teaches away from the claimed invention.**

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 353 F.2d 238, 147 U.S.P.Q. 391, 393 (CCPA 1965). A single statement in the prior art reference should not be taken out of context and relied upon with the benefit of hindsight to show obviousness; rather, a reference should be considered as a whole. Bausch & Lomb, Inc. v. Barnes-Hind/Hycrocurve, Inc., 796 F.2d 443, 230 U.S.P.Q. 416, 419-



420 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987), on remand, 10 U.S.P.Q. 2d 1929 (N.D. Calif. 1989).

One of skill in the art would not be motivated to make a mold or production tool for manufacturing an abrasive article with a single opening as a result of the teachings of Rochlis '583. In fact, one of skill in the art would expect that a mold with only a single opening in each cavity would not be functional since the openings between the mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). In effect, Rochlis '583 teaches away from Appellants' invention when its disclosure is considered as a whole.

**3. It is impermissible to use hindsight as an obviousness test.**

Appellants respectfully submit that the use of Rochlis '583 alone in an obviousness rejection can only occur by the impermissible use of hindsight reasoning. In order to establish a *prima facie* case of obviousness, the references must teach or suggest all the claim limitations. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 at 93 ("Focusing on the obviousness of substitutions and differences instead of on the invention as a whole, . . . was a legally improper way to simplify the difficult determination of obviousness."). One cannot "simply [to] engage in a hindsight reconstruction of the claimed invention, using the Applicant's structure as a template and selecting elements from references to fill the gaps." In re

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Gorman, 933 F.2d 982, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). Further, both the suggestion for combining the teachings of the prior art to make the invention and the reasonable likelihood of its success must be founded in the prior art and not in the teachings of Appellants' disclosure. In re Dow Chem., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Here, the cited art neither suggests the combination of its teachings nor suggests the reasonable likelihood that such a combination would result in the present invention.

Appellants respectfully submit that the teachings of Rochlis '583 are woefully inadequate to teach or suggest any mold or production tool for manufacturing an abrasive article, wherein the tool has a plurality of cavities, each of which as a single opening. Impermissible hindsight was used to sift through the prior art in order to reconstruct the claimed invention using Appellants' specification as a template for selecting a particular teaching.

Furthermore, there is simply no teaching, suggestion, or incentive in Rochlis '583 to provide a motivation to modify its teachings to provide a mold or tool with cavities having only single openings, specifically in view of the fact that Rochlis '583 emphasizes the importance of the openings between the mating surfaces of the laminations (they allow for air or gas to be evolved in the molding or hardening procedure, col. 13, lines 70-73).

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C. Summary

For the many foregoing reasons, it is respectfully submitted that *prima facie* cases of anticipation and obviousness have not been established. It is earnestly requested that the Board reverse the Examiner's rejections, and that all of the claims be allowed. Appellants acknowledge the pending obviousness-type double patent rejection over copending Application No. 09/520,032 and, after patentability of the instant invention is confirmed, a Terminal Disclaimer will be filed if such a rejection is maintained. It is assumed that Appellants would be allowed to file a Terminal Disclaimer if needed.

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SIGNATURE

[Signature]

Dec. 23, 2002  
Date

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## APPENDIX I

Serial No.: 09/955,604

Docket No.: 49933US032

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Claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 are provided below.

23. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, and the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second and third plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first and third plurality of angles, and wherein each of the cavities has a single opening.

24. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape and fourth plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second, third, and fourth plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first, third, and fourth plurality of angles, wherein at least one of the angles of the third plurality is different from all of the angles of the first, second, and fourth plurality of angles, and wherein each of the cavities has a single opening.

30. A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first shape, a second group of cavities has a second shape, a third group of cavities has a third shape, wherein the first, second, and third shapes are all different, and wherein each of the cavities has a single opening.

31. A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first size, a second group of cavities has a second size, a third group of cavities has a third size, wherein the first, second, and third sizes are all different, and wherein each of the cavities has a single opening.

32. A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defined by substantially distinct and discernible boundaries which include substantially specific dimensions, wherein a first cavity has specific first dimensions, a second cavity has specific second dimensions, and a third cavity has specific third dimensions, each of said cavities has a boundary defined by at least four planar surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein at least one angle of intersection of said first cavity is different from all the angles of intersection of said second and third cavities, wherein at least one angle of intersection of said second cavity is different from all the angles of intersection of said first and third cavities, and wherein each of the cavities has a single opening.

89. The production tool of claim 23, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and

second plurality of base edge lengths, wherein the third geometric shape includes a base and third plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, and wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths.

90. The production tool of claim 24, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and second plurality of base edge lengths, wherein the third geometric shape includes a base and third plurality of base edge lengths, wherein the fourth geometric shape includes a base and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, and wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths.

92. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, and the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of

base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening.

93. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape including a base and fourth plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths, and wherein each of the cavities has a single opening.

134. The production tool of claim 92, wherein the first, second, and third geometric shapes are pyramidal.

135. The production tool of claim 92, wherein the first, second, and third geometric shapes are truncated pyramidal.

136. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third row of cavities, wherein the cavities each have a geometric shape including a base and a plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first row of cavities is different from all the base edge lengths of the second and third rows of cavities, wherein at least one of the base edge lengths of the second row of cavities is different from all the base edge lengths of the first and third row of cavities, and wherein each of the cavities has a single opening.

138. The production tool of claim 136, wherein the geometric shape of the cavities in the first, second, and third rows are pyramidal.

139. The production tool of claim 136, wherein the geometric shape of the cavities in the first, second, and third rows are truncated pyramidal.

140. The production tool of claim 136, wherein the first, second, and third rows of cavities extend in parallel to one another.

141. The production tool of claim 136, wherein the base edge lengths of the first row of cavities have a first base edge length extending parallel to the first row and a second base edge length extending perpendicular to the first row, and wherein the second base length of all the cavities in the first row is the same.

142. The production tool of claim 141, wherein at least some of the first base lengths of the cavities in the first row are different from one another.



143. A production tool suitable for use in manufacturing an abrasive article comprising first, second, and third cavities, wherein the first cavity has a first geometric shape including a base and a first plurality of base edge lengths forming the base of the geometric shape, the second cavity has a second geometric shape including a base and a second plurality of base edge lengths forming the base of the geometric shape, and the third cavity has a third geometric shape including a base and a third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality of base edge lengths is different from all the base edge lengths of the second and third plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality of base edge lengths is different from all the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening.

145. The production tool of claim 143, wherein the geometric shapes of the first, second, and third cavities are pyramidal.

146. The production tool of claim 143, wherein the geometric shapes of the first, second, and third cavities are truncated pyramidal.

147. The production tool of claim 143, wherein the first cavity is located adjacent to the second cavity.

148. The production tool of claim 147, wherein the second cavity is located adjacent to the third cavity.

**APPENDIX II**

Serial No.: 09/955,604

Docket No.: 49933US032

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Communication filed September 19, 2001.



PATENT  
Docket No. 49933US032

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): HOOPMAN et al. )  
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 )  
Serial No.: Unassigned )  
Serial No. of Parent: 09/520,032 )  
 )  
Confirmation No.: Unknown )  
 )  
Filing Date: Herewith )  
Filing Date of Parent: March 6, 2000 )  
 )  
For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES

Group Art Unit:  
Group Art Unit of Parent: 1722

Examiner: Unknown  
Examiner of Parent: Joseph Leyson

**COMMUNICATION**

Assistant Commissioner for Patents  
Attn: Box Patent Application  
Washington, D.C. 20231

Sir:

Prior to taking up the above-identified patent application, the Examiner is requested to consider the accompanying remarks. The pending claims are claims 23-24, 30-32, 56-57, 63-64, 89-90, 92-93, 113-114, and 133-153. Support for these claims can be found throughout the specification, including the originally filed claims and drawings, as would be clearly understood by one of skill in the art. Examples of locations of support for these new claims are listed in the table below.

Claim 1-21	Support can be found, e.g., in the originally filed claims in the parent application Serial No. 09/520,032 (filed March 6, 2000).
Claim 22	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 20, line 27 through page 21, line 2; and at page 26, line 16 through page 27, line 7.
Claim 23	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page

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	10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 20, line 27 through page 21, line 2; and at page 26, line 16 through page 27, line 7.
Claim 24	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 20, line 27 through page 21, line 2; and at page 26, line 16 through page 27, line 7.
Claim 25	Support can be found, e.g., at page 6, lines 18-25; at page 20, line 27 through page 21, line 18; and at page 26, line 16 through page 27, line 7.
Claim 26	Support can be found, e.g., at page 6, lines 18-25; at page 20, line 27 through page 21, line 18; and at page 26, line 16 through page 27, line 7.
Claim 27	Support can be found, e.g., at page 6, lines 18-25; at page 20, line 27 through page 21, line 18; and at page 26, line 16 through page 27, line 7.
Claim 28	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 19, lines 14-20; at page 20, line 27 through page 21, line 18; and at page 26, line 16 through page 27, line 7.
Claim 29	Support can be found, e.g., at page 6, lines 18-25; at page 10, lines 5-10; at page 11, lines 19-28; at page 21, lines 19-26; and at page 26, line 16 through page 27, line 7.
Claim 30	Support can be found, e.g., at page 6, line 18 through page 7, line 15; and at page 26, line 16 through page 27, line 7.
Claim 31	Support can be found, e.g., at page 6, line 18 through page 7, line 15; and at page 26, line 16 through page 27, line 7.
Claim 32	Support can be found, e.g., at page 6, lines 18-25; at page 7, lines 6-15; at page 26, line 16 through page 27, line 7; and in originally filed claim 1.
Claim 33-43	Support can be found, e.g., at page 28, lines 12-17; and above with respect to claims 22-32.
Claim 44-54	Support can be found, e.g., at page 28, lines 12-17; and above with respect to

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	claims 22-32.
Claim 55	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 19, lines 14-20; at page 20, line 27 through page 21, line 2; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 56	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 57	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 58	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 59	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 60	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 61	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 19, lines 14-20; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 62	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 10, lines 5-10; at page 11, lines 19-28; at page 21, lines 19-26; and at page 26, line 16 through page 27, line 7; and in originally filed claim 6.

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Claim 63	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 64	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 26, line 16 through page 27, line 7; and in originally filed claim 6.
Claim 65	Support can be found, e.g., at page 6, lines 18 through page 8, line 24; at page 26, line 16 through page 27, line 7; and in originally filed claims 1 and 6.
Claim 66-76	Support can be found, e.g., at page 28, lines 12-17; and above with respect to claims 55-65.
Claim 77-87	Support can be found, e.g., at page 28, lines 12-17; and above with respect to claims 55-65.
Claim 88, 91	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 19, lines 14-20; at page 20, line 27 through page 21, line 2; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 89, 92	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 90, 93	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 94	Support can be found, e.g., at page 6, lines 18-25; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 95	Support can be found, e.g., at page 6, lines 18-25; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 96	Support can be found, e.g., at page 6, lines 18-25; at page 20, line 27 through

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	page 21, line 18; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 97	Support can be found, e.g., at page 6, lines 18-25; at page 10, lines 5-10; at page 11, lines 19-28; at page 21, lines 19-26; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claims 98-104	Support can be found, e.g., at page 28, lines 12-17; and above with respect to claims 91-97.
Claims 105-111	Support can be found, e.g., at page 28, lines 12-17; and above with respect to claims 91-97.
Claim 112	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 19, lines 14-20; at page 20, line 27 through page 21, line 2; at page 26, line 16 through page 27, line 7; in originally filed claim 6; and at page 10, lines 23-27.
Claim 113	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; in originally filed claim 6; and at page 10, lines 23-27.
Claim 114	Support can be found, e.g., at page 6, line 18 through page 8, line 24; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; in originally filed claim 6; and at page 10, lines 23-27.
Claim 115	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; in originally filed claim 6; and at page 10, lines 23-27.
Claim 116	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 20, line 27 through page 21, line 18; at page 26, line 16 through page 27, line 7; in originally filed claim 6; and at page 10, lines 23-27.
Claim 117	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 20, line 27 through page 21, line 18; at page 26, line 16

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	through page 27, line 7; in originally filed claim 6; and at page 10, lines 23-27.
Claim 118	Support can be found, e.g., at page 6, lines 18-25; at page 7, line 16 through page 8, line 24; at page 10, lines 5-10; at page 11, lines 19-28; at page 21, lines 19-26; and at page 26, line 16 through page 27, line 7; in originally filed claim 6; and at page 10, lines 23-27.
Claim 119-125	Support can be found, e.g., at page 28, lines 12-17; and above with respect to claims 112-118.
Claim 126-132	Support can be found, e.g., at page 28, lines 12-17; and above with respect to claims 112-118.
Claim 133	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 134	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 135	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 136	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 137	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 138	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16



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	through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 139	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 140	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 141	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 142	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 143	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 144	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 145	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 146	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 147	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page

	10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 148	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 149	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 150	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.
Claim 151	Support can be found, e.g., at page 6, lines 18-25; at page 7, lines 6-15; at page 26, line 16 through page 27, line 7; and in originally filed claim 1.
Claim 152	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; at page 10, lines 23-27; and at page 22, lines 14-16.
Claim 153	Support can be found, e.g., at page 6, line 18 through page 7, line 15; at page 10, line 23 through page 11, line 2; at page 19, lines 14-20; at page 26, line 16 through page 27, line 7; and at page 10, lines 23-27.

### Remarks

In the parent application, Serial No. 09/520,032, filed March 6, 2000, claims 14-16, 18, 22-24, 29-32, 88-93, and 97 were rejected under §102(e) in view of Calhoun et al. (U.S. Patent No. 5,437,754). Such claims are being re-presented herein as claims 14-16, 18, 22-24, 29-32, 88-93, and 97, respectively, except claims 14-16, 18, 22, 29, 88, 91, and 97 have been cancelled in the accompanying Request for Filing a Continuation Application, and the following claims have been amended: 30 (to recite a third group of cavities having a third shape), 31 (to recite a third

group of cavities having a third size), 32 (to recite a third cavity having third dimensions). Additional amendments have been made, the majority of which are primarily typographical in nature.

Also being presented are new claims 133-148, which are directed to a production tool, as well as former claims 56-57, 63-64, and 113-114, which are all independent claims directed to a method of making a production tool, and new claims 149-153, which are also method claims.

In view of the §102(e) (anticipation) rejection in the parent application based on Calhoun et al. the following comments are being provided to explain why a §102(e) (anticipation) rejection based on Calhoun et al. would not be proper for the instant claims.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. §2131 (quoting Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the . . . claim." M.P.E.P. §2131 (quoting Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)).

"The standards of anticipation are strict. The invention must be disclosed within the four corners of a single reference. If a reference is silent or ambiguous with respect to an element or feature of the invention, that gap cannot be filled by an assumption or by combining one reference with another. An anticipating reference must teach the invention. It is not sufficient to point to silence or ambiguity after the invention and argue that the invention could be made out from the reference." Plastering Development Center, Inc. v. Perma Glas-Mesh Corp., 371 F.Supp. 939, 943, 944, 179 USPQ 838, 841 (N.D. Ohio 1973) (quoting General Tire & Rubber Co. v. The Firestone Tire & Rubber Co., 349 F.Supp. 345, 356, 174 USPQ 427, 442, 443 (N.D. Ohio 1972)). Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture. W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303 (Fed. Cir. 1983).

“Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Jamesbury Corp. v. Litton Industrial Products, 756 F.2d 1556, 1560, 225 USPQ 253, 256 (Fed. Cir. 1985) (quoting Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983)); Soundsciber Corp. v. U.S., 175 Ct.Cl. 644, 360 F.2d 954, 960, 148 USPQ 298, 301 (1966). A prior art disclosure that ‘almost’ meets that standard may render the claim invalid under §103; it does not ‘anticipate.’ Jamesbury Corp. v. Litton Industrial Products, 225 USPQ 253, 256 (Fed. Cir. 1985) (quoting from Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983)).

Although Calhoun et al. do generally disclose a production tool having three-dimensional cavities that can be of different sizes and/or shapes, such shapes being truncated cones, truncated pyramids, cubes, cylinders, elongated troughs, chevrons, intersecting grooves, hemispheres, and combinations thereof, there is no specific disclosure of Applicants’ invention as claimed. For example:

Calhoun et al. do not specifically teach the presence of at least three pluralities of cavities having a plurality of angles forming a geometric shape, wherein at least one of the angles of the first plurality is different from all the angles of each of the second and third plurality of angles, and at least one of the angles of the second plurality is different from all the angles of each of the first and third plurality of angles (see claims 23 and 56).

Calhoun et al. do not specifically teach the presence of at least four pluralities of cavities having a plurality of angles forming a geometric shape, wherein at least one of the angles of the first plurality is different from all the angles of each of the second, third, and fourth plurality of angles, at least one of the angles of the second plurality is different from all the angles of each of the first, third, and fourth plurality of angles, and at least one of the angles of the third plurality is different from all the angles of each of the first, second, and fourth plurality of angles (see claims 24 and 57).

Calhoun et al. do not specifically teach the presence of at least three pluralities of cavities having different shapes (see claims 30 and 63) or at least three pluralities of cavities having different

sizes (see claims 31 and 64).

Calhoun et al. do not specifically teach the presence of at least three cavities each having a boundary defined by at least four planar surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein at least one angle of intersection of the first cavity is different from all the angles of intersection of the second and third cavities, and at least one angle of intersection of the second cavity is different from all the angles of intersection of the first and third cavities (see claims 32 and 151).

Calhoun et al. do not specifically teach the presence of at least three pluralities of cavities having a plurality of base edge lengths forming the base of a geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all the base edge lengths of each of the second and third plurality of base edge lengths, and at least one of the base edge lengths of the second plurality is different from all the base edge lengths of each of the first and third plurality of base edge lengths (see claims 92 and 113).

Calhoun et al. do not specifically teach the presence of at least four pluralities of base edge lengths forming the base of a geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all the base edge lengths of each of the second, third, and fourth plurality of base edge lengths, at least one of the base edge lengths of the second plurality is different from all the base edge lengths of each of the first, third, and fourth plurality of base edge lengths, and at least one of the base edge lengths of the third plurality is different from all the base edge lengths of each of the first, second, and fourth plurality of base edge lengths (see claims 93 and 114).

Calhoun et al. do not specifically teach the presence of at least three rows of cavities each having a geometric shape including a base and a plurality of base edge lengths forming the base, wherein at least one of the base edge lengths of the first row of cavities is different from all the base edge lengths of each of the second and third row of cavities, and at least one of the base edge lengths of the second row of cavities is different from all the base edge lengths of each of

the first and third row of cavities (see claims 136 and 152).

Calhoun et al. do not specifically teach the presence of at least three cavities each of which has a geometric shape including a base and a plurality of base edge lengths forming the base, wherein at least one of the base edge lengths of the first plurality is different from all the base edge lengths of each of the second and third plurality of base edge lengths, and at least one of the base edge lengths of the second plurality is different from all the base edge lengths of each of the first and third plurality of base edge lengths (see claims 143 and 153).

Thus, Calhoun et al. do not teach each and every element of Applicants' claims. That is, there are claim elements recited in Applicants' independent claims missing from Calhoun et al. Thus, it is respectfully submitted that Calhoun et al. is not suitable for use in an anticipation rejection; rather, it is at most (if even that) suitable for an obviousness rejection.

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Serial No.: Unassigned  
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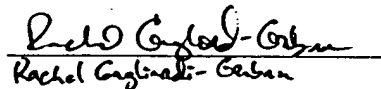
Page 13 of 13

### CONCLUSION

The application should now be in condition for examination and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

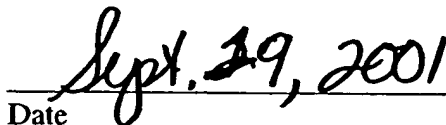
**CERTIFICATE UNDER 37 C.F.R. §1.10:**

The undersigned hereby certifies that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §1.10 on the date indicated below and is addressed to the Assistant Commissioner for Patents, Attn: Box Patent Application, Washington, D.C. 20231.

  
Rachel Gayland-Gebman

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Date of Deposit: September 19, 2001

  
Date

Respectfully submitted for

**HOOPMAN et al.**

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**APPENDIX III**

Serial No.: 09/955,604

Docket No.: 49933US032

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Office Action and Restriction Requirement mailed from the U.S. Patent and  
Trademark Office on January 30, 2002.





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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,604	09/19/2001	Timothy L. Hoopman	49933US032	1214

7590 01/30/2002

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St. Paul, MN 55133-3427

EXAMINER

LEYSON, JOSEPH S

ART UNIT	PAPER NUMBER
----------	--------------

1722

DATE MAILED: 01/30/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

in 2/7/02

**Office Action Summary**

Application No.

09/955,604

Applicant(s)

HOOPMAN ET AL

Examiner

Joseph Leyson

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23,24,30-32,56,57,63,64,89,90,92,93,113,114 and 133-153 is/are pending in the application.
- 4a) Of the above claim(s) 56,57,63,64,113,114 and 149-153 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23,24,30-32,89,90,92,93 and 133-148 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 23, 24, 30-32, 89, 90, 92, 93 and 133-148, drawn to a production tool, classified in class 425, subclass 470.
- II. Claims 56, 57, 63, 64, 113, 114 and 149-153, drawn to a method of making a production tool, classified in class 264, subclass 219.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as a process which does not include creating a design wherein the production tool is made in a random fashion by cutting randomly or by randomly placing elements on a substrate.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by

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their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Ann Muetting on 16 January 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 23, 24, 30-32, 89, 90, 92, 93 and 133-148. Affirmation of this election must be made by applicant in replying to this Office action. Claims 56, 57, 63, 64, 113, 114 and 149-153 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The disclosure is objected to because of the following informalities: The cross reference to the related applications on p. 1, lines 7-11, should be deleted in view of the cross reference inserted by the amendment in the transmittal papers filed on 19 September 2001.

Appropriate correction is required.

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7. Claims 133, 137 and 144 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 133 is redundant to claim 92 because if at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality and if at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality, then it is INHERENT that at least one of the base edge lengths of the third plurality is different from all the base edge lengths of the first and second plurality.

Claim 137 is redundant to claim 136 because if at least one of the base edge lengths of the first row is different from all of the base edge lengths of the second and third rows and if at least one of the base edge lengths of the second row is different from all of the base edge lengths of the first and third rows, then it is INHERENT that at least one of the base edge lengths of the third row is different from all the base edge lengths of the first and second rows.

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Claim 144 is redundant to claim 143 because if at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality and if at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality, then it is INHERENT that at least one of the base edge lengths of the third plurality is different from all the base edge lengths of the first and second plurality.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 23, 30, 31, 89, 92 and 133-148 are rejected under 35 U.S.C. 102(b) as being anticipated by Rochlis(-583).

Rochlis(-583) teaches a production tool suitable for use in manufacturing an abrasive article (col. 1, lines 50-56) which includes a plurality of cavities having different geometric shapes, angles and dimensions. The production tool can be a coating roll (fig. 19) or an etched (engraved) metal roll (col. 3, lines 52-63; col. 13, lines 15-17 and 62-67). The production

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tool can have parallel rows of cavities as shown in figs. 21 and 22 with a first plurality of rectangular cavities, a second plurality of circular cavities, and a third plurality of triangular cavities. At least one of the angles or base edge lengths of the first plurality is different from all the angles or base edge lengths of the second plurality and of the third plurality. At least one of the angles or base edge lengths of the second plurality is different from all the angles or base edge lengths of the first plurality and of the third plurality. Rochlis(-583) discloses that the cavities of the production tool can have different sizes (col. 2, lines 66-70; col. 6, lines 17-22; col. 9, line 61, to col. 10, line 52; i.e., different heights). Rochlis(-583) discloses that the cavities and products can have pyramidal or truncated pyramidal shapes (i.e., figs. 10-13; col. 13, lines 51-58). Rochlis(-583) discloses that the production tool can have a plurality of different types (shapes) of cavities (col. 13, lines 29-35). Figs. 21 and 22 show a first row of cavities with a rectangular cross section which defines a first base edge length extending parallel to the first row and a second base edge length extending perpendicular to the first row, wherein the second base length of all the cavities in the first row is the same (of course they also can be different sizes as mentioned above), and show a first

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rectangular cavity adjacent a second circular cavity, the second circular cavity being adjacent a third triangular cavity.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 23, 24, 31, 32, 89, 90, 92, 93 and 133-148 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rochlis(-583).



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The 102 rejection above is based upon the interpretation of the alternatives for the production tool disclosed by Rochlis(-583) as being anticipatory. If applicants believe that the disclosed alternatives are NOT anticipatory, then it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the production tool of Rochlis(-583) with the alternatives disclosed by Rochlis(-583) because Rochlis(-583) explicitly discloses that the production tool can be modified with such disclosed alternatives.

Rochlis(-583) discloses a production tool having 3 different types or shapes of cavities defining three pluralities or groups of cavities (figs. 21 and 22), but does NOT explicitly disclose a fourth plurality or group of cavities having a fourth different type of cavity. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the production tool to have four pluralities or group of cavities having four different types of cavity because Rochlis(-583) discloses that the production tool can have a plurality of different types of cavities and/or because Rochlis(-583: figs. 21 and 22) discloses a production tool example having not just two but three pluralities or groups of cavities having three different types of cavities. Note that different shapes will read on the respective instant claims.

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For example, if the three different types had cross sections of a square, a pentagon, and a hexagon, then each of the cavities would have a boundary defined by at least four surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein the at least one angle of intersection of the first cavity is different from all the angles of the second and third cavities, and wherein at least one angle of intersection of the second cavity is different from all the angles of intersection of the first and third cavities. Various different types would also provide different base edge lengths.

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 23, 24, 30-32, 89, 90, 92, 93 and 133-148 are provisionally rejected under the judicially created doctrine of

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obviousness-type double patenting as being unpatentable over claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time of the invention to eliminate the limitation of each cavity having a single opening of claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 because it is well within the artisan of ordinary skill to make integral that which was separable or to make separable that which was integral. Generally there is no invention in making integral that which was before in several parts, In re Lockhart, 90 USPQ 214; In re Larson, 144 USPQ 347. The mere fact that a given structure is integral does not preclude its consisting of various elements, Howard v. Detroit Stove Works, 150 U.S. 164.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Leyson whose telephone number is (703) 308-2647. The examiner can normally be reached on M-F(8:30-6:00) First Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (703) 308-3322. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*jl*

jl

January 18, 2002



NAM NGUYEN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

**Notice of References Cited**

Application/Control No.

09/955,604

Applicant(s)/Patent Under  
Reexamination  
HOOPMAN ET AL

Examiner

Joseph Leyson

Art Unit

1722

Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-3312583	04-1967	Rochlis	-/-
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

**APPENDIX IV**

Serial No.: 09/955,604

Docket No.: 49933US032

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Amendment and Response filed April 30, 2002..

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s):	Timothy L. HOOPMAN et al.	)	Group Art Unit:	1722
		)		
Serial No.:	09/955,604	)	Examiner:	Joseph Leyson
Confirmation No.:	1214	)		
		)		
Filed:	19 September 2001	)		
For:	TOOLS TO MANUFACTURE ABRASIVE ARTICLES			

**AMENDMENT AND RESPONSE**

Assistant Commissioner for Patents  
Washington D.C. 20231

Dear Sir:

In response to the Office Action mailed 30 January 2002, please amend the above-identified application as follows:

**In the Specification**

Please replace the paragraph beginning at page 1, line 7, with the following rewritten paragraph. Per 37 C.F.R. § 1.121, this paragraph is also shown in Appendix A with notations to indicate the changes made.

-- This application is a continuation of Application No. 09/520,032 (filed March 6, 2000), pending, which is a division of Application No. 09/259,488 (filed February 26, 1999), issued as U.S. Patent NO. 6,076,248, which application is a division of Application No. 08/940,267 (filed September 29, 1997), issued as U.S. Patent No. 6,129,540, which is a continuation of Application No. 08/450,814 (filed May 25, 1995), abandoned, which is a division of Application No. 08/120,300 (filed September 13, 1993), abandoned. --

**In the Claims**

Please amend claims 23, 24, 30-32, 56, 57, 63, 64, 92, 93, 113, 114, 136, 143, and 151-153. The amended claims are provided below in clean form. Per 37 C.F.R. § 1.121, amended claims are also shown in Appendix A with notations to indicate changes made (for convenience, all pending claims are provided in Appendix A).

23. **(Amended)** A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, and the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second and third plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first and third plurality of angles, and wherein each of the cavities has a single opening.

24. **(Amended)** A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape and fourth plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second, third, and fourth plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first, third, and fourth plurality of angles, wherein at least one of the angles of



the third plurality is different from all of the angles of the first, second, and fourth plurality of angles, and wherein each of the cavities has a single opening.

30. **(Amended)** A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first shape, a second group of cavities has a second shape, a third group of cavities has a third shape, wherein the first, second, and third shapes are all different, and wherein each of the cavities has a single opening.

31. **(Amended)** A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first size, a second group of cavities has a second size, a third group of cavities has a third size, wherein the first, second, and third sizes are all different, and wherein each of the cavities has a single opening.

32. **(Amended)** A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defined by substantially distinct and discernible boundaries which include substantially specific dimensions, wherein a first cavity has specific first dimensions, a second cavity has specific second dimensions, and a third cavity has specific third dimensions, each of said cavities has a boundary defined by at least four planar surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein at least one angle of intersection of said first cavity is different from all the angles of intersection of said second and third cavities, wherein at least one angle of intersection of said second cavity is different from all the angles of intersection of said first and third cavities, and wherein each of the cavities has a single opening.

56. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, and the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second and third plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first and third plurality of angles, and wherein each of the cavities has a single opening; and  
forming the production tool using the design.

57. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape and fourth plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second, third, and fourth plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first, third, and fourth plurality of angles, wherein at least one of the angles of the third plurality is different from all of the angles of the first, second, and fourth plurality of angles, and wherein each of the cavities has a single opening; and  
forming the production tool using the design.

63. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a plurality of cavities defining at least a first, a second group, and a third group, wherein a first group of cavities has a first shape, a second group of cavities has a second shape, a third group of cavities has a third shape, wherein the first, second, and third shapes are all different, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

64. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a plurality of cavities defining at least a first, a second group, and a third group, wherein a first group of cavities has a first size, a second group of cavities has a second size, a third group of cavities has a third size, wherein the first, second, and third sizes are all different, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

92. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, and the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening.

93. **(Amended)** A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape including a base and fourth plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths, and wherein each of the cavities has a single opening.

113. **(Amended)** A method of making a production tool, the method comprising:  
creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, and the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, wherein at least one of the base edge lengths of the second

plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening; and  
forming the production tool using the design.

114. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape including a base and fourth plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

136. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third row of cavities, wherein the cavities each have a geometric shape including a base and a plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first row of cavities is different from all the base edge lengths of the second and third rows of cavities, wherein at least one of the base edge lengths of

the second row of cavities is different from all the base edge lengths of the first and third row of cavities, and wherein each of the cavities has a single opening.

143. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising first, second, and third cavities, wherein the first cavity has a first geometric shape including a base and a first plurality of base edge lengths forming the base of the geometric shape, the second cavity has a second geometric shape including a base and a second plurality of base edge lengths forming the base of the geometric shape, and the third cavity has a third geometric shape including a base and a third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality of base edge lengths is different from all the base edge lengths of the second and third plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality of base edge lengths is different from all the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening.

151. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a plurality of cavities defined by substantially distinct and discernible boundaries which include substantially specific dimensions, wherein a first cavity has specific first dimensions, a second cavity has specific second dimensions, and a third cavity has specific third dimensions, each of said cavities has a boundary defined by at least four planar surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein at least one angle of intersection of said first cavity is different from all the angles of intersection of said second and third cavities, wherein at least one angle of intersection of said second cavity is different from all the angles of intersection of said first and third cavities, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

152. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, and third row of cavities, wherein the cavities each have a geometric shape including a base and a plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first row of cavities is different from all the base edge lengths of the second and third rows of cavities, wherein at least one of the base edge lengths of the second row of cavities is different from all the base edge lengths of the first and third row of cavities, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

153. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising first, second, and third cavities, wherein the first cavity has a first geometric shape including a base and a first plurality of base edge lengths forming the base of the geometric shape, the second cavity has a second geometric shape including a base and a second plurality of base edge lengths forming the base of the geometric shape, and the third cavity has a third geometric shape including a base and a third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality of base edge lengths is different from all the base edge lengths of the second and third plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality of base edge lengths is different from all the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

**Amendment and Response**

Timothy L. HOOPMAN et al.

Serial No.: 09/955,604

Confirm. No.: 1214

Filed: 19 September 2001

For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES

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**Remarks**

The Office Action mailed 30 January 2002 has been received and reviewed. Claims 23, 24, 30-32, 56, 57, 63, 64, 92, 93, 113, 114, 136, 143, and 151-153 have been amended. The pending claims are claims 23-24, 30-32, 56-57, 63-64, 89-90, 92-93, 113-114, and 133-153. Reconsideration and withdrawal of the rejections are respectfully requested.

Pursuant to the Examiner's request, the specification has been amended herein to correctly identify the cross reference information.

**Response to Restriction Requirement**

Pursuant to the telephone conversation between the Examiner and Applicants' Representative, Ann Muetting, election of Group I (claims 23, 24, 30-32, 89, 90, 92, 93, and 133-148) is hereby affirmed.

Applicants' Representatives reserve the right to pursue examination of the non-elected claims in continuation or divisional applications. Applicants respectfully request reconsideration of the restrictions in this case and submit that the inventions as claimed can be readily evaluated in one search without placing undue burden on the Examiner.

**The 35 U.S.C. § 102(b) Rejection**

Claims 23, 30-31, 89, 92, and 133-148 were rejected under 35 U.S.C. § 102(b) as being anticipated by Rochlis ('583). Applicants respectfully traverse this rejection.

Each of the independent claims recites that each of the cavities has a single opening. In contrast, the mold disclosed in Rochlis ('583) requires a laminate construction with multiple openings (i.e., one opening per layer). Specifically, these openings between the mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). There is no enabling disclosure in Rochlis ('583), however, that any cavity, let alone each of the cavities, has a single opening. That is, there is no enabling



disclosure that Rochlis ('583) has laminated mold constructions without openings between the mating surfaces of the laminations.

For at least the above reasons, Applicants submit that claims 23, 30-31, 89, 92, and 133-148 are patentable over Rochlis ('583). Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

### **The 35 U.S.C. § 103(a) Rejection**

Claims 23-24, 31-32, 89-90, 92-93, and 133-148 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rochlis ('583). Applicants respectfully traverse this rejection.

Again, each of the independent claims recites that each of the cavities has a single opening. In contrast, the mold disclosed in Rochlis ('583) requires a laminate construction with multiple openings (i.e., one opening per layer). Specifically, these openings between the mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). There is no enabling disclosure in Rochlis ('583), however, that any cavity, let alone each of the cavities, has a single opening. That is, there is no enabling disclosure that Rochlis ('583) has laminated mold constructions without openings between the mating surfaces of the laminations.

For at least the above reasons, claims 23-24, 31-32, 89-90, 92-93, and 133-148 are patentable over Rochlis ('583). Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

### **Double Patenting Rejection**

Claims 23-24, 30-32, 89-90, 92-93, and 133-148 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17, 20-21, 25-28, 33-54, 94-96, and 98-111 of copending Application No. 09/520,032. Upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response.

Amendment and Response  
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Summary

It is respectfully submitted that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for  
HOOPMAN et al.

By:

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April 30, 2002  
Date

AMM/kjm

CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on this 30<sup>th</sup> day of APRIL, 2002, at 3:10 pm (Central Time).

By:

Printed Name

Kelly J. McNulty

Kelly J. McNulty

**APPENDIX A - SPECIFICATION/CLAIM AMENDMENTS INCLUDING NOTATIONS  
TO INDICATE CHANGES MADE**

**Serial No.: 09/955,604  
Docket No.: 49933 US 032**

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Amendments to the following are indicated by underlining what has been added and bracketing what has been deleted. The amendments have also been shaded.

**In the Specification**

The paragraph beginning at page 1, line 7, has been replaced with the following paragraph:

**This application is a continuation of Application No. 09/520,432, filed March 20, 2000, pending, which is a division of Application No. 09/259,459, filed July 26, 1999, which is a continuation of Application No. 08/76,444, filed October 14, 1997, which is a continuation of Application No. 08/94,247, filed September 29, 1997, which is a continuation of Application No. 08/129,540, filed January 14, 1994, which is a continuation of Application No. 03/450,314, filed May 25, 1995, abandoned, which is a division of Application No. 08/124,300, filed September 13, 1994, abandoned.**

**In the Claims**

For convenience, all pending claims are shown below.

23. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, and the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second and third plurality of angles, [and] wherein at least one of the angles of the second plurality is different from all of the angles of the first and third plurality of angles, **and wherein each of the cavities has a single opening.**

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24. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape and fourth plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second, third, and fourth plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first, third, and fourth plurality of angles, [and] wherein at least one of the angles of the third plurality is different from all of the angles of the first, second, and fourth plurality of angles, and wherein each of the cavities has a single opening.

30. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first shape, a second group of cavities has a second shape, a third group of cavities has a third shape, [and] wherein the first, second, and third shapes are all different, and wherein each of the cavities has a single opening.

31. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first size, a second group of cavities has a second size, a third group of cavities has a third size, [and] wherein the first, second, and third sizes are all different, and wherein each of the cavities has a single opening.

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32. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defined by substantially distinct and discernible boundaries which include substantially specific dimensions, wherein a first cavity has specific first dimensions, a second cavity has specific second dimensions, and a third cavity has specific third dimensions, each of said cavities has a boundary defined by at least four planar surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein at least one angle of intersection of said first cavity is different from all the angles of intersection of said second and third cavities, [redacted] wherein at least one angle of intersection of said second cavity is different from all the angles of intersection of said first and third cavities [redacted] and wherein each of the cavities has a single opening.

56. (Amended) A method of making a production tool, the method comprising:  
creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, and the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second and third plurality of angles, [redacted] wherein at least one of the angles of the second plurality is different from all of the angles of the first and third plurality of angles [redacted] and wherein each of the cavities has a single opening; and  
forming the production tool using the design.

57. (Amended) A method of making a production tool, the method comprising:  
creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of

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cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape and fourth plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second, third, and fourth plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first, third, and fourth plurality of angles, [redacted] wherein at least one of the angles of the third plurality is different from all of the angles of the first, second, and fourth plurality of angles, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

63. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a plurality of cavities defining at least a first, a second group, and a third group, wherein a first group of cavities has a first shape, a second group of cavities has a second shape, a third group of cavities has a third shape, [redacted] wherein the first, second, and third shapes are all different, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

64. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a plurality of cavities defining at least a first, a second group, and a third group, wherein

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a first group of cavities has a first size, a second group of cavities has a second size, a third group of cavities has a third size, [REDACTED] wherein the first, second, and third sizes are all different [REDACTED] and wherein [REDACTED]; and

forming the production tool using the design.

89. The production tool of claim 23, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and second plurality of base edge lengths, wherein the third geometric shape includes a base and third plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, and wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths.

90. The production tool of claim 24, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and second plurality of base edge lengths, wherein the third geometric shape includes a base and third plurality of base edge lengths, wherein the fourth geometric shape includes a base and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, and wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths.

92. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each

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have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, and the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, [redacted] wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths ~~and wherein each of the cavities has a single opening.~~

93. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape including a base and fourth plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, [redacted] wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths ~~and wherein each of the cavities has a single opening.~~



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113. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, and the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, [and] wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths, ~~and wherein at least one of the cavities has a small opening~~; and

forming the production tool using the design.

114. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape including a base and fourth plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all

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of the base edge lengths of the first, third, and fourth plurality of base edge lengths, [redacted] wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths, [redacted]

[redacted]; and

forming the production tool using the design.

133. The production tool of claim 92, wherein at least one of the base edge lengths of the third plurality of base edge lengths is different from all the base edge lengths of the first and second plurality of base edge lengths.

134. The production tool of claim 92, wherein the first, second, and third geometric shapes are pyramidal.

135. The production tool of claim 92, wherein the first, second, and third geometric shapes are truncated pyramidal.

136. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third row of cavities, wherein the cavities each have a geometric shape including a base and a plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first row of cavities is different from all the base edge lengths of the second and third rows of cavities, [redacted] wherein at least one of the base edge lengths of the second row of cavities is different from all the base edge lengths of the first and third row of cavities, [redacted].

137. The production tool of claim 136, wherein at least one of the base edge lengths of the third row of cavities is different from all the base edge lengths of the first and second row of cavities.

138. The production tool of claim 136, wherein the geometric shape of the cavities in the first, second, and third rows are pyramidal.

139. The production tool of claim 136, wherein the geometric shape of the cavities in the first, second, and third rows are truncated pyramidal.

140. The production tool of claim 136, wherein the first, second, and third rows of cavities extend in parallel to one another.

141. The production tool of claim 136, wherein the base edge lengths of the first row of cavities have a first base edge length extending parallel to the first row and a second base edge length extending perpendicular to the first row, and wherein the second base length of all the cavities in the first row is the same.

142. The production tool of claim 141, wherein at least some of the first base lengths of the cavities in the first row are different from one another.

143. (Amended) A production tool suitable for use in manufacturing an abrasive article comprising first, second, and third cavities, wherein the first cavity has a first geometric shape including a base and a first plurality of base edge lengths forming the base of the geometric shape, the second cavity has a second geometric shape including a base and a second plurality of base edge lengths forming the base of the geometric shape, and the third cavity has a third geometric shape including a base and a third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality of base edge lengths is different from all the base edge lengths of the second and third plurality of base edge lengths, ~~and~~ wherein at

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least one of the base edge lengths of the second plurality of base edge lengths is different from all the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening.

144. The production tool of claim 143, wherein at least one of the base edge lengths of the third plurality of base edge lengths is different from all the base edge lengths of the first and second plurality of base edge lengths.

145. The production tool of claim 143, wherein the geometric shapes of the first, second, and third cavities are pyramidal.

146. The production tool of claim 143, wherein the geometric shapes of the first, second, and third cavities are truncated pyramidal.

147. The production tool of claim 143, wherein the first cavity is located adjacent to the second cavity.

148. The production tool of claim 147, wherein the second cavity is located adjacent to the third cavity.

149. The method claim of 56, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and second plurality of base edge lengths, wherein the third geometric shape includes a base and third plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, and wherein at least one of

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the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths.

150. The method claim of 57, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and second plurality of base edge lengths, wherein the third geometric shape includes a base and third plurality of base edge lengths, wherein the fourth geometric shape includes a base and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, and wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths.

151. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a plurality of cavities defined by substantially distinct and discernible boundaries which include substantially specific dimensions, wherein a first cavity has specific first dimensions, a second cavity has specific second dimensions, and a third cavity has specific third dimensions, each of said cavities has a boundary defined by at least four planar surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein at least one angle of intersection of said first cavity is different from all the angles of intersection of said second and third cavities, [and] wherein at least one angle of intersection of said second cavity is different from all the angles of intersection of said first and third cavities, and wherein each of the cavities has a single opening; and

forming the production tool using the design.

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152. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising a first, second, and third row of cavities, wherein the cavities each have a geometric shape including a base and a plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first row of cavities is different from all the base edge lengths of the second and third rows of cavities, [redacted] wherein at least one of the base edge lengths of the second row of cavities is different from all the base edge lengths of the first and third row of cavities [redacted]; and

forming the production tool using the design.

153. (Amended) A method of making a production tool, the method comprising:

creating a design for a production tool for manufacturing an abrasive article, the production tool comprising first, second, and third cavities, wherein the first cavity has a first geometric shape including a base and a first plurality of base edge lengths forming the base of the geometric shape, the second cavity has a second geometric shape including a base and a second plurality of base edge lengths forming the base of the geometric shape, and the third cavity has a third geometric shape including a base and a third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality of base edge lengths is different from all the base edge lengths of the second and third plurality of base edge lengths, [redacted] wherein at least one of the base edge lengths of the second plurality of base edge lengths is different from all the base edge lengths of the first and third plurality of base edge lengths [redacted]; and

[redacted]; and

forming the production tool using the design.

**APPENDIX V**

Serial No.: 09/955,604

Docket No.: 49933US032

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Office Action mailed from the United States Patent and Trademark Office on July  
22, 2002.



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,604	09/19/2001	Timothy L. Hoopman	49933US032	1214

7590

07/22/2002

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
P.O. Box 33427  
St. Paul, MN 55133-3427

EXAMINER

LEYSON, JOSEPH S

ART UNIT	PAPER NUMBER
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1722

6

DATE MAILED: 07/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



# Office Action Summary

Application No.

09/955,604

Applicant(s)

HOOPMAN ET AL.

Examiner

Joseph Leyson

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 23,24,30-32,56,57,63,64,89,90,92,93,113,114 and 133-153 is/are pending in the application.
- 4a) Of the above claim(s) 56,57,63,64,113,114 and 149-153 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23,24,30-32,89,90,92,93 and 133-148 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

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1. Applicant's affirmation of the election with traverse of Group I, apparatus claims 23, 24, 30-32, 89, 90, 92, 93 and 133-148, in Paper No. 5 filed on 30 April 2002 is acknowledged. The traversal is on the ground(s) that the inventions as claimed can be readily evaluated in one search without undue burden on the Examiner. This is not found persuasive because the search and examination of both inventions would not be coextensive. The issues raised in the examination of apparatus claims are divergent from those raised in the examination of process claims. Further, while there may be some overlap in the searches of the two inventions, there is no reason to believe that the searches would be identical. Therefore, based on the additional work involved in searching and examining both distinct inventions together, restriction of the distinct inventions is clearly proper.

The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claims 56, 57, 63, 64, 113, 114 and 149-153 drawn to an invention nonelected with traverse. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

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3. Claims 133, 137 and 144 are objected to under 37

CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 133 is redundant to claim 92 because if at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality and if at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality, then it is INHERENT that at least one of the base edge lengths of the third plurality is different from all the base edge lengths of the first and second plurality.

Claim 137 is redundant to claim 136 because if at least one of the base edge lengths of the first row is different from all of the base edge lengths of the second and third rows and if at least one of the base edge lengths of the second row is different from all of the base edge lengths of the first and third rows, then it is INHERENT that at least one of the base edge lengths of the third row is different from all the base edge lengths of the first and second rows.

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Claim 144 is redundant to claim 143 because if at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality and if at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality, then it is INHERENT that at least one of the base edge lengths of the third plurality is different from all the base edge lengths of the first and second plurality.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 23, 30, 31, 89, 92 and 133-148 are rejected under 35 U.S.C. 102(b) as being anticipated by Rochlis(-583).

Rochlis(-583) teaches a production tool suitable for use in manufacturing an abrasive article (col. 1, lines 50-56) which includes a plurality of cavities having different geometric shapes, angles and dimensions. The production tool can be a coating roll (fig. 19) or an etched (engraved) metal roll (col. 3, lines 52-63; col. 13, lines 15-17 and 62-67). The production

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tool can have parallel rows of cavities as shown in figs. 21 and 22 with a first plurality of rectangular cavities, a second plurality of circular cavities, and a third plurality of triangular cavities. At least one of the angles or base edge lengths of the first plurality is different from all the angles or base edge lengths of the second plurality and of the third plurality. At least one of the angles or base edge lengths of the second plurality is different from all the angles or base edge lengths of the first plurality and of the third plurality. Rochlis(-583) discloses that the cavities of the production tool can have different sizes (col. 2, lines 66-70; col. 6, lines 17-22; col. 9, line 61, to col. 10, line 52; i.e., different heights). Rochlis(-583) discloses that the cavities and products can have pyramidal or truncated pyramidal shapes (i.e., figs. 10-13; col. 13, lines 51-58). Rochlis(-583) discloses that the production tool can have a plurality of different types (shapes) of cavities (col. 13, lines 29-35). Figs. 21 and 22 show a first row of cavities with a rectangular cross section which defines a first base edge length extending parallel to the first row and a second base edge length extending perpendicular to the first row, wherein the second base length of all the cavities in the first row is the same (of course they also can be different sizes as mentioned above), and show a first

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rectangular cavity adjacent a second circular cavity, the second circular cavity being adjacent a third triangular cavity. Each of the cavities has a single opening.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claims 23, 24, 31, 32, 89, 90, 92, 93 and 133-148 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rochlis(-583).

The 102 rejection above is based upon the interpretation of the alternatives for the production tool disclosed by Rochlis(-583) as being anticipatory. If applicants believe that the disclosed alternatives are NOT anticipatory, then it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the production tool of Rochlis(-583) with the alternatives disclosed by Rochlis(-583) because Rochlis(-583) explicitly discloses that the production tool can be modified with such disclosed alternatives.

Rochlis(-583) discloses a production tool, as mentioned above, having 3 different types or shapes of cavities defining three pluralities or groups of cavities (figs. 21 and 22), but does NOT explicitly disclose a fourth plurality or group of cavities having a fourth different type of cavity. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the production tool to have four pluralities or group of cavities having four different types of cavity because Rochlis(-583) discloses that the production tool can have a plurality of different types of cavities and/or because Rochlis(-583: figs. 21 and 22) discloses

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a production tool example having not just two but three pluralities or groups of cavities having three different types of cavities. Note that different shapes will read on the respective instant claims. For example, if the three different types had cross sections of a square, a pentagon, and a hexagon, then each of the cavities would have a boundary defined by at least four surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein the at least one angle of intersection of the first cavity is different from all the angles of the second and third cavities, and wherein at least one angle of intersection of the second cavity is different from all the angles of intersection of the first and third cavities. Various different types would also provide different base edge lengths.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).



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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 23, 24, 30-32, 89, 90, 92, 93 and 133-148 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 in view of Rochlis(-583). Claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 disclose the production tool substantially as instantly claimed. Rochlis(-583) discloses a production tool as mentioned above. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify the production tool of claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 such that the cavities have a first, second, third, or more plurality of cavities, each plurality having a different shape because such a modification would produce a product having a first, second, third, or more plurality of different shapes on the product as disclosed by Rochlis(-583). Note that the possible different shapes and combinations thereof disclosed by Rochlis(-583) would provide the dimensions, planar surfaces, angles, edges, boundaries and shapes as recited by the instant claims.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Applicant's arguments with respect to the instant claims have been considered but are moot in view of the new ground(s) of rejection.

Applicants argue that Rochlis(-583) does not disclose each cavity having a single opening. The examiner respectfully disagrees. The examiner does agree that the mold disclosed by Rochlis(-583) in figs. 21 and 22 is a laminate construction and that each layer has multiple openings. The multiple openings of each layer correspond to the multiple cavities. And, when the layers are assembled to form the mold, corresponding multiple openings define a single cavity having a single opening. Thus, the layers separately have multiple openings, whereas a single cavity has a single opening. If there are any openings between the layers, they are used for venting. These vent openings are part of the mold, and are NOT part of the mold cavity.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Leyson whose telephone number is (703) 308-2647. The examiner can normally be reached on M-F(8:30-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Silbaugh can be reached on (703) 308-3829. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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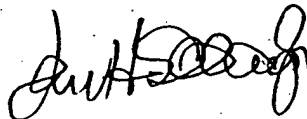
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*ja*

jl

July 18, 2002



JAN H. SILBAUGH  
SUPERVISORY PATENT EXAMINER  
ART UNIT 1722

07/18/02

**APPENDIX VI**

Serial No.: 09/955,604

Docket No.: 49933US032

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Amendment and Response Under 37 C.F.R. 1.116 transmitted on September 23,  
2002 via facsimile transmission.

**OFFICIAL**  
Expedited Examining Procedure  
Group 1722

**PATENT**  
Docket No. 49933US032

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): Timothy L. HOOPMAN et al.)	Group Art Unit: 1722
)	
Serial No.: 09/955,604	)
Confirmation No.: 1214	)
)	
Filed: 19 September 2001	)
)	
For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES	

**AMENDMENT AND RESPONSE UNDER 37 CFR §1.116**

Assistant Commissioner for Patents  
**Attn: BOX AF**  
Washington D.C. 20231

Dear Sir:

In response to the Final Office Action mailed 22 July 2002, please amend the above-identified application as follows:

**In the Claims**

Please cancel claims 56, 57, 63, 64, 113, 114, 133, 137, 144, and 149-153.

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Filed: 19 September 2001

For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES

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### **Remarks**

The Final Office Action mailed 22 July 2002 has been received and reviewed.

Claims 56, 57, 63, 64, 113, 114, 133, 137, 144, and 149-153 having been cancelled, the pending claims are claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143, and 145-148.

Reconsideration and withdrawal of the rejections in view of the cancellation of the claims above-indicated and the following comments are respectfully requested.

### **Obviousness-Type Double Patenting Rejection**

Claims 23, 24, 30-32, 89-90, 92, 93 and 133-148 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of co-pending application No. 09/520,032 in view of Rochlis (U.S. Patent No. 3,312,583). The cancellation of claims 133, 137, and 144 renders the rejection as to these claims moot. As to the remaining claims, upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response.

### **The 37 U.S.C. §1.75 Objection**

The Examiner objected to claims 133, 137, and 144 under 37 U.S.C. §1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicants do not agree that claims 133, 137, and 144 are of improper dependent form. However, in the interest of furthering prosecution of the application, these claims have been cancelled.

Withdrawal of the objection is respectfully requested.

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**The 35 U.S.C. §102 Rejection**

The Examiner rejected claims 23, 30, 31, 89, 92, and 133-148 under 35 U.S.C. §102(b) as being anticipated by Rochlis (U.S. Patent No. 3,312,583).

Applicants submit that the cancellation of claims 133, 137, and 144 renders the rejection as to these claims moot. As to claims 23, 30, 31, 89, 92, 134-136, 138-143, and 145-148, Applicants respectfully traverse this rejection.

Applicants' invention is directed to a production tool for manufacturing an abrasive article. The production tool includes a plurality of cavities, each of which has a single opening. Various embodiments of the production tool are claimed.

**Claims 23, 30, 31, 89, 92, 134-136, 138-143, and 145-148 are not anticipated under 35 U.S.C. § 102(b) by Rochlis '583.**

The standard for anticipation is one of strict identity. "It is axiomatic that for prior art to anticipate under § 102 it has to meet every element of the claimed invention . . . ."

Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

"In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure' . . . ." In re Hoeksema, 399 F.2d 269, 158 U.S.P.Q. 596, 600 (CCPA 1968). "A reference contains an 'enabling disclosure' if the public was in possession of the claimed invention before the date of invention." M.P.E.P. § 2121.01.

**1. Rochlis '583 does not disclose every element of the claimed invention.**

Each of Applicants' independent claims recites a production tool for manufacturing an abrasive article having a plurality of cavities, each of which has a single



opening. In contrast, the mold disclosed in Rochlis '583 requires a laminate construction with multiple openings (i.e., openings between the layers in addition to the opening through which mold material enters the cavity) (col. 3, lines 40-49). Specifically, these openings between the mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). There is no disclosure in Rochlis '583, however, that any cavity, let alone each of the cavities, has only a single opening. That is, there is no disclosure that Rochlis '583 has laminated mold constructions without openings between the mating surfaces of the laminations. Furthermore, there is no disclosure that Rochlis '583 has mold constructions with a single opening in each cavity.

Applicants also traverse the assertion that the vent openings are not part of the mold cavities. Rochlis '583 clearly states that the vent openings are provided to prevent entrapment of gas "in the mold cavity in a manner to possibly alter the shape or size of the pile elements" (column 3, lines 47-48). In other words, the vent openings allow gas to escape from the cavities to allow them to fill properly. As a result, any assertion that the vent openings are not located in the cavities is simply not supported by Rochlis '583 and must be withdrawn.

**2. Rochlis '583 does not contain an enabling disclosure.**

As stated above, Rochlis '583 does not disclose a production tool with any cavity, let alone each of a plurality of cavities, having only a single opening. Furthermore, Rochlis '583 does not teach how one of skill in the art would make a production tool for manufacturing an abrasive article with even one cavity having a single opening. Rochlis '583 is enabling for a laminated mold construction that includes openings between the mating surfaces of the laminations. There is no enabling disclosure in Rochlis '583 of how one of skill in the art would make a mold or production tool with only a single opening.

**The 35 U.S.C. §103 Rejection**

The Examiner rejected claims 23, 24, 31, 32, 89, 90, 92, 93, and 133-148 under 35 U.S.C. §103(a) as being unpatentable over Rochlis (U.S. Patent No. 3,312,583).

Applicants submit that the cancellation of claims 133, 137, and 144 renders the rejection as to these claims moot. As to claims 23, 24, 31, 32, 89, 90, 92, 93, 134-136, 138-143, and 145-148, Applicants respectfully traverse this rejection.

**Claims 23, 24, 31, 32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 are not obvious under 35 U.S.C. § 103 over Rochlis '583.**

"When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined." M.P.E.P. § 2141 (citations omitted).

**1. Rochlis '583 does not teach or suggest the claimed invention.**

Rochlis '583 does not explicitly teach or suggest a production tool with any cavity having only a single opening, let alone each of a plurality of cavities having only a single opening. Furthermore, Rochlis '583 does not explicitly teach or suggest how one of skill in the art would make a production tool for manufacturing an abrasive article with a cavity having a single opening in each cavity. Rochlis '583 teaches how to make a laminated mold construction with openings between the mating surfaces of the laminations. From the disclosure of Rochlis '583, one of skill in the art would not know how to make a mold with only a single opening in each cavity.

Applicants also submit that the Office Action fails to establish a prima facie case of obviousness as no motivation is identified as to why one of skill in the art would modify the teachings of Rochlis '583 to reach the claimed invention.

**2. When considered as a whole, Rochlis '583 teaches away from the claimed invention.**

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 353 F.2d 238, 147 U.S.P.Q. 391, 393 (CCPA 1965). A single statement in the prior art reference should not be taken out of context and relied upon with the benefit of hindsight to show obviousness; rather, a reference should be considered as a whole. Bausch & Lomb, Inc. v. Barnes-Hind/Hycrocurve, Inc., 796 F.2d 443, 230 U.S.P.Q. 416, 419-420 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987), on remand, 10 U.S.P.Q. 2d 1929 (N.D. Calif. 1989).

One of skill in the art would not be motivated to make a mold or production tool for manufacturing an abrasive article with a single opening as a result of the teachings of Rochlis '583. In fact, one of skill in the art would expect that a mold with only a single opening in each cavity would not be functional since the openings between the mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). In effect, Rochlis '583 teaches away from Applicants' invention when its disclosure is considered as a whole.

**3. It is impermissible to use hindsight as an obviousness test.**

Applicants respectfully submit that the use of Rochlis '583 alone in an obviousness rejection can only occur by the impermissible use of hindsight reasoning. In order

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Confirmation No.: 1214

Filed: 19 September 2001

For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES

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to establish a *prima facie* case of obviousness, the references must teach or suggest all the claim limitations. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 at 93 ("Focusing on the obviousness of substitutions and differences instead of on the invention as a whole, . . . was a legally improper way to simplify the difficult determination of obviousness."). One cannot "simply [to] engage in a hindsight reconstruction of the claimed invention, using the Applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 933 F.2d 982, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). Further, both the suggestion for combining the teachings of the prior art to make the invention and the reasonable likelihood of its success must be founded in the prior art and not in the teachings of Applicants' disclosure. In re Dow Chem., 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Here, the cited art neither suggests the combination of its teachings nor suggests the reasonable likelihood that such a combination would result in the present invention.

Applicants respectfully submit that the teachings of Rochlis '583 are woefully inadequate to teach or suggest any mold or production tool for manufacturing an abrasive article, wherein the tool has a plurality of cavities, each of which as a single opening. Impermissible hindsight was used to sift through the prior art in order to reconstruct the claimed invention using Applicants' specification as a template for selecting a particular teaching.

Furthermore, there is simply no teaching, suggestion, or incentive in Rochlis '583 to provide a motivation to modify its teachings to provide a mold or tool with cavities having only single openings, specifically in view of the fact that Rochlis '583 emphasizes the importance of the openings between the mating surfaces of the laminations (they allow for air or gas to be evolved in the molding or hardening procedure, col. 13, lines 70-73).

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### Summary

For the many foregoing reasons, it is respectfully submitted that the pending claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 are in condition for allowance and notification to that effect is respectfully requested.

The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for  
HOOPMAN et al.

By

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**26813**

PATENT TRADEMARK OFFICE

23 SEPT. 2002

Date

By: 

Kevin W. Raasch

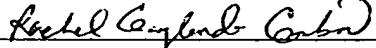
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#### CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Attn: Box AF, Washington, D.C. 20231, on this 23<sup>rd</sup> day of September, 2002, at 3:57 p.m. (Central Time).

By:   
Name: Rachel Gaylord Guban

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**APPENDIX A - SPECIFICATION/CLAIM AMENDMENTS INCLUDING NOTATIONS  
TO INDICATE CHANGES MADE**

**Serial No.: 09/955,604**

**Docket No.: 49933 US 032**

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Amendments to the following are indicated by underlining what has been added and bracketing what has been deleted. The amendments have also been marked in bold typeface.

**In the Claims**

For convenience, all pending claims are shown below.

23. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, and the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second and third plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first and third plurality of angles, and wherein each of the cavities has a single opening.

24. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape and first plurality of angles forming the geometric shape, the second plurality of cavities each have a second geometric shape and second plurality of angles forming the geometric shape, the third plurality of cavities each have a third geometric shape and third plurality of angles forming the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape and fourth plurality of angles forming the geometric shape, wherein at least one of the angles of the first plurality is different from all of the angles of the second, third, and fourth plurality of angles, wherein at least one of the angles of the second plurality is different from all of the angles of the first, third, and fourth plurality of angles, wherein at least one of the angles of the third plurality is

different from all of the angles of the first, second, and fourth plurality of angles, and wherein each of the cavities has a single opening.

30. A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first shape, a second group of cavities has a second shape, a third group of cavities has a third shape, wherein the first, second, and third shapes are all different, and wherein each of the cavities has a single opening.

31. A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defining at least a first, a second, and a third group, wherein a first group of cavities has a first size, a second group of cavities has a second size, a third group of cavities has a third size, wherein the first, second, and third sizes are all different, and wherein each of the cavities has a single opening.

32. A production tool suitable for use in manufacturing an abrasive article comprising a plurality of cavities defined by substantially distinct and discernible boundaries which include substantially specific dimensions, wherein a first cavity has specific first dimensions, a second cavity has specific second dimensions, and a third cavity has specific third dimensions, each of said cavities has a boundary defined by at least four planar surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein at least one angle of intersection of said first cavity is different from all the angles of intersection of said second and third cavities, wherein at least one angle of intersection of said second cavity is different from all the angles of intersection of said first and third cavities, and wherein each of the cavities has a single opening.

56. Cancelled

57. Cancelled

63. Cancelled

64. Cancelled

89. The production tool of claim 23, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and second plurality of base edge lengths, wherein the third geometric shape includes a base and third plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, and wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths.

90. The production tool of claim 24, wherein the first geometric shape includes a base and first plurality of base edge lengths, wherein the second geometric shape includes a base and second plurality of base edge lengths, wherein the third geometric shape includes a base and third plurality of base edge lengths, wherein the fourth geometric shape includes a base and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, and wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths.

92. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a



base and second plurality of base edge lengths forming the base of the geometric shape, and the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second and third plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening.

93. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, third, and fourth plurality of cavities, wherein the first plurality of cavities each have a first geometric shape including a base and first plurality of base edge lengths forming the base of the geometric shape, the second plurality of cavities each have a second geometric shape including a base and second plurality of base edge lengths forming the base of the geometric shape, the third plurality of cavities each have a third geometric shape including a base and third plurality of base edge lengths forming the base of the geometric shape, and the fourth plurality of cavities each have a fourth geometric shape including a base and fourth plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality is different from all of the base edge lengths of the second, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality is different from all of the base edge lengths of the first, third, and fourth plurality of base edge lengths, wherein at least one of the base edge lengths of the third plurality is different from all of the base edge lengths of the first, second, and fourth plurality of base edge lengths, and wherein each of the cavities has a single opening.

113. Cancelled

114. Cancelled

133. Cancelled

134. The production tool of claim 92, wherein the first, second, and third geometric shapes are pyramidal.

135. The production tool of claim 92, wherein the first, second, and third geometric shapes are truncated pyramidal.

136. A production tool suitable for use in manufacturing an abrasive article comprising a first, second, and third row of cavities, wherein the cavities each have a geometric shape including a base and a plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first row of cavities is different from all the base edge lengths of the second and third rows of cavities, wherein at least one of the base edge lengths of the second row of cavities is different from all the base edge lengths of the first and third row of cavities, and wherein each of the cavities has a single opening.

137. Cancelled

138. The production tool of claim 136, wherein the geometric shape of the cavities in the first, second, and third rows are pyramidal.

139. The production tool of claim 136, wherein the geometric shape of the cavities in the first, second, and third rows are truncated pyramidal.

140. The production tool of claim 136, wherein the first, second, and third rows of cavities extend in parallel to one another.

141. The production tool of claim 136, wherein the base edge lengths of the first row of cavities have a first base edge length extending parallel to the first row and a second base edge length extending perpendicular to the first row, and wherein the second base length of all the cavities in the first row is the same.

142. The production tool of claim 141, wherein at least some of the first base lengths of the cavities in the first row are different from one another.

143. A production tool suitable for use in manufacturing an abrasive article comprising first, second, and third cavities, wherein the first cavity has a first geometric shape including a base and a first plurality of base edge lengths forming the base of the geometric shape, the second cavity has a second geometric shape including a base and a second plurality of base edge lengths forming the base of the geometric shape, and the third cavity has a third geometric shape including a base and a third plurality of base edge lengths forming the base of the geometric shape, wherein at least one of the base edge lengths of the first plurality of base edge lengths is different from all the base edge lengths of the second and third plurality of base edge lengths, wherein at least one of the base edge lengths of the second plurality of base edge lengths is different from all the base edge lengths of the first and third plurality of base edge lengths, and wherein each of the cavities has a single opening.

144. Cancelled

145. The production tool of claim 143, wherein the geometric shapes of the first, second, and third cavities are pyramidal.

146. The production tool of claim 143, wherein the geometric shapes of the first, second, and third cavities are truncated pyramidal.

Serial No.: 09/955,604

Confirmation No.: 1214

Filed: 19 September 2001

For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES

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147. The production tool of claim 143, wherein the first cavity is located adjacent to the second cavity.

148. The production tool of claim 147, wherein the second cavity is located adjacent to the third cavity.

149. Cancelled

150. Cancelled

151. Cancelled

152. Cancelled

153. Cancelled

**APPENDIX VII**

Serial No.: 09/955,064

Docket No.: 49933US032

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Advisory Action mailed from the U.S. Patent and Trademark Office on October 4,  
2002.



**UNITED STATES PATENT AND TRADEMARK OFFICE**

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United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,604	09/19/2001	Timothy L. Hoopman	49933US032	1214

7590 10/04/2002

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
P.O. Box 33427  
St. Paul, MN 55133-3427

EXAMINER

LEYSON, JOSEPH S

ART UNIT PAPER NUMBER

1722

DATE MAILED: 10/04/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/955,604

Applicant(s)

HOOPMAN ET AL.

Examiner

Joseph Layson

Art Unit

1722

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 23 September 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 708.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): all the rejections to canceled claims 133, 137 and 144.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 23,24,30-32,89,90,92,93,134-136,138-143 and 145-148.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Attachment

1. The request for reconsideration has been considered but does not place this application in condition for allowance because the arguments filed on 23 September 2002 are not persuasive.

Applicant argues that each cavity having a single opening as disclosed the instant claims is not disclosed by the prior art and that Rochlis (-583) discloses a mold with a laminate construction with multiple openings including openings between layers of the laminate mold which are vent openings to allow air or gas to escape. The examiner agrees that Rochlis (-583) discloses a mold with a laminate construction with multiple openings. However, applicants do NOT preclude these openings in the instant claims. Note that the instant claims recite each mold cavity having a single opening. Clearly, each mold cavity in Rochlis(-583) is defined by a single opening. If the mold cavity had multiple openings, then multiple products produced by the multiple openings would be shown in the product. As clearly shown in Rochlis(-583) a single product is produced from each cavity. Therefore, applicant is arguing that the instant claims preclude other openings made by the laminate construction, but the instant claims do not require such limitations.

Applicant argues that Rochlis(-583) does not contain an enabling disclosure of how to make a mold or production tool



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with only a single opening and actually teaches away from the claimed invention. Again, a mold having a single opening is NOT claimed. The instant claims recite each mold cavity having a single opening, as mentioned above.

Applicant argues that Rochlis(-583) emphasizes the importance of the openings between the mating surfaces of the laminations to allow for air or gas to be evolved in the molding or hardening procedure (col. 13, lines 70-73). However, Rochlis(-583) does not disclose that such openings between the mating surfaces to allow for air or gas to be evolved are CRITICAL for the operation of the apparatus.

2. The amendment filed on 23 September 2002 only cancels claims, and therefore the rejection of the remaining pending claims has NOT changed.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Leyson whose telephone number is (703) 308-2647. The examiner can normally be reached on M-F(8:30-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Silbaugh can be reached on (703) 308-3829. The fax phone numbers for the organization where this application or proceeding is assigned

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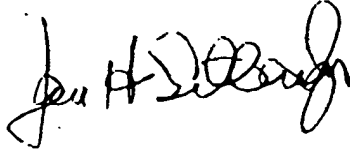
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are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

2  
jl

October 2, 2002

  
JAN H. SIDOROVICH  
SUPERVISORY ENGINEER  
ART UNIT 1722

10/03/02

## **APPENDIX IX**

Serial No.: 09/955,604

Docket No.: 49933US032

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1. Urdang et al., The Random House College Dictionary, New York, NY; Title page, Publication page, Table of Contents, and pg. 1228 (1973).



# College Dictionary

**Laurence Urdang**  
Editor in Chief

**Stuart Berg Flexner**  
Managing Editor

---

Based on

**The Random House  
Dictionary of the  
English Language**  
The Unabridged Edition

**Jess Stein**  
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# Preface

IN THE DECADES recently past, especially since World War II, the educational standards of the world have been extended to embrace more people than ever before. Literacy has increased enormously. Coupled with the technological advances of the period, the necessity for reading and study has resulted in an unprecedented interest in words.

The dictionary has traditionally been the only source of information on language for the majority of people. In it they expect to find how a word is spelled, how it may be hyphenated, how it is pronounced, what its various forms are, what its meanings are, and what its origins and history are. They also expect to find whether a word is technical or general, whether it can be used in polite company or not, and even whether someone who is called a certain word is justified in feeling offended. They want unfamiliar objects illustrated and particular places pinpointed on maps; they want biographical information, geographical, demographical, and political data, abbreviations, symbols, synonyms, antonyms, usage notes—in short, people expect to find condensed between the covers of a dictionary the knowledge of the world as reflected in their language. Above all, they demand that this knowledge be accurate and up to date. Indeed, why not? The dictionary is often the only reference book of any kind that many people ever own.

That these prodigious demands are met is, of course, no accident. A dictionary is the product of specialists, linguists, and highly trained editors who are devoted to researching language and information and to interpreting it and presenting it in understandable form.

*The Random House College Dictionary* is an abridgment of *The Random House Dictionary of the English Language—The Unabridged Edition*, and its style follows that of the *RHD*. No dictionary, no matter how extensive, could record the entire English language. It is obvious, then, that the editors of any dictionary are compelled to exercise discretion in what is to be included. The goal cannot be completeness: the goal must be judicious selectivity. There is no dearth of re-

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# THE FRANKLIN HOUSE College Dictionary

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1. pertaining to Ceylon, its native people, or their language. —n. 2. a member of the Sinhalese people. 3. an Indic language that is the language of most of Ceylon, including Colombo. Also, Sinhalese. [var. of *Sinhalese* < *Skt Sinhala* (Ceylon) < *sin* < *gal*].

**single** (sɪŋɡl̩), *adj.*, *v.*, *gled*, *-gling*, *n.* —*adj.* 1. only; only one in number; sole: a *single example*. 2. of, pertaining to, or suitable for one person only: a *single bed*. 3. unique; solitary: *He was the single survivor*. 4. unmarried. 5. pertaining to the unmarried state. 6. of one against one, as combat or fight. 7. consisting of only one part, element, or member: a *single lens*. 8. sincere; honest; undivided: *single devotion*. 9. separate; individual. 10. uniform; applicable to all. 11. (of a flower) having only one set of petals. 12. *Brit.* of only moderate strength or body, as ale or beer. 13. (of the eye) seeing rightly. —*v.* 14. to pick or choose out from others (usually *fol.* by *out*): *to single out a fact for special mention*. 15. *Baseball*, *a.* to cause the advance of (a base runner) by a one-base hit. *b.* to cause (a run) to be scored by a one-base hit (often *fol.* by *in*). —*n.* 16. *Baseball*, to make a one-base hit. 17. *Obs.* (of a horse) to go at single-foot. —*n.* 18. one person or thing; a single one. 19. an accommodation for one person, as a hotel room, cabin on a ship, etc. 20. Also called *one-base hit*. *Baseball*, a base hit that enables a batter to reach first base safely. 21. *singles*, (*construed as sing.*) a match with one player on each side. 22. *Golf*, twosome (def. 4). 23. *Cricket*, a hit for which one run is scored. 24. *Informal*, a one-dollar bill: *a five and five singles*. [late ME; ME *sengle* < MF < L *single* (us); see *SINGLE*] —*Syn.* 1. distinct, particular. 4. unwed. 14. select. 18. individual.

**single-act-ing** (sɪŋɡl̩ ˈæktɪŋ), *adj.* (of a reciprocating engine, pump, etc.) having pistons accomplishing work only in one direction. Cf. *double-acting* (def. 1).

**single-action** (sɪŋɡl̩ ˈækʃən), *adj.* (of a firearm) requiring the cocking of the hammer before firing each shot: a *single-action revolver*.

**single bond**, *Chem.* a chemical linkage consisting of one covalent bond between two atoms of a molecule, represented in chemical formulas by one line or two vertical dots, as C-H or C-H.

**single-breasted** (sɪŋɡl̩ ˈbreɪstɪd), *adj.* (of a garment, esp. a coat or jacket) having a single button or row of buttons in front for the center closing. Cf. *double-breasted*.

**single-cross** (sɪŋɡl̩ ˈkrɒs), *n.* *Genetics*, a cross between two inbred lines.

**single cut**, *Jewelry*, a simple form of brilliant cut, having eight facets above and eight facets below the girdle. Also called *half brilliant cut*.

**single-cut** (sɪŋɡl̩ ˈkʌt), *adj.* noting a file having a series of parallel cutting ridges in one direction only.

**single entry**, *Bookkeeping*, a simple accounting system noting only amounts owed by and due to a business. Cf. *double entry*. —*sin*/'gle-en/'try, *adj.*

**single file**, a line of persons or things arranged one behind the other: *Indian file*.

**single-foot** (sɪŋɡl̩ ˈfʊt), *n.* 1. *rack*. —*v.* 2. (of a horse) to go at a rack.

**single-handed** (sɪŋɡl̩ ˈhændɪd), *adj.* 1. accomplished or done by one person alone; unaided. 2. having, using, or requiring the use of only one hand or one person. —*adv.* 3. by oneself; alone; without aid. —*sin*/'gle-hand/'ed-ly, *adv.*

**single-hand-ed-ness**, *n.*

**single-hearted** (sɪŋɡl̩ ˈhɑːrtɪd), *adj.* sincere and undivided in feeling or spirit; dedicated.

**single-minded** (sɪŋɡl̩ ˈmaɪndɪd), *adj.* 1. having or showing a single aim or purpose: a *single-minded program*. 2. dedicated; steadfast. —*sin*/'gle-mind/'ed-ly, *adv.* —*sin*/'gle-mind/'ed-ness, *n.*

**single-ness** (sɪŋɡl̩ ˈnɪs), *n.* the state or quality of being single.

**single-phase** (sɪŋɡl̩ ˈfāz), *adj.* *Eled.* noting or pertaining to a circuit having an alternating current with one phase or with phases differing by 180°.

**single quotes**, one pair of single quotation marks, written as (') and used esp. for a quotation within another quotation: *He said, "I told you to say 'Open sesame' when you want to enter the mountain."* Cf. *double quotes*.

**single-shot** (sɪŋɡl̩ ˈʃɒt), *adj.* (of a firearm) requiring loading before each shot; not having a cartridge magazine.

**single-space** (sɪŋɡl̩ ˈspes), *v.*, *-spaced*, *-spacing*. —*v.* 1. to type (copy) on each line space. —*v.* 2. to type copy leaving no blank spaces between lines.

**single Span/ish bur/ton**, a tackle having a runner as well as the fall supporting the load. See *diag.* at *tackle*.

**single stand/ard**, 1. a single set of principles or rules applying to everyone, as a single moral code applying to both men and women. Cf. *double standard*. 2. *monometallism*.

**single-stick** (sɪŋɡl̩ ˈstɪk), *n.* 1. a short, heavy stick. 2. (formerly) a wooden stick held in one hand, used instead of a sword in fencing. *b.* fencing with such a stick.

**single-let** (sɪŋɡl̩ ˈlet), *n.* *Chiefly Brit.* a man's undershirt or jersey.

**single tape**, See under *magnetic tape*.

**single tax**, *Econ.* a tax, as on land, that constitutes the sole source of public revenue. —*sin*/'gle-tax/, *adj.*

**single-ton** (sɪŋɡl̩ ˈtɒn), *n.* 1. something occurring singly. 2. *Cards*, a card that is the only one of a suit in a hand.

**single-track** (sɪŋɡl̩ ˈtræk), *adj.* having a narrow scope; one-track: a *single-track mind*.

**single-tree** (sɪŋɡl̩ ˈtriː), *n.* *whiffletree*. [var. of *whiffletree*]

**single whip**, See under *whip* (def. 20). See *diag.* at *tackle*.

**single-ly** (sɪŋɡl̩ ˈli), *adv.* 1. apart from others; separately. 2. one at a time; as single units. 3. single-handed; alone. [ME *senglely*]

**single-song** (sɪŋɡl̩ ˈsɒŋ, -sɒŋ), *n.* 1. verse, or a piece of verse, of a jingling or monotonous character. 2. monotonous rhythmical cadence, tone, or sound. 3. *Brit.* a group sing. —*adj.* 4. monotonous in rhythm.

**single-spiel** (sɪŋɡl̩ ˈspiːl), *n.* *Ger.* *sin*/'shpɛl/, a German opera, esp. of the 18th century, using spoken dialogue. [C. G. lit. *single-play*]

**sin-gu-lar** (sɪŋɡl̩ ˈɡjʊlə), *adj.* 1. extraordinary; remarkable; exceptional: a *singular success*. 2. unusual or strange;

odd; different: *singular behavior*. 3. being the only one of its kind; unique: a *singular example*. 4. separate; individual.

**5. Gram.** noting or pertaining to a member of the category of number indicating that a word form has one referent or denotes one person, place, thing, or instance, as *boy*, a singular noun, or *goes*, a singular form of the verb. Cf. *dual* (def. 4), plural (def. 4). 6. *Logic*, of or pertaining to something individual, specific, or not general. 7. *Obs.* personal; private. 8. *Obs.* single. —*n.* *Gram.* 9. the singular number. 10. a form in the singular. [ME < L *singularis*]. See *SINGLE*, -*AR*]

**sin-gu-lar-ly**, *adv.* —*Syn.* 1-4. peculiar. 2. bizarre, queer, curious. 3. uncommon, rare. —*Ant.* 1. usual.

**sin-gu-lar-ize** (sɪŋɡl̩ ˈɡjʊlə raɪz/), *v.*, *-ized*, *-izing*. *Chiefly Brit.* singularize. —*sin*/'gu-lar-iz-/tion, *n.*

**sin-gu-lar-i-ty** (sɪŋɡl̩ ˈɡjʊlə riːti), *n.*, *pl.* -ties for 2. 1. the state, fact, or quality of being singular. 2. a singular, unusual, or unique quality. [ME *singularite* < LL *singularitas*]

**sin-gu-lar-ize** (sɪŋɡl̩ ˈɡjʊlə raɪz/), *v.*, *-ized*, *-izing*, to make singular. Also, esp. *Brit.*, *singularise*. —*sin*/'gu-lar-iz-/tion, *n.*

**sinh** (sɪŋ), *n.* *Math.* hyperbolic sine. [sin(ε) + H(TPERBOLIC)]

**Sin-ha-lese** (sɪn/'ha lez/, -lez), *adj.*, *n.*, *pl.* -lese. *Sinhalese*.

**Sin-i-cism** (sɪn/'sɪzəm), *n.* something characteristic of or peculiar to the Chinese. [Sinitic Chinese (< ML *Sinicus*) < Gk *Sinikos* < LGk *Sin(at)* the Chinese + -ikos (-ic) + -ism]

**Si-ning** (shɪ/'nɪŋ), *n.* a city in and the capital of Chinghai, in W. China, 300,000 (est. 1957). Also, *Hsining*.

**sin-ist-er** (sɪn/'ɪstər), *adj.* 1. threatening or portending evil, harm, or trouble; ominous. 2. malevolent; evilly intended. 3. *Heraldry*, noting the side of an escutcheon or achievement of arms that is to the left of the hypothetical bearer (opposed to *dexter*). 4. *Archaic*, of or on the left side; left. [late ME < L: on the left hand or side, hence unfavorable, injurious (from the Roman belief that unfavorable omens appear on one's left)] —*sin*/'is-ter-ly, *adv.* —*Syn.* 1. inauspicious, portentous. —*Ant.* 1. benign.

**sinistr-**, a learned borrowing from Latin meaning "left," "on the left," used in the formation of compound words: *sinistrous*. Also, esp. before a consonant, *sinistro-*. [C. L. *sinistr-*, *s.* of *sinister*]

**sin-is-tral** (sɪn/'ɪstrəl), *adj.* 1. of, pertaining to, or on the left side; left (opposed to *dextral*). 2. left-handed. [late ME < ML *sinistrālis*] —*sin*/'is-tral-ly, *adv.*

**sin-is-tro-gy-ra-tion** (sɪn/'ɪstrɔj rə/'ʃən, sɪ nɪs/'trɔ-), *n.* *Optics*, *Chem.* levorotation. —*sin*/'is-tro-gy-ric (sɪn/'ɪstrɔj rɪk), *adj.*

**sin-is-trorse** (sɪn/'ɪstrɔrs/, sɪ nɪs/'trɔrs, sɪn/'ɪstrɔrs), *adj.* *Bot.* (from a point of view at the center of the spiral) rising spirally from right to left, as a stem (opposed to *dextrorse*). [C. L. *sinistrorsus*], *lit.*, turned leftwards, contr. of \**sinistrorsus*, var. of \**sinistrorsus*. See *SINISTRO-*, *var.*]

**sin-is-trous** (sɪn/'ɪstrɔs), *adj.* 1. ill-omened; unlucky; disastrous. 2. *sinistral*; left. —*sin*/'is-trous-ly, *adv.*

**Sin-it-ic** (sɪn/'ɪtɪk), *n.* 1. a branch of Sino-Tibetan consisting of the various local languages and dialects whose speakers share literary Chinese as their standard language. —*adj.* 2. of or pertaining to the Chinese, their language, or their culture. [C. LL *Sin(ae)* the Chinese (< LGk *Sinai*) + -itic]

**sink** (sɪŋk), *v.*, *sank* or, often, *sunk*; *sunk* or *sunk-en*; *sink-ing*; *n.* —*v.* 1. to fall, drop, or descend gradually to a lower level. 2. to go down toward or below the horizon. 3. to slope downward; dip. 4. to displace the volume of an underlying substance or object and become submerged or partially submerged (often *fol.* by *in* or *into*): *The battleship sank within two hours. His foot sank in the mud.* 5. to fall or collapse slowly from weakness, fatigue, etc. 6. to become absorbed in or gradually to enter a state or condition (usually *fol.* by *in* or *into*): *to sink into slumber*. 7. to pass or fall into some lower state or condition. 8. to fall in physical strength or health. 9. to become lower in loudness, tone, or pitch. 10. to enter or permeate the mind; become known or understood (usually *fol.* by *in* or *into*): *I repeated it till the words sank in.* 11. to become hollow, as the cheeks. 12. to sit, recline, or lie (usually *fol.* by *down*, *in*, *on*, etc.): *He sank down on the bench.* —*v.* 13. to cause to fall, drop, or descend gradually. 14. to cause to become submerged. 15. to lower or depress the level of. 16. to bury, plant, or lay (a pipe, conduit, etc.) into or as into the ground. 17. to bring to a worse or lower state or status. 18. to reduce in amount, extent, intensity, etc. 19. to lower in loudness, tone, or pitch. 20. to invest in the hope of making a profit or gaining some other return. 21. to dig, bore, or excavate (a hole, shaft, well, etc.). —*n.* 22. a basin or receptacle connected with a water supply, used for washing. 23. a low-lying, poorly drained area where waters collect or disappear by sinking down into the ground or by evaporation. 24. sinkhole (def. 2). 25. a place of vice or corruption. 26. a drain or sewer. 27. any pond or pit for sewage or waste, as a cesspool or a pool for industrial wastes. [ME; OE *sinc(an)*; c. D *sinken*, G *sinken*, Icel *sökka*, Goth *singan*]

**sink-age** (sɪŋk/ɪdʒ), *n.* the act, process, or an amount of sinking.

**sink-er** (sɪŋk/ər), *n.* 1. a person or thing that sinks. 2. a person employed in sinking, as one who sinks shafts. 3. a weight, as of lead, for sinking a fishing line or net below the surface of the water. 4. *Slang*, a doughnut.

**sink-hole** (sɪŋk/'hɒl), *n.* 1. a hole formed in soluble rock by the action of water, serving to conduct surface water to an underground passage. 2. Also called *sink*, a depressed area in which waste or drainage collects. [ME]

**Sin-kiang** (sɪn/'kɪŋɡ/; Chin. *shín*/'kɪŋɡ/), *n.* the westernmost division of China, bordering Tibet, India, the Soviet Union, and Mongolia; formerly a province, 5,640,000 (est. 1957); 635,829 sq. mi. *Cap.*: Urumchi. Official name, *Sin-kiang-Uighur Auton/omous Re-gion* (sɪn/'kɪŋɡ/'wɛ/gə, -gər; Chin. *shín*/'kɪŋɡ/'wɛ/gə/ŋər).

**sink-ing fund**, a fund to extinguish an indebtedness, usually a bond issue.

**sink-ing spell**, a temporary decline, as in health.

**sin-less** (sɪn/'lis), *adj.* free from or without sin. [ME *sinles*, OE *synlās*]

**sin-ner** (sɪn/'ər), *n.* a person who sins; transgressor. [ME]

**APPENDIX X.**

Serial No.: 09/955,604

Docket No.: 49933US032

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1. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986) cert. denied, 480 U.S. 947 (1987).
2. In re Hoeksema, 399 F.2d 269, 158 U.S.P.Q. 596 (CCPA 1968).
3. M.P.E.P. § 2121.01.
4. M.P.E.P. § 2141.01.
5. In re Wesslau, 353 F.2d 238, 147 U.S.P.Q. 391 (CCPA 1965).
6. Bausch & Lomb, Inc. v. Barnes-Hind/Hycrocurve, Inc., 796 F.2d 443, 230 U.S.P.Q. 416 (Fed. Cir. 1986) cert. denied, 484 U.S. 823 (1987), on remand, 10 U.S.P.Q. 2d 1929 (N.D. Calif. 1989).
7. In re Gorman, 933 F.2d 982, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).
8. In re Dow Chem., 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988).



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**Hybritech Incorporated v. Monoclonal Antibodies, Inc.****(CA FC)****231 USPQ 81****Decided September 19, 1986****No. 86-531****U.S. Court of Appeals Federal Circuit**

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**Headnotes****PATENTS****1. Patentability -- In general (§ 51.01)**

Federal district court's finding that evidence was lacking as to when, before May 1980, claimed invention of using monoclonal antibodies in "sandwich" assays was conceived by patent holder, is clearly erroneous, in view of evidence demonstrating patent holder's earlier efforts in developing claimed invention by using prior art technology to produce necessary monoclonal antibodies in diagnostic sandwich assay kits, in view of evidence demonstrating that exploiting monoclonal antibodies for use in sandwich assays was one of patent holder's major objectives, and in view of laboratory notebooks and research program that fully corroborate testimonial evidence of conception, since such evidence clearly supports holding that patent holder conceived claimed invention before patent challenger and that patent challenger's work is not prior art.

**2. Patentability -- Anticipation -- In general (§ 51.201)**

Prior art work that involved "sandwich" assay to extent that antigen was sandwiched between two monoclonal antibodies, but that did not involve detecting presence of or quantitating antigen, did not anticipate claimed invention, since it did not meet its every element.

**3. Patentability -- Invention -- In general (§ 51.501)**

Articles which "predicted" widespread use of monoclonal antibodies but which are dated well after patented monoclonal assay's date of conception and within one year of its

filing date, are not prior art, nor should earlier articles which discussed production of monoclonal antibodies, although clearly prior art, have been relied upon to establish obviousness of trying monoclonal antibodies of particular affinity in "sandwich" immunoassay that detects presence of or quantitates antigen, since such articles do not suggest how that end may be accomplished, and since "obvious to try" is improper consideration in adjudicating obviousness issue.

**4. Patentability -- Evidence of -- Commercial success -- Causes (§ 51.4555)**

Trial court's finding that "sudden availability" of monoclonals was reason for commercial success of patented diagnostic kits is clearly erroneous, in view of evidence demonstrating that at least three years passed between time monoclonal antibodies were available in adequate supply and time patent holder began selling its kits.

**5. Claims -- Indefinite -- Chemical (§ 20.553)**

Federal district court erred in holding that claims for monoclonal assay are indefinite because antibody affinity cannot be estimated with any consistency, since calculating affinity was known in art at time of filing, and since such claims reasonably apprise those skilled in art and are as precise as subject matter permits, even though calculations are not precise or "standard."

**Particular patents -- Assays**

4,376,110, David and Green, Immunometric Assays Using Monoclonal Antibodies, holding of invalidity reversed.

**Case History and Disposition:**

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**Appeal from District Court for the Northern District of California, Conti, J.; 227 USPQ 215 .**

**Action by Hybritech Incorporated, against Monoclonal Antibodies, Inc., for patent infringement. From judgment for defendant, plaintiff appeals. Reversed and remanded.**

**Attorneys:**

**Douglas E. Olson, and Lyon & Lyon, both of Los Angeles, Calif. (James W. Geriak and Bradford J. Duft, both of Los Angeles, Calif., on the brief) for appellant.**

**David J. Brezner, and Flehr, Hohback, Test, Albritton & Herbert,**

**both of San Francisco, Calif. (Barry E. Britschneider and Herbert I. Cantor, both of Washington, D.C., of counsel) for appellee.**

**Judge:**

Before Rich, Davis, and Smith, Circuit Judges.

**Opinion Text**

**Opinion By:**

Rich, Circuit Judge.

This appeal is from the August 28, 1985, decision of the United States District Court for the Northern District of California, 623 F.Supp. 1344, 227 USPQ 215, in favor of defendant Monoclonal Antibodies, Inc. (Monoclonal) holding that all 29 claims of plaintiff's patent No. 4,376,110 entitled "Immunometric Assays Using Monoclonal Antibodies" ('110 patent), issued to Dr. Gary S. David and Howard E. Greene and assigned to Hybritech Incorporated (Hybritech), are invalid as anticipated under 35 USC 102(g), for obvious

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ness under §103, and under §112 first and second paragraphs. We reverse and remand.

**Background**

Vetebrates defend themselves against invasion by microorganisms by producing antibodies, proteins which can complex with the invading microorganisms and target them for destruction or removal. In fact, any foreign molecule of sufficient size can act as a stimulus for antibody production. Such foreign molecules, or antigens, bear particular sites or epitopes that represent antibody recognition sites. B cell lymphocytes, the cells that actually produce antibodies, recognize and respond to an epitope on an antigen by reproducing or cloning themselves and then producing antibodies specific to that epitope. Even if the antigen is highly purified, the lymphocytes will produce antibodies specific to different epitopes on the antigen and so produce antibodies with different specificities. Furthermore, because the body is exposed to many different antigens, the blood of a vertebrate will contain antibodies to many different antigenic substances.

Scientists and clinicians have long employed the ability of antibodies to recognize and complex with antigens as a tool to identify or label particular cells or molecules and to separate them from a mixture. Their source of antibodies has been primarily the serum separated from the blood of a vertebrate immunized or exposed to the antigen. Serum, however, contains a mixture of antibodies directed to numerous antigens and to any number of epitopes on a particular antigen. Because such a mixture of antibodies arises from many different clones of lymphocytes, it is called "polyclonal."

Recent technological advances have made it possible to isolate and cultivate a single clone of lymphocytes to obtain a virtually unlimited supply of antibodies specific to one particular epitope. These antibodies, known as "monoclonal antibodies" because they arise from a single clone of lymphocytes, are produced by a relatively new technology known as the hybridoma. Hybridomas are produced by fusing a particular cancer cell,

the myeloma cell, with spleen cells from a mouse that has been injected or immunized with the antigen. These fusions are isolated by transferring them to a growth fluid that kills off the unfused cancer cells, the unfused spleen cells dying off by themselves. The fused hybrid spleen and myeloma cells, called hybridomas, produce antibodies to the antigen initially injected into the mouse. The growth fluid containing the hybridomas is then diluted and put into individual test tubes or wells so that there is only one hybridoma per tube or well. Each hybridoma then reproduces itself and these identical hybridomas each produce identical monoclonal antibodies having the same affinity and specificity. In this way, a virtually unlimited supply of identical antibodies is created, directed to only one epitope on an antigen rather than, as with polyclonal antibodies, to many different epitopes on many different antigens.

In addition to the specificity of antibodies to particular epitopes discussed above, antibodies also have a characteristic "sensitivity," the ability to detect and react to antigens. Sensitivity is expressed in terms of "affinity:" the greater an antibody's ability to bind with a particular antigen, the greater the antibody's affinity. The strength of that antibody-antigen bond is in part dependent upon the antibody's "affinity constant," expressed in liters per mole, for the antigen.

Immunoassays, the subject matter of the '110 patent are diagnostic methods for determining the presence or amount of antigen in body fluids such as blood or urine by employing the ability of an antibody to recognize and bind to an antigen. Generally, the extent to which the antibody binds to the antigen to be quantitated is an indication of the amount of antigen present in the fluid. Labelling the antibody or, in some cases, the antigen, with either a radioactive substance, I 125, or an enzyme makes possible the detection of the antibody-antigen complex. In an extreme case, where the fluid sample contains a very low level of the antigen, binding might not occur unless the antibodies selected or "screened" for the procedure are highly sensitive.

In the case of a "competitive" immunoassay, a labelled antigen reagent is bound to a limited and known quantity of antibody reagent. After that reaction reaches equilibrium, the antigen to be detected is added to the mixture and competes with the labelled antigen for the limited number of antibody binding sites. The amount of labelled antigen reagent displaced, if any, in this second reaction indicates the quantity of the antigen to be detected present in the fluid sample. All of the antigen attached to the antibody will be labelled antigen if there is no antigen in the test fluid sample. The advantage of this method is that only a small amount of antibody is needed, its drawback, generally, that the system must reach equilibrium, and thus produces results slowly.

In the case of a "sandwich" assay, otherwise known as an immunometric assay, the latter being a term coined by Dr. Lawton Miles in 1971, a quantity of unlabelled antibody reagent is bound to a solid support surface such as the inside wall of a test tube containing a complex of the fluid sample containing the

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antigen to be detected and a labelled *antibody* reagent. The result is an insoluble three part complex referred to as a sandwich having antibody bread and antigen filling. This figure is illustrative of the sandwich concept:

*Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

The advantage of the sandwich assay is that it is fast and simple, its drawback that enormous quantities of antibodies are needed.

### **Hybritech**

Hybritech, started in 1978 and joined thereafter by coinventors Green and Dr. David, has, since 1979, been in the business of developing diagnostic kits employing monoclonal antibodies that detect numerous antigens and thus a broad range of conditions such as pregnancy, cancer, growth hormone deficiency, or hepatitis. Examples of antigens include influenza viruses, immunoglobulin E (IgE) which indicates allergic reaction, human chorionic gonadotropin (HCG) which indicates pregnancy, and prostatic acid phosphatase (PAP) which indicates prostate cancer, to name a few. Dr. Adams, a business-experienced scientist, joined the company in May 1980 as head of research and development. The '110 patent, application for which was filed August 4, 1980, issued March 8, 1983, with claims defining a variety of sandwich assays using monoclonal antibodies. Claim 19, apparently the broadest of the twenty-nine in the patent, is directed generally to a sandwich assay and reads (emphasis ours):

19. In an *immunometric assay* to determine the presence or concentration of an antigenic substance in a sample of a fluid comprising forming a ternary complex of a first labelled antibody, said antigenic substance, and a second antibody said second antibody being bound to a solid carrier insoluble in said fluid wherein the presence of the antigenic substance in the samples is determined by measuring either the amount of labelled antibody bound to the solid carrier or the amount of unreacted labelled antibody, *the improvement comprising* employing monoclonal antibodies having an affinity for the antigenic substance of at least about 10<sup>8</sup> liters/mole for each of said labelled antibody and said antibody bound to a solid carrier.

Claim 1, directed particularly to a reverse sandwich assay, explained infra, reads:

1. A process for the determination of the presence of [sic, or] concentration of an antigenic substance in a fluid comprising the steps:
  - (a) contacting a sample of the fluid with a measured amount of a soluble first monoclonal antibody to the antigenic substance in order to form a soluble complex of the antibody and antigenic substance present in said sample, said first monoclonal antibody being labelled;
  - (b) contacting the soluble complex with a second monoclonal antibody to the antigenic substance, said second monoclonal antibody being bound to a solid carrier, said solid carrier being insoluble in said fluid, in order to form an insoluble complex of said first monoclonal antibody, said antigenic substance and said second monoclonal antibody bound to said solid carrier;
  - (c) separating said solid carrier from the fluid sample and unreacted labelled antibody;
  - (d) measuring either the amount of labelled antibody; associated with the solid carrier or the amount of unreacted labelled antibody; and
  - (e) relating the amount of labelled antibody measured with the amount of labelled antibody measured for a control sample prepared in accordance with steps (a)-(d), said control sample being known to be free

of said anti-genic substance, to determine the presence of antigenic substance in said fluid sample, or relating the amount of labelled antibody measured with the amount of labelled antibody measured for samples containing known amounts of antigenic substance prepared in accordance with steps (a)-(d) to determine the concentration of antigenic substance in said fluid sample, the first and second monoclonal antibodies having an affinity for the antigenic substance of at least about 10<sup>8</sup> liters/mole.

### ***The District Court Decision***

Hybritech sued Monoclonal March 2, 1984, for damages and an injunction alleging that the manufacture and sale of Monoclonal's diagnostic kits infringed the '110 patent. Trial without a jury began on August 5, 1985, and concluded August 23, 1985, thirty witnesses having been heard and over 2,000 pages of transcript generated. The district court produced the reported opinion, findings, and con

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clusions, which use nearly verbatim Monoclonal's *pre-trial* brief and *pre-trial proposed* findings of fact and conclusions of law, in three days, in support of the judgment now on appeal.

The district court held that the claimed subject matter of the '110 patent was neither conceived nor actually reduced to practice before May 1980, and was anticipated under §102(g) by the actual reduction to practice of the invention by Drs. Uotila and Ruoslahti at the La Jolla Cancer Research Foundation (LJCRF) as early as November of 1979 and by the actual reduction to practice of the invention by Drs. Oi and Herzenberg (Oi/Herzenberg work) at the Stanford University Laboratory as early as July 1978, later published in December of 1979.

The district court also held the claims of the '110 patent invalid for obviousness from the Oi/Herzenberg work in view of (1) a February 1979 article by M. E. Frankel and W. Gerhard (Frankel article) which discloses high-affinity monoclonal antibodies, and apparently in view of numerous other references including (2) the work of Nobel Prize winners G. Kohler and C. Milstein disclosing a Nobel Prize-worthy method for producing monoclonal antibodies in vitro (outside the body) published in an August 7, 1975, article; (3) U.S. Patent No. 4,244,940 issued to Jeong et al. disclosing a simultaneous polyclonal assay (Jeong), U.S. Patent No. 4,098,876 to Piasio et al. disclosing a reverse polyclonal sandwich assay (Piasio), U.S. Patent No. 4,016,143 to Schurrs et al. disclosing a forward polyclonal sandwich assay (Schurrs); (4) a July 1979 publication by A. C. Cuello et al. disclosing the use of monoclonal antibodies in competitive assays; and (5) eight articles dated between January 1979 and March 6, 1980, "predicting" that monoclonal antibodies would be used in future immunoassays.<sup>1</sup>

The district court also invalidated the patent on various grounds based on 35 USC 112, first and second paragraphs, as hereinafter discussed.

### ***A. The References***

#### ***1. Kohler and Milstein's Nobel Prize-Winning Work: Producing Monoclonal Antibodies In Vitro For the First Time***

In early immunoassay work, polyclonal antibodies produced in vivo (in the body) in mice were used to bind with the antigen to be detected in the body fluid sample. Mice

were immunized by injection with antigen so that the lymphocytes in their bodies produced antibodies that attacked the injected antigen. Those polyclonal antibodies were withdrawn from the animal's blood and used in immunoassays. The major problem was that when the mice's immune systems changed or the mice died, the antibodies changed or died too; supply was limited and uncertain.

As the examiner was aware, Kohler and Milstein developed a technique not only for producing antibodies in vitro, independent of a living body, thus eliminating dependence on a particular animal, but for in vitro production of monoclonal antibodies by hybridomas, discussed in the Background section, supra.

Given that sandwich assays require enormous amounts of antibodies, companies like appellant and appellee, which utilize monoclonal antibodies for sandwich assays, would not be in business were it not for the work of Kohler and Milstein.

## ***2. The Work of Drs. Ruoslahti, Uotila, and Engvall at the La Jolla Cancer Research Foundation (LJCRF) in 1979 and 1980***

Dr. Ruoslahti performed mostly competitive immunoassays using polyclonal antibodies to alphafetoprotein (AFP) antigens at the City of Hope since 1970. Dr. Uotila joined him in late 1978 to perform immunoassays using monoclonal antibodies to AFP. After producing monoclonal antibodies to AFP and performing competitive radio immunoassays (RIA -- a competitive assay that uses a radioactive label) with monoclonal antibodies at the City of Hope in mid-1979, Drs. Ruoslahti, Uotila and Engvall left LJCRF.

In the fall of 1979, September or October according to Dr. Uotila, discussion and work began on using monoclonal antibodies to AFP in a sandwich assay. Dr. Uotila, the principal researcher in this particular endeavor, generated six notebooks while at the City of Hope and LJCRF. The next-to-last page of notebook four contained a note to Dr. Uotila from Dr. Ruoslahti reading:

Sometime you should enzyme label a good monoclonal antibody so that you can set up a sandwich assay. If you use two monoclonal antibodies, you may be able to do the assay with a single incubation, since the monoclonal antibodies are likely to be

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directed against different determinants and not compete with one another. Although Dr. Uotila's notebook pages were, for the most part, unsigned, undated, and uncorroborated, Dr. Ruoslahti's testimony, placed the date of this note at about October 1979 by referring to the first pages of notebook five which were dated in early November 1979. Dr. Ruoslahti testified that one curve on one graph on page 43D of notebook five showed a successful simultaneous sandwich assay using monoclonal antibodies about November 5, 1979, although no data supporting that graph could be found elsewhere in the notebook. He further testified that the affinity of the monoclonal antibodies used for that test was not calculated until 1980 but that the raw data necessary for that calculation was generated in 1979.

Dr. Uotila stated in her deposition (she did not testify at trial) that she started work on a sandwich assay using monoclonal antibodies between October 4 and the end of that month, 1979, and that she could not remember the procedure used nor was there enough

information in her notebook, including page 43D, to refresh her memory. She did remember, although she continued work on this assay because the tests did not yield repeatedly good curves without which she would not publish her work, that the assay on page 43D was successful. Dr. Engvall testified about a discussion of Dr. Uotila's monoclonal antibody work with her while at the City of Hope and about first performing a sandwich assay after arriving at LJCRF in 1979.

### **3. *The Work of Drs. Oi and Herzenberg at the Stanford University Laboratory in 1978 Published in December 1979***

Drs. Oi and Herzenberg used monoclonal antibodies to "map" epitopes or determine the number and location of different antibody binding sites on a known quantity of IgE antigen by attaching to it an antibody bound to a carrier and exposing that antigen to other monoclonal antibodies. The antibodies either attached to epitopes on the antigen or were blocked from doing so by the other monoclonal antibodies, depending on the location and number of epitopes; if the epitopes on the antigen were too close together and the number of antibodies too great, few antibodies would bind to the antigen. Hybritech points out that both Dr. Herzenberg and Dr. Oi testified that *their work did not involve determining the presence or quantity of antigen*, that they had no idea what the affinities of the monoclonal antibodies used were, and that those values were never calculated.

One unsigned, unwitnessed page from three large laboratory notebooks, which Hybritech argues is insufficient because it does not identify the chemical reagents or protocol used, was relied on by Monoclonal to establish actual reduction to practice of the Oi/Herzenberg work in 1978 to establish a case of §102(g) prior invention by another. The district court agreed with Monoclonal that the Oi/Herzenberg work anticipated the claimed invention and, in addition, combined this work with the Frankel publication to hold that the claimed subject matter was obvious under §103.

### **4. *The Frankel Article: Monoclonal Antibodies Having Affinities of 10 <sup>9</sup>liters/mole***

Frankel describes an RIA (radioimmunoassay) method for the rapid determination of affinity constants for monoclonal antibodies produced from hybridomas. The article states that the assay used is applicable only to antibodies with binding constants of about 10 <sup>10</sup>liters/mole and discloses the binding constants for antibodies to several closely related strains of influenza virus.

The district court found that Frankel disclosed monoclonal antibodies having the affinity constants claimed in the '110 patent, 10 <sup>8</sup>to over 10 <sup>9</sup>liters/mole.

### **5. *The Cuello Article and the Jeong, Piasio, and Schurr Patents Considered by the Examiner***

Cuello, dated July 1979, states that it describes the usefulness of monoclonal antibodies in the characterization and localization of neurotransmitters such as Substance P, a peptide clearly associated with the transmission of primary sensory information in the spinal cord. The article discloses producing monoclonal antibodies from hybrid myelomas (hybridomas), their use in conventional radioimmunoassay techniques, and the benefits from doing so which flow from the ability to derive permanent cell lines capable of continuous production of highly specific antibodies.

The district court found that the examiner twice rejected all of the claims of the '110



patent based on Cuello alone or in combination with the Jeong, Piasio, and Schurr references which disclose various sandwich assays using polyclonal antibodies. The court also found that the examiner allowed the claims after they were amended to include the 10 affinity limitation and after Richard Bartholomew, a Hybritech employee, submitted an affidavit alleging the advantages of using monoclonal rather than polyclonal antibodies in sandwich assays.

Apparently based on the testimony of Monoclonal's expert witness Judith Blakemore, a named inventor of the Jeong patent, manager of antibody programs at Bio-Rad Laboratories from 1975 to 1982, and currently manager of monoclonal antibody therapeutics at Cetus Corporation, a Hybritech competitor in immunoassay diagnostics, the district court stated

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that the "reasons for allowance were not well-founded because (1) the alleged advantages were expected as naturally flowing from the well-known natural characteristics of monoclonal antibodies . . .; (2) . . . were not significant . . .; or (3) were at best minor," although they were "argued to the examiner as if they were" important. These were Monoclonal's words from its pretrial submission adopted by the court.

#### **6. *The References That "Predicted" the Use of Monoclonal Antibodies in Immunoassays***

The district court stated, again in Monoclonal's words, that "it is of the utmost importance" that the advantages of monoclonal antibodies were "predicted by a number of authorities," eight to be exact, not important enough to list here, after the Kohler and Milstein discovery and after monoclonal antibodies became available.

#### **B. *The Claimed Subject Matter of the '110 Patent***

Hybritech argues that the district court's determination that there is no credible evidence of conception or reduction to practice of the '110 invention before May 1980 is error because Dr. David's laboratory notebooks, Nos. 21 and 24, clearly show successful sandwich assays using monoclonal antibodies in August, September, and October of 1979. At the least, argues Hybritech, the invention was conceived in January of 1979, long before Drs. Ruoslahti, Engvall, and Uotila began work on a sandwich assay using monoclonal antibodies, and diligence was thereafter exercised until constructive reduction to practice occurred by the filing of the '110 patent application on August 4, 1980.

Dr. David and Greene testified that pages 2118 to 2122 of Dr. David's notebook, dated January 4, 1979, and witnessed January 30, 1979, disclose the generic conception of the invention in the context of the physical support structure used to carry out a sandwich assay, and Dr. David testified on redirect that (1) Page 1128 of notebook 21, dated May 27, 1979, recorded an early attempt at a sandwich assay that failed, (2) on August 3, 1979, as recorded at page 1166, a sandwich assay using monoclonal antibody 068 attached to a solid carrier, a radio-labelled 068 antibody, and a hepatitis antigen from an Abbott Labs polyclonal competitive assay kit was successfully performed, and (3) a sandwich assay using a bound 259 antibody, a radio-labelled 068 antibody, and a hepatitis antigen was successfully performed on September 21, 1979. Hybritech also urges that work in October 1979 directed to determining whether certain monoclonal

antibodies were recognizing the same or different determinants, was a reduction to practice.

Monoclonal points out that these notebook pages do not expressly state that monoclonal antibodies of 10 8liters/mole affinity were used in a sandwich assay and that the May, August, and September notebook entries were not witnessed until about the time Dr. Adams, experienced in patent matters, joined Hybritech and advised its researchers on properly recording laboratory work. They therefore claim that actual reduction to practice was not shown before May 1980.

## OPINION

### I. Review Under Rule 52(a) Fed.R. Civ. P.

Rule 52(a) "ensures care in the preparation of an opinion . . . and provides appellate courts with the benefit of the District Court's insights into a case," *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309 318, 227 USPQ 766, 772 (Fed. Cir. 1985) (Harvey, Senior District Judge, concurring) by requiring a district court to "find the facts specially and state separately its conclusions of law thereon." With the exception of the first eight paragraphs, the first half of the district court's opinion here is Monoclonal's *pretrial* brief and the last three pages of the opinion are Monoclonal's *pretrial* findings of fact and conclusions of law. The district court adopted the above documents virtually verbatim, with the exception of portions of each concerning inequitable conduct and noninfringement, apparently without inviting a response from Hybritech, resulting in a repetitious (as the district court admitted in the opinion), sometimes internally inconsistent, and hard to follow opinion that presents us with a difficult task in gleaning the basis for many of the conclusions. For some of the findings, submitted before trial, no supporting evidence was introduced at trial.

The Supreme Court, in *Anderson v. City of Bessemer City, N.C.*, 105 S.Ct. 1504 (1985), strongly criticized the practice of "verbatim adoption of findings of fact prepared by prevailing parties, particularly when those findings have taken the form of conclusory statements unsupported by citation to the record." *Anderson*, *supra* at 1511. This court also has cautioned against the adoption of findings, especially when proposed by a party before trial, as here, and stated that the likelihood of clear error in those findings increases in such a situation. *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 730 F.2d 1452, 1457, 221 USPQ 481, 485 (Fed. Cir. 1984).

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Notwithstanding our misgivings about whether the findings in this case, prepared before any evidence was introduced, satisfy the objectives of Rule 52(a) -- a carefully prepared opinion providing the reviewing court with the benefit of the district court's *reasoned insights* into the case -- those findings are the district court's and may be reversed only if clearly erroneous. *See Anderson*, *supra*, at 1511; *Lindemann*, 730 F.2d at 1457, 221 USPQ at 485.

"A finding is clearly erroneous when, although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed." *United States v. United States Gypsum Co.*, 333 U.S. 364, 395 (1948). "This standard plainly does not entitle a reviewing court to reverse the finding of the trier of fact simply because it is convinced that it would have decided the

case differently." *Anderson*, supra, at 1511. In other words, "if the district court's account of the evidence is plausible in light of the record viewed in its entirety" or "where there are two permissible views of the evidence," the factfinder cannot be clearly erroneous. *Anderson*, supra, at 1511 (quoting *United States v. Yellow Cab Co.*, 338 U.S. 338, 342 (1949)). This is so, stated the Court in dictum, see *Anderson*, supra, at 1516 (Blackmun, J., concurring), even when the district court's findings rest on physical or documentary evidence or inferences from other facts and not on credibility determinations. See also Rule 52(a) Fed.R. Civ. P. (as amended Aug. 1, 1985). If the latter are involved, "Rule 52 demands even greater deference to the trial court's findings" but a trial judge may not "insulate his findings from review by denominating them credibility determinations"; if documents or objective evidence contradict the witness' story, clear error may be found even in a finding purportedly based on a credibility determination. *Anderson*, supra, at 1512-13. We proceed in light of all these principles.

## **II. Presumption of Validity**

Under 35 USC 282, a patent is presumed valid, and the one attacking validity has the burden of proving invalidity by clear and convincing evidence. See, e.g., *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1360, 220 USPQ 763, 770 (Fed. Cir. 1984). Notwithstanding that the introduction of prior art not before the examiner may facilitate the challenger's meeting the burden of proof on invalidity, the presumption remains intact and on the challenger throughout the litigation, and the clear and convincing standard does not change. See, e.g., *Jervis B. Webb Co. v. Southern Systems, Inc.*, 742 F.2d 1388, 1392 & n.4, 222 USPQ 943, 945 & n.4 (Fed. Cir. 1984). The only indication that the district court recognized the presumption of validity and its proper application was its statement that "[t]he key issue in this case is whether the defendant has overcome the presumption of nonobviousness." That statement, however, speaks only part of the truth; the presumption of validity goes to validity of the patent in relation to the patent statute as a whole, not just to nonobviousness under Section 103.

## **III. Prior Invention of Another, 35 USC 102(g)**

Section 102(g) states that a person shall be entitled to a patent unless "before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it." Section 102(g) "relates to prior inventorship by another in this country" and "retains the rules governing the determination of priority of invention . . . ." *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1444, 223 USPQ 603, 606 (Fed. Cir. 1984) (quoting P.J. Federico, *Commentary on the New Patent Act*, 35 USCA page 1, at 19 (1954)). Section 102(g) says: "In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

Reduction to practice, and conception as well, is a legal determination subject to review free of the clearly erroneous standard. *Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd.*, 731 F.2d 831, 837, 221 USPQ 561, 565-66 (Fed. Cir. 1984); *D.L. Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 1151, 219 USPQ 13, 18 (Fed. Cir. 1983). Findings of fact supporting that legal conclusion, are, of course, reviewed under the clearly erroneous standard.

Conception is the "formation in the mind of the inventor, of a definite and permanent

idea of the complete and operative invention, as it is hereafter to be applied in practice." 1 *Robinson On Patents* 532 (1890); *Coleman v. Dines*, 754 F.2d 353, 359, 224 USPQ 857, 862 (Fed. Cir. 1985). Actual reduction to practice requires that the claimed invention work for its intended purpose, *see, e.g., Great Northern Corp. v. Davis Core & Pad Co.*, 782 F.2d 159, 165, 228 USPQ 356, 358, (Fed. Cir. 1986), and, as has long been the law, constructive reduction to practice occurs when a patent application on the claimed invention is filed. *Weil v. Fritz*, 572 F.2d 856, 865 n.16,

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196 USPQ 600, 608 n.16 (CCPA 1978) (citing with approval *Automatic Weighing Machine Co. v. Pneumatic Scale Corp.*, 166 F. 288 (1st Cir. 1909)).

[1] After a review of the record in its entirety, including the numerous corroborating Hybritech laboratory notebooks, internal documents, and pertinent testimony, we hold clearly erroneous the district court's finding that there is no clear or corroborated evidence "with regard to when before May 1980, the idea of actually using monoclonals in sandwich assays" was conceived or, more properly, of when the *claimed invention* was conceived, and therefore reverse the court's holding, as a matter of law, that Hybritech's inventors did not conceive the claimed invention before May 1980.

Hybritech's claim of conception, generally, is evidenced by the sometimes sparsely documented work of a start-up company whose first small advances evolved into the myriad activities of a mature company with efforts directed toward developing the claimed invention by first employing the Kohler and Milstein technology to produce the necessary monoclonal antibodies and using those antibodies in diagnostic sandwich assay kits. There is no doubt that exploiting monoclonal antibodies for use in sandwich assays was one of the major objectives of Hybritech. In a letter to Pharmacia Fine Chemicals dated April 26, 1979, Greene, in responding to Pharmacia's interest in Hybritech's products, outlined the latter's "efforts to bring the exciting new hybridoma technology into routine medical use" and its exploration of "several intriguing concepts for which monoclonals may open up new immunodiagnostic techniques heretofore infeasible with animal serums." Although company minutes in early 1979 contain little about the claimed subject matter and some of the discussions thereon, such as Greene's and Dr. Adams' conversation about monoclonal sandwich assays when the former was trying to woo Dr. Adams to join Hybritech were unrecorded, the Hybritech laboratory notebooks and the nature of Hybritech's research program fully corroborate the testimonial evidence of conception and thus clearly support our holding that Hybritech conceived the claimed invention before LJCRF.

Dr. David's January 1979 notebook describes, in detail, as explained by Greene and Dr. David at trial, a nylon apparatus that undoubtedly could be used for performing a sandwich assay using monoclonal antibodies, although Dr. David testified on cross-examination that at that time Hybritech had not yet developed any monoclonal antibodies, including attaching one of the reagents to a solid carrier ring, contacting that ring with a fluid sample in a microtiter plate well, adding a labelled reagent to the well after rinsing, and then "counting" or measuring the amount of either the labelled or unlabelled reagent after a prescribed time and second rinsing. The notebook then describes the procedure for detecting an antibody "(a-x)" to an antigen "(x)" complete with diagrams and text, both illuminated by Dr. David at trial. The notebook further

states, "Alternatively, if one wished to quantitate an antigen, y, the identical procedure would be followed, except that reagents would be reversed, i.e. the reaction would be:" and there follows a clear illustration of an antibody attached to a solid carrier reacting with an antigen to form a complex, and that complex reacting with a second labelled antibody. The notebook was signed by Dr. David on January 4, 1979, and witnessed and signed on January 30 of the same year by Dr. Curry, the first cell biologist hired at Hybritech to set up the hybridoma production program.

Dr. David testified on direct that monoclonal antibodies were developed in the following months: antigens were purchased from outside sources and purified before being injected into mice; the spleen cells from those mice were fused with myelomas; and the resultant hybridomas were separated into well plates for development, and a radioimmunoassay procedure was carried out to determine the affinity of the antibodies.

The May 1979 failed sandwich assay, witnessed in May 1980, corroborates Dr. David's testimony that a polyclonal antibody bound to a solid carrier and a labelled monoclonal antibody were used in a sandwich assay with an antigen from Abbott Labs' Ausria polyclonal diagnostic kit for hepatitis. No binding was detected.

Dr. David testified about the experiment documented in the August 1979 notebook, a sandwich assay with a hepatitis antigen from an Abbott Labs Ausria kit with two Hybritech 068 monoclonal antibodies, one attached to a solid carrier bead and the other labelled; the purpose of the experiment was to quantitate the antigen. The notebook corroborates Dr. David's testimony that the test was positive and lists the counts per minute of the labelled antibody. Defendant Monoclonal's expert Ciotti testified about this experiment:

Also, of course, it is limited to -- it is limited to hepatitis antigen. And without a generic conception, it would just be merely a -- if it did work for its intended purpose -- which I would assume for purposes of discussion -- it *would be a reduction to practice of one embodiment*. And without a corresponding generic conception, I don't think it would be held to be the making of the invention in

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terms of, for instance, in claim 19. [Emphasis ours.]

Dr. David further testified that the September 21, 1979, record in David's notebook, witnessed months later, shows a reverse sandwich assay using a bound 259 monoclonal antibody and a labelled 068 monoclonal antibody with a hepatitis antigen with results confirmed by a dose response curve.<sup>2</sup> Hybritech further alleges that a laboratory notebook page dated October 1979 is a reduction to practice of the claimed invention but fails to cite any related testimony or other evidence in support thereof.

Finally, the record shows that the claimed affinity limitation "of at least about 10<sup>8</sup> liters/mole" was determined and appreciated during the course of the development of the claimed subject matter. Dr. David and Dr. Adams separately testified that the screening procedures used by Hybritech ensured that only monoclonal antibodies having at least 10<sup>8</sup> liters/mole affinity would be used in assays. An October 1979 internal memorandum from Greene to the staff states "To improve comparisons we will express all affinities to the base ten to the eighth which represents the lower end of the useable range."

We are left with the definite and firm conviction that a mistake has been committed because the district court's account of the evidence that "there was no credible evidence

of conception before May 1980" is insupportable. There is such evidence. The laboratory notebooks, alone, are enough to show clear error in the findings that underlie the holding that the invention was not conceived before May 1980. That some of the notebooks were not witnessed until a few months to one year after their writing does not make them incredible or necessarily of little corroborative value. Admittedly, Hybritech was a young, growing company in 1979 that failed to have witnesses sign the inventors' notebooks contemporaneously with their writing. Under a reasoned analysis and evaluation of all pertinent evidence, however, we cannot ignore that Hybritech, within a reasonable time thereafter, prudently had researchers other than those who performed the particular experiments witness the notebooks in response to Tom Adams' advice. The notebooks clearly show facts underlying and contemporaneous with conception of the claimed invention and in conjunction with the testimony of Dr. David and Greene, and others, are altogether legally adequate documentary evidence, under the law pertaining to conception, of the formation in the minds of the inventors of a definite and permanent idea of the complete and operative invention as it was thereafter applied in practice. We thus are not moved by Monoclonal's argument that the findings of fact underlying conception are based on credibility determinations and are more sacrosanct than usual. *See Anderson, supra*, at 1512-13.

### **1. LJCRF Is Not Prior Art**

Hybritech laboratory notebooks and the uncontradicted testimony of Dr. David and Mr. Greene show that development of the claimed invention proceeded diligently through the rest of 1979 and 1980, there being absolutely no evidence of record nor even argument by Monoclonal that Hybritech was not diligent in its efforts to reduce to practice the claimed invention during the period January 1979 to the '110 application filing date of August 4, 1980. We therefore hold as a matter of law that Hybritech's conception, which was before LJCRF conceived the claimed invention, coupled by diligence to its constructive reduction to practice by the filing of the '110 application, entitle Hybritech to priority over LJCRF. *See* 35 USC 102(g). The work of LJCRF is therefore not prior art.

We also note that there is inadequate factual basis for the district court's holding that LJCRF reduced the claimed invention to practice as early as November 1979 because the only evidence that corroborates the testimony of Ruoslahti, Uotila, and Engvall is the note from Ruoslahti to Uotila, see section A, 2, *supra*, which indisputably is not the claimed invention, and the *one* curve from *one* graph from only one page, 43D, of the six Uotila notebooks. After a reasoned examination, analysis, and evaluation of this pertinent evidence we conclude that it falls far short of showing the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice," *see Coleman*, 754 F.2d at 359; 224 USPQ at 862, and therefore is legally inadequate to support even a holding of *conception* of the claimed invention by LJCRF personnel in 1979.

(1) It is undisputed that page 43D was not signed, witnessed, or dated; (2) the deposition testimony of Uotila was that she could not remember the procedure used to arrive at the dose-response curve on page 43D and there was not enough information in her notebook to refresh her memory; (3) the testimony of

Ruoslahti was that he could find *no* data in the notebook supporting that graph, none of the *later* graphs shown there represented successful assays and that "especially after this was done, we ran into more severe problems. And it took us a while to do away with the problems;" (4) Ruoslahti also testified that they never determined, in 1979, the affinities of the monoclonal antibodies they used, and that the title of page 43D had been altered at some point -- the word "inhibition" had been crossed out and "sandwich" written in; and (5) the testimony of Engvall was that there was nothing about the shape of those curves which indicates that they were sandwich assays. We also note, as evidence bearing upon the credibility of Ruoslahti's testimony (that LJCRF actually reduced the claimed invention to practice in 1979), that when LJCRF attempted to provoke an interference in the PTO with Hybritech based on the U.S. filing of an application that was the counterpart to a Swedish application disclosing similar subject matter, LJCRF could not demonstrate even a *prima facie* reduction to practice prior to Hybritech's August 4, 1980, filing date. During that proceeding, the earliest dates Ruoslahti set down on paper to support conception and reduction to practice were in 1980.

## **2. The Work of Oi/Herzenberg Is Not the Claimed Invention**

[2] It is axiomatic that for prior art to anticipate under §102 it has to meet every element of the claimed invention, and that such a determination is one of fact. *See, e.g., Lindemann, supra*, 730 F.2d at 1458, 221 USPQ at 485; *Great Northern Corp. v. Davis Core & Pad Co.*, 782 F.2d 159, 165, 228 USPQ 356, 358 (Fed. Cir. 1986). Section 102(g) upon which the district court relied is one type of "anticipation," i.e., prior invention by another of the same invention. Drs. Oi and Herzenberg testified that their work did not involve detecting the presence of or quantitating antigen but a determination of the number and location of epitopes on a *known* quantity of antigen. Although this work did involve a sandwich assay to the extent that an antigen was sandwiched between two monoclonal antibodies, it is clear that the similarity between that work and the claimed invention goes no further. Furthermore, both doctors testified that they did not know the affinities of the antibodies that were used in their mapping work and in fact never calculated them. Ciotti, Monoclonal's expert, testified that the 10<sup>8</sup> affinity limitation cannot be found anywhere in the Oi/Herzenberg work. Again we are left with a definite and firm conviction that a mistake was made because that work does not meet every element of the claimed invention. The district court's finding to the contrary is clearly erroneous.

We note that the district court, in also holding the patent invalid under §103, next considered, combined the Oi/Herzenberg work with the Frankel reference, one justifiable inference therefrom being that the court recognized that Frankel discloses a claim *element* that Oi/Herzenberg does not, namely, at least about 10<sup>8</sup> liters/mole affinity.

## **IV. Obviousness, 35 USC 103**

A section 103 obviousness determination -- whether the claimed invention *would have been* (not "would be" as the court repeatedly stated because Monoclonal's pretrial papers used that improper language) obvious at the time the invention was made is reviewed free of the clearly erroneous standard although the underlying factual inquiries - scope and content of the prior art, level of ordinary skill in the art,<sup>3</sup> and differences between the prior art and the claimed invention -- integral parts of the subjective determination involved in §103, are reviewed under that standard. Objective evidence such as commercial success, failure of others, long-felt need, and unexpected results must

be considered *before* a conclusion on obviousness is reached and is not merely "icing on the cake," as the district court stated at trial. See *Lindemann*, supra, 730 F.2d at 1461, 221 USPQ at 488; *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 219 USPQ 857 (Fed. Cir. 1983); *W.L. Gore & Associates v. Garlock Inc.*, 721 F.2d 1540, 220 USPQ 303, 314 (Fed. Cir. 1983).

### **1. The Eight Articles "Predicting" Widespread Use of Monoclonal Antibodies**

Before discussing the more pertinent references in this case -- the Oi/Herzenberg and Frankel works -- we cull the other prior art references relied on by the trial court.

[3] First, the latest four of the eight articles that the court stated were of the "utmost importance" because they "predicted" that the breakthrough in production of monoclonal antibodies by Kohler and Milstein would lead to widespread use of monoclonal antibodies in

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immunoassays are neither 102(a)/103 nor 102(b)/103 prior art because they are dated between late 1979 and March 6, 1980, well after the date of conception and within one year of the filing date of the '110 patent.

The earliest four of the eight articles, on the other hand, although clearly prior art, discuss *production* of monoclonal antibodies -- admittedly old after Kohler and Milstein showed how to produce them -- but none discloses sandwich assays. At *most*, these articles are invitations to try monoclonal antibodies in immunoassays but do not suggest how that end might be accomplished. To the extent the district court relied upon these references to establish that it would have been *obvious to try* monoclonal antibodies of 10<sup>8</sup>liters/mole affinity in a sandwich immunoassay that detects the presence of or quantitates antigen, the court was in error. See *Jones v. Hardy*, 727 F.2d 1524, 1530, 220 USPQ 1021, 1026 (Fed. Cir. 1984) ("Obvious to try" is improper consideration in adjudicating obviousness issue).<sup>4</sup>

### **2. The Kohler and Milstein Work, the Cuello Article and the Jeong, Piasio, and Schurr Patents Considered by the Examiner**

The district court's finding that Kohler and Milstein developed a method for producing monoclonal antibodies in vitro is correct, but that finding proves no more; although it made possible all later work in that it paved the way for a supply of monoclonal antibodies, it indisputably does not suggest using monoclonal antibodies in a sandwich assay in accordance with the invention claimed in the '110 patent.

The Cuello reference discloses monoclonal antibodies but not in a sandwich assay. The competitive assay in Cuello, moreover, uses only one monoclonal antibody and thus in no way suggests the claimed invention wherein a ternary complex of two monoclonal antibodies and an antigen form a sandwich. Furthermore, the court did not explain how this art, by itself or in combination with any of the other art, suggests the claimed subject matter and thus why that combination would have been obvious. We are of the opinion that it does not.

The district court correctly found that the use of polyclonal antibodies in sandwich assays was well known. The Jeong patent discloses the use of polyclonal antibodies in a



simultaneous sandwich assay, with no suggestion that monoclonal antibodies be so used. It is prior art by virtue of §102(e), application for the patent having been filed September 5, 1978, its effective date as a reference. The Piasio patent, disclosing a reverse sandwich assay using polyclonal antibodies, and Schurrs, disclosing a forward sandwich assay using the same, both §102(a) prior art, are likewise devoid of any suggestion that monoclonal antibodies can be used in a similar fashion.

### **3. The Oi/Herzenberg Work and the Frankel Article**

Clearly, the most pertinent items of prior art not cited by the examiner are the Oi/Herzenberg work, as described in section A, 3, *supra*, and the Frankel article. As stated in the discussion of Prior Invention of Another (section III, 2, *supra*), the Oi/Herzenberg work involved mapping epitopes on a known quantity of antigen. It was not concerned with and does not disclose using monoclonal antibodies of at least 10<sup>8</sup>liters/mole affinity. Oi and Herzenberg testified that they did not know the affinity of the antibodies used, and Ciotti testified that nowhere in that work is there mention of monoclonal antibody affinity of at least 10<sup>8</sup>liters/mole. On this basis, we conclude that the Oi/Herzenberg work is qualitatively different than the claimed invention; the former is directed to mapping epitopes on a known quantity of antigen and the latter to determining the "presence or concentration of an antigenic substance in a sample of fluid . . . ." We disagree with Monoclonal that these are "essentially the same thing."

Furthermore, it is perfectly clear that this work in no way suggests using monoclonal antibodies of the affinity claimed in the '110 patent. It is because of these differences between the Oi/Herzenberg work and the claimed invention that the fact that an antigen was sandwiched between two monoclonal antibodies in the course of Oi's and Herzenberg's work is not sufficient basis to conclude that the claimed invention would have been obvious at the time it was made to a person of ordinary skill in the art.

Likewise, a conclusion that the invention would have been obvious cannot properly be reached when the Oi/Herzenberg work is

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considered in view of the Frankel article. Frankel teaches a method for rapid determination of affinity constants for monoclonal antibodies, some of which clearly have affinities of the order defined by the claims, but does not in any way suggest using two of those antibodies in a sandwich to assay an antigen by forming a ternary complex of labelled antibody, the antigenic substance, and a bound antibody wherein the presence of the antigenic substance is determined by measuring either the amount of labelled antibody bound to a solid carrier or the amount of unreacted labelled antibody. The mere existence of prior art disclosing how to measure the affinity of high affinity monoclonal antibodies is insufficient to support a holding of obviousness. Hybritech's claims define a *process* that *employs* monoclonal antibodies, and does not merely claim antibodies of high affinity. In view of the fact that the Oi/Herzenberg work is not directed to an assay as claimed and does not disclose antibodies of at least 10<sup>8</sup>liters/mole affinity, and further that Frankel fails to suggest using such antibodies in a sandwich assay, the Frankel article does not compensate for the substantial difference between the Oi/Herzenberg work and the claimed subject matter, and therefore those references in combination cannot support a holding of obviousness.

#### **4. Objective Evidence of Nonobviousness**

[4] In one part of its opinion the court found that "the commercial success of the kits *may* well be attributed to the business expertise and acumen of the plaintiff's personnel, together with its capital base and marketing abilities" (emphasis ours) and later that "[w]here commercial success is based on the sudden availability of starting materials, in this instance the availability of monoclonal antibodies as a result of the Kohler and Milstein discovery, business acumen, marketing ability, and capital sources, no causal relationship is proven." (Citation omitted.)

##### **i. Commercial Success: Hybritech's Diagnostic Kits Grabbed a Substantial Market Share**

The undisputed evidence is that Hybritech's diagnostic kits had a substantial market impact. The first diagnostic kit sales occurring in mid-1981, sales increased seven million dollars in just over one year, from \$6.9 million in 1983 to an estimated \$14.5 million in 1984; sales in 1980 were nonexistent. Competing with products from industry giants such as Abbott Labs, Hoffman LaRoche, Becton-Dickinson, and Baxter-Travenol, Hybritech's HCG kit became the market leader with roughly twenty-five percent of the market at the expense of market shares of the other companies. Its PAP kit ranks second only to a product sold by Dupont's New England Nuclear, surpassing products from Baxter-Travenol, Abbott, and others. Hybritech's other kits, indisputably embodying the invention claimed in the '110 patent, obtained similar substantial market positions.

Although the district court did not provide its insights into why commercial success was due to business acumen and not to the merits of the claimed invention, Monoclonal urges in support that it was due to Hybritech's spending disproportionate sums on marketing, 25-30% of income. The undisputed evidence was that expenditures of *mature* companies in this field are between 17 and 32%. Furthermore, the record shows that advertising makes those in the industry -- hospitals, doctors, and clinical laboratories -- aware of the diagnostic kits but does not make these potential users buy them; the products have to work, and there is no evidence that that is not the case here or that the success was not due to the merits of the claimed sandwich assays -- clearly contrary to the district court's finding.

The trial court's finding that the "sudden availability of monoclonals" was the reason for the commercial success of Hybritech's diagnostic kits (Finding 11) is unsupported by the record and clearly erroneous. Monoclonal admits that monoclonal antibodies were available in the United States in 1978, and the evidence clearly reflects that. Thus, at least *three years* passed between the time monoclonal antibodies were available in adequate supply and the time Hybritech began selling its kits. Especially in the fast-moving biotechnology field, as the evidence shows, that is anything but sudden availability.

##### **ii. Unexpected Advantages**

Hybritech points to the testimony of three witnesses skilled in the diagnostic field who state that, based on tests done in their laboratories as a result of real-world comparisons in the normal course of research, the diagnostic kits that embody the '110 invention unexpectedly solved longstanding problems. Dr. Hussa, the head of a large referral laboratory and a world-wide consultant, testified that until Hybritech introduced its kits, he and others were very skeptical and had almost exclusively used competitive assays with a radioactive tracer (RIAs). <sup>5</sup> In relation to an HCG Hybritech

kit, he testified that he had first thought that the Hybritech HCG kit would not give accurate results for low antigen concentrations because that condition is indicated in the Hybritech kit by a low radioactivity reading, a reading difficult to differentiate from control samples containing no antigen. He also stated that in the past, RIA kits falsely detected HCG in nonpregnant women, a condition which would indicate cancer and surgery. He stated that when he employed the Hybritech HCG kit in such instances it demonstrated, correctly and absent any difficulty interpreting the data, that no HCG was present.

Dr. Blethen, an M.D. holding a Ph.D. in biochemistry, testified that she did not think that the Hybritech HGH kit, for detecting growth hormone in children, would offer any advantage, but she determined that it detected HGH deficiencies in children where conventional RIAs failed to do so. She also stated that the kit does not give false positive readings as do conventional RIA kits, an opinion shared by Dr. Hussa. A third witness, Dr. Herschman, who holds a master's degree in chemistry, testified that he spent years working on the development of an assay that would determine the presence of TSH (thyroid stimulating hormone) with greater sensitivity. He succeeded but discovered that the Hybritech TSH kit had the same sensitivity, the test being performed in four hours rather than the three days his kit required.

Having considered the evidence of nonobviousness required by §103 and *Graham*, supra, we hold, as a matter of law, that the claimed subject matter of the '110 patent would not have been obvious to one of ordinary skill in the art at the time the invention was made and therefore reverse the court's judgment to the contrary. The large number of references, as a whole, relied upon by the district court to show obviousness, about twenty in number, skirt all around but do not as a whole suggest the claimed invention, which they must, to overcome the presumed validity, *Lindemann*, 730 F.2d at 1462, 221 USPQ at 488, *as a whole*. See 35 USC 103; *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir. 1984). Focusing on the obviousness of substitutions and differences instead of on the invention as a whole, as the district court did in frequently describing the claimed invention as the mere substitution of monoclonal for polyclonal antibodies in a sandwich assay, was a legally improper way to simplify the difficult determination of obviousness. See generally *Hodosh v. Block Drug Co*, 786 F.2d 1136, 229 USPQ 182 (Fed. Cir. 1986).<sup>6</sup>

With respect to the objective indicia of nonobviousness, while there is evidence that marketing and financing played a role in the success of Hybritech's kits, as they do with any product, it is clear to us on the entire record that the commercial success here was due to the merits of the claimed invention. It cannot be argued on this record that Hybritech's success would have been as great and as prolonged as admittedly it has been if that success were not due to the merits of the invention. The evidence is that these kits compete successfully with numerous others for the trust of persons who have to make fast, accurate, and safe diagnoses. This is not the kind of merchandise that can be sold by advertising hyperbole.

### **V. Enablement, Best Mode, and Definiteness Under §112**

The section 112 defense appears to have been an afterthought of both Monoclonal, who briefly but unsuccessfully attempts to defend this utterly baseless determination, and

of the district court which adopted the defense from Monoclonal's pretrial papers apparently without knowledge of the applicable law, to highlight, as it stated at trial, that it was part of its job to see that "whoever wins wins all the way or whoever loses loses all the way." Taken as a whole, the court's comments on §112 -- split into two parts, one from Monoclonal's pretrial brief and the other from the adopted pretrial

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findings and conclusions -- are internally inconsistent. The opinion states that the patent fails to disclose how (1) to make monoclonal antibodies; (2) to screen for proper monoclonal antibodies; and (3) to measure monoclonal antibody affinity and therefore the specification is nonenabling and does not satisfy the best mode requirement, and the claims are indefinite. We discuss each of these in turn.

### **1. Enablement**

Enablement is a legal determination of whether a patent enables one skilled in the art to make and use the claimed invention, *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 960, 220 USPQ 592, 599 (Fed. Cir. 1983), is not precluded even if some experimentation is necessary, although the amount of experimentation needed must not be unduly extensive, *Atlas Powder Co. v. E.I. Du Pont De Nemours & Co.*, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984), and is determined as of the filing date of the patent application, which was August 4, 1980. See *W.L. Gore and Associates v. Garlock, Inc.*, 721 F.2d 1540, 1556, 220 USPQ 303, 315 (Fed. Cir. 1983). Furthermore, a patent need not teach, and preferably omits, what is well known in the art. *Lindemann*, 730 F.2d at 1463, 221 USPQ at 489.

The record fully supports the '110 patent's statement that

The monoclonal antibodies used for the present invention are obtained by the [hybridoma] process discussed by Milstein and Kohler. . . . The details of this process are well known and not repeated here.

The district court itself stated that the "method for producing monoclonal antibodies in vitro was well known prior to the alleged invention of the '110 patent," and used the "sudden availability of monoclonal antibodies" produced by the Kohler and Milstein discovery to support, albeit erroneously, its finding of a lack of nexus between the merits of the claimed invention and its commercial success. The court then about-faced and held the '110 patent deficient because it fails to teach how to make monoclonal antibodies.

With respect to screening, the only permissible view of the evidence is that screening methods used to identify the necessary characteristics, including affinity, of the monoclonal antibodies used in the invention were known in the art and that the '110 patent contemplated one of those. At trial, Monoclonal's counsel stated "it is a procedure that was known in '78." In similar fashion, the district court held that the claimed subject matter would have been obvious in part because the "existence of monoclonal antibodies *having the affinity constants claimed in the patent was well known* prior to the alleged invention . . . ." [Emphasis ours.] Furthermore, there was not a shred of evidence that undue experimentation was required by those skilled in the art to practice the invention. . . We hold as a matter of law that the '110 patent disclosure is enabling.

### **2. Best Mode**

"The specification . . . shall set forth the best mode contemplated by the inventor of carrying out his invention." 35 USC 112. Because not complying with the best mode requirement amounts to concealing the preferred mode contemplated by the applicant at the time of filing, in order to find that the best mode requirement is not satisfied, it must be shown that the applicant knew of and concealed a better mode than he disclosed. *DeGeorge v. Bernier*, 768 F.2d 1318, 1324, 226 USPQ 758, 763 (Fed. Cir. 1985) (quoting with approval *In re Sherwood*, 613 F.2d 809, 204 USPQ 537 (CCPA 1980)). The only evidence even colorably relating to concealment is testimony by various Hybritech employees that sophisticated, competent people perform the screening and that the screening process is labor-intensive and time-consuming. It is not plausible that this evidence amounts to proof of concealment of a best mode for screening or producing monoclonal antibodies for use in the claimed '110 process, and therefore we are of the firm conviction that the district court's finding that the best mode requirement was not satisfied is clearly erroneous.

### 3. Indefiniteness

[5] The basis of the district court's holding that the claims are indefinite is that "they do not disclose how infringement may be avoided because antibody affinity cannot be estimated with any consistency." (Conclusion 6.) Even if the district court's finding in support of this holding -- that "there is no standard set of experimental conditions which are used to estimate affinities" -- is accurate, under the law pertaining to indefiniteness -- "if the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more," *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985) -- the claims clearly are definite. The evidence of record indisputably shows that calculating affinity was known in the art at the time of filing, and

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notwithstanding the fact that those calculations are not precise, or "standard," the claims, read in light of the specification, reasonably apprise those skilled in the art and are as precise as the subject matter permits. As a matter of law, no court can demand more.

### VI. Motions

Monoclonal's motion to strike Appendices A and B of Hybritech's reply brief as being beyond the page limit applicable to reply briefs is granted as to Appendix A but denied as to Appendix B, the latter having been helpful in culling the often non-supportive citations to the record by Monoclonal.

Hybritech's motion to supplement the record with a Monoclonal advertisement not considered at trial is denied. Any adverse impact that the disposition of these two motions has upon either party is more than outweighed by this court's patience with the seemingly endless flow of post-argument argumentative papers.

### VII. Conclusion

The judgment of the district court holding the patent in suit invalid is *reversed* in all respects, and the case is *remanded* for a determination of the issue of infringement which the court held was moot.

**REVERSED AND REMANDED**

## Footnotes

Footnote 1. With respect to obviousness, one portion of the district court's opinion apparently relies on all of the above listed references, (1)-(5), for the obviousness holding while a later portion entitled "CONCLUSIONS OF LAW" relies on only the Oi/Herzenberg and Frankel articles. Furthermore, the district court did not state that the LJCRF work was considered for purposes of §103, although we recognize that §102(g) prior art can be used for §103.

Footnote 2. A dose response curve is antigen concentration plotted against the signal produced by labelled antibody in an immunoassay. The signal increases with increasing antigen concentration in a successful assay but at some point decreases when the antigen concentration becomes too high.

Footnote 3. Although the district court failed expressly to find the level of ordinary skill in the art at the time the invention was made, it did make reference to "[p]eople working in immunology aware of the Kohler and Milstein discovery" which we deem an accurate finding for the purposes of that portion of the *Graham* factual inquiries.

Footnote 4. Finding 10, which states that the invention was contemporaneously developed and disclosed in at least five publications and patent applications not listed above *and dated well after the filing date of the '110 patent but before its issuance* is irrelevant for purposes of the hypothesis based on the three factual inquiries required by §103 as interpreted by *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966) because obviousness must be determined as of the time the invention was made.

Additionally, they are of little probative value in this case because they are dated December 1981 at the earliest, more than a year after the August 4, 1980, filing date here and roughly two years after conception occurred. Furthermore, simultaneous development may or may not be indicative of obviousness, the latter being the case here for the above reasons and because the other evidence of nonobviousness is adequate, such occurrences having been provided for in 35 USC 135. *Lindemann*, supra, 730 F.2d at 1460-61, 221 USPQ at 487; *Environmental Designs, Ltd. v. Union Oil Co. of California*, 713 F.2d 693, 698 n.7, 218 USPQ 865, 869 n.7 (Fed. Cir. 1983)

Footnote 5. Monoclonal's expert Blakemore testified that of 425 assays on the market in 1979 less than 1% were sandwich assays. Today, sandwich assays constitute the majority of all assays sold.

The record also shows that Blakemore, who testified extensively for Monoclonal that the claimed invention would have been obvious, never used monoclonal antibodies in sandwich assays at Cetus before 1980. Additionally, she did not even mention them in the Jeong patent, of which she was a coinventor, which issued January 13, 1981, long after the beginning of Hybritech's work in this area in 1979.

Footnote 6. It bears repeating that it is crucial that counsel set forth the law accurately. More particularly, it is the duty of counsel to impart to the judge that the obviousness question properly is whether the *claimed invention as a whole would have been* obvious to one of *ordinary skill in the art at the time the invention was made*, and that the district court must *expressly* make the three factual determinations required by *Graham* and consider objective evidence of obviousness *before* the legal conclusion of obviousness *vel non* is made. Submitting to the court language like "any differences . . . would have

been obvious," as was done here, violates the axiom that the question is not whether the differences would have been obvious but the claimed invention *as a whole*. Furthermore, arguing that "it would be obvious" rather than that it would *have been* obvious shifts the court's focus to the wrong period of time, namely to a time long after the invention was made, in which, more likely than not, the prior art and the level of ordinary skill in the art are more advanced. *See* 35 USC 103.

- End of Case -

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## **In re HOEKSEMA**

**(CCPA)**

**158 USPQ 596**

**Decided Aug. 8, 1968**

**No. 7778**

**U.S. Court of Customs and Patent Appeals**

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### **Headnotes**

#### **PATENTS**

**1. Rehearing and reopening—In general (§ 57.1)**

Court of Customs and Patent Appeals grants rehearing because of continuing importance of questions involved and strong suggestion of error in its earlier opinion.—  
In re Hoeksema (CCPA) 158 USPQ 596.

**2. Patentability—Composition of matter (§ 51.30)**

Process obviousness is relevant in deciding compound obviousness.—In re  
Hoeksema (CCPA) 158 USPQ 596.

**3. Patentability—Invention—In general (§ 51.501)**

In context of 35 U.S.C. 103, court is not permitted to fragment a claimed invention in applying that section; invention must be considered as a whole.—In re Hoeksema (CCPA) 158 USPQ 596.

**4. Patentability — Composition of matter (§ 51.30)**

Claimed compound is the invention as a whole (35 U.S.C. 103), but, so considered, unless there is some known or obvious way to make compound, invention is nothing more than a mental concept expressed in chemical terms and formulae on a paper; invention as a whole is claimed compound and a way to produce it; since there is no showing that claimed compound can exist because there is no showing of a known or obvious way to manufacture it, the invention as a whole is not obvious under section 103.—In re Hoeksema (CCPA) 158 USPQ 596.



**5. Patentability — Anticipation — In general (§ 51.201)****Patentability — Invention—In general (§ 51.501)**

Conditions for patentability, novelty and loss of right to patent, stated in 35 U.S.C. 102, may have relevance as to disclosure which must be found in prior art to find obviousness of invention under section 103; in determining that quantum of prior art disclosure which is necessary to declare applicant's invention "not novel" or "anticipated" within section 102, test is whether reference contains an enabling disclosure; this test applies to issues under section 103.—In re Hoeksema (CCPA) 158 USPQ 596.

**6. Patentability—Composition of matter (§ 51.30)**

If prior art fails to disclose or render obvious a method for making claimed compound, at time invention was made, it may not be legally concluded that compound itself is in possession of public; absence of known or obvious process for making claimed compounds overcomes presumption that compounds are obvious, based on close relationships between their structures and those of prior art compounds.—In re Hoeksema (CCPA) 158 USPQ 596.

**7. Pleading and practice in Patent Office—Rejections (§ 54.7)**

Patent Office having cited reference which rendered claimed compounds prima facie obvious, applicant sustained burden of going forward with contrary evidence by filing affidavit pointing out that reference does not disclose process for producing claimed compounds, thus overcoming Office's position as to reference's legal effect under 35 U.S.C. 103; thereupon, burden of going forward with proofs to support its position as to obviousness shifted to Office; Office's failure to produce such evidence requires that rejection be reversed.—In re Hoeksema (CCPA) 158 USPQ 596.

**Particular patents — 9-D-Psicofuranosylpurine**

Hoeksema, 9-D-Psicofuranosylpurine and 6-Substituted Derivatives, claim 1 of application allowed.—In re Hoeksema (CCPA) 158 USPQ 596.

**Case History and Disposition:**

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**Appeal from Board of Appeals of the Patent Office.**

Application for patent of Herman Hoeksema, Serial No. 30,770, filed May 23, 1960; Patent Office Group 120. From decision rejecting claim 1, applicant appeals. Affirmed at 154 USPQ 169 . On petition for rehearing. Reversed; Kirkpatrick, Judge, dissenting with opinion.

**Attorneys:**

**EARL C. SPAETH (EUGENE O. RETTER and GEORGE T. JOHANNESSEN of counsel) all of Kalamazoo, Mich., for appellant.**

**JOSEPH SCHIMMEL (JACK E. ARMORE of counsel) for Commissioner of Patents.**

**Judge:**

Before WORLEY, Chief Judge, RICH, SMITH, and ALMOND, Associate Judges, and KIRKPATRICK, Judge. \*

**Opinion Text****Opinion By:**

SMITH, Judge.

[1] In our prior consideration of this appeal, we affirmed the decision of the Patent Office Board of Appeals, which had affirmed the examiner's rejection of the sole remaining claim of appellant's application, <sup>1</sup> *In re Hoeksema*, 54 CCPA 1618, 379 F.2d 1007, 154 USPQ 169 (1967). Because of the continuing importance of the questions involved, and the strong suggestion of error in our earlier opinion, we granted appellant's petition for a rehearing under the provisions of Rule 7 of this court, 55 CCPA—, (October 5, 1967).

The parties filed new briefs, and the case was reargued on January 3, 1968. Upon reconsideration of our previous decision, we have concluded that our previous decision was erroneous and that a proper resolution of the issues requires that we *reverse* the decision of the board.

The facts are set forth in our original opinion. We shall assume familiarity with that statement of facts and shall here redevelop only those which we now believe were previously misapprehended or misapplied and require the present decision.

The sole claim on appeal is directed to a chemical compound and reads as follows:

1. An N-psicofuranoside having the formula:

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*Graphic material consisting of a chemical formula or diagram set at this point is not available. See text in hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

wherein A is selected from the class consisting of hydrogen, the group -XR wherein R is selected from the class consisting of hydrogen, lower-alkyl, and lower-aralkyl, and X is selected from the class consisting of oxygen and sulfur,

and the group

*Graphic material consisting of a chemical formula or diagram set at this point is not available. See text in hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

wherein R<sub>2</sub> is selected from the class consisting of hydrogen, lower-alkyl, lower-aralkyl, and lower-aryl, and R<sub>3</sub> is selected from the class consisting of lower-alkyl, lower-aralkyl, and lower-aryl, and R<sub>4</sub> is selected from the class consisting of hydrogen, a hydrocarbon carboxylic acid acyl radical containing from two to twelve carbon atoms, inclusive, and a halo-, hydroxy-, lower-alkoxy-, amino-, cyano-, thiocyno-, and nitro-substituted hydrocarbon carboxylic acid acyl radical containing from two to twelve carbon atoms, inclusive.

That claim stands rejected under 35 U.S.C. 103 as unpatentable over prior art, on this record limited solely to the De Boer et al. patent <sup>2</sup> (De Boer) which discloses a compound with the structural formula:

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As we noted in our original opinion, the controversy here is limited to the substituent A at the 6-position of the purine ring system. Although a compound having De Boer's structure is not included in the appealed claim since A in the claim cannot be an unsubstituted or primary amino,

*Graphic material consisting of a chemical formula or diagram set at this point is not available. See text in hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

, the basic structure of the De Boer compound is similar to the structure of appellant's alkylamino and dialkylamino compounds. <sup>3</sup>

Despite this close structural similarity between the De Boer amino compound and the alkylamino and dialkylamino compounds included in the appealed claim, appellant chose not to submit a showing of unexpected properties in his claimed compounds. <sup>4</sup> Appellant asserted that his compounds were unobvious and patentable without such a showing. He urged that De Boer does not teach one of ordinary skill in the art how to make appellant's claimed compounds, and the examiner did not cite any other reference telling how they might be made. Therefore, in appellant's view, his claimed compounds are not in possession of the public, *In re Brown*, 51 CCPA 1254, 329 F.2d 1066, 141 USPQ 245 (1964). <sup>5</sup>

In support of his position, appellant submitted an affidavit by Dr. Paul F. Wiley relating to the unavailability to the public of processes for preparing appellant's alkylamino and dialkylamino compounds. <sup>6</sup> Dr. Wiley's qualifications

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and competence as an expert to state facts and opinion in this area of chemistry were not challenged.

Regarding the Wiley affidavit, the examiner stated, in his Answer:

The affidavit \* \* \* does not appear to be pertinent to the claim now on appeal because it is directed to the processes by which the De Boer et al. and appellant's compounds are prepared, and shows nothing unobvious for the

instantly claimed compound.

Concerning the Wiley affidavit, the board cited a statement of this court in *In re Riden*, 50 CCPA 1411, 318 F.2d 761, 138 USPQ 112 (1963), to the effect that "the method of making the compounds is a relevant fact to be considered in the question of obviousness of the compounds," 50 CCPA at 1415, 318 F.2d at 764, 138 USPQ at 114-115. But the board continued:

\* \* \* This may be so but it is only one factor and, in our opinion, should never be the overriding one which appellant is here, in effect, urging.

Appellant states the first of two central questions to be decided in this rehearing as follows:

1) Appellant will admit his compounds are obvious and unpatentable *if* an obvious process is available to make them. Does it follow then that appellant's compounds are unobvious and patentable if an obvious process is *not* available to make them?

[2] Within this context, appellant simplifies that question to: Is process obviousness relevant in deciding compound obviousness? <sup>7</sup>

The solicitor responds to the latter characterization of the question in the affirmative, pointing out that the first question bears on the principle implicit in *In re Brown*, *supra*, that claimed compounds not distinguished in their properties over closely related prior art compounds are unpatentable thereover where the claimed compounds would be "in possession of the public" in that a process for preparing them would be obvious to those of ordinary skill in the art.

In addition, the solicitor now refers to our prior opinion in which we noted that the facts in this case are closely analogous to those of *In re Riden*, *supra*, where we stated that the fact that the method of making the claimed compound is relevant, 54 CCPA at —, 379 F.2d at 1010, 154 USPQ at 172.

A recurring problem of analysis which confronted us as we prepared our previous opinion, and which still confronts us after the rehearing, has its genesis in a proper understanding of the issue as framed by appellant. In effect, appellant agrees that since the claimed product is a homolog of a known compound, it would be *prima facie* "obvious" under 35 U.S.C. 103. But this agreement is conditioned on the proviso that there is in the prior art an "obvious" process by which to make that compound.

[3] In the context of section 103, we are not permitted to fragment a claimed invention in applying that section. The clear mandate of the statute which governs our analysis requires that

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we consider the *invention as a whole* in making the determination.

[4] Thus, as we apply the statute to the present invention, we must ask first, what is the invention as a whole? Necessarily, by elementary patent law principles, it is the claimed compound, but, so considered, unless there is some known or obvious way to make the compound, the invention is nothing more than a mental concept expressed in chemical terms and formulae on a paper.

We are certain, however, that the invention as a whole is the claimed compound *and* a way to produce it, wherefore appellant's argument has substance. There has been no showing by the Patent Office in this record that the claimed compound can exist because

there is no showing of a known or obvious way to manufacture it; hence, it seems to us that the "invention as a whole," which section 103 demands that we consider, is not obvious from the prior art of record.

While there are valid reasons based in public policy as to why this defect in the prior art precludes a finding of obviousness under section 103, *In re Brown*, supra, its immediate significance in the present inquiry is that it poses yet *another difference* between the claimed invention and the prior art which *must* be considered in the context of section 103. So considered, we think the differences between appellant's *invention as a whole* and the prior art are such that the claimed invention would not be obvious within the contemplation of 35 U.S.C. 103.

[5] While 35 U.S.C. 102 is not *directly* involved in the issue on review, the conditions for patentability, novelty and loss of right to patent, there stated, may have relevance as to the disclosure which must be found in the prior art to find obviousness of an invention under section 103. In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention "not novel" or "anticipated" within section 102, the stated test is whether a reference contains an "enabling disclosure," in the present context, a process by which the claimed compound could be made. In *In re LeGrice*, 49 CCPA 1124, 301 F.2d 929, 133 USPQ 365 (1962), we observed that the resolution of this issue required us to determine whether, *as a matter of law*, a reference without such a disclosure constituted a statutory time bar to an applicant's right to a patent. There, the issue was founded on 35 U.S.C. 102(b), not 103, but our conclusions have a certain pertinence here. We concluded, *id.* at 1134, 301 F.2d at 936, 133 USPQ at 372:

We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention*. \* \* \*

In *In re Brown*, supra, this court discussed *In re Von Bramer*, 29 CCPA 1018, 127 F.2d 149, 53 USPQ 345 (1942), commenting that that opinion should not be construed to encompass what had come to be called the "Von Bramer doctrine." There we stated, 51 CCPA at 1257, 329 F.2d at 1009, 141 USPQ at 247:

\* \* \* This doctrine, which appears to have resulted from *In re Von Bramer et al.*, supra, seems over a period of years to have been tailored in some quarters to a principle which defeats the novelty of a chemical compound on the basis of a mere printed conception or a mere printed contemplation of a chemical "compound" *irrespective of the fact that so-called "compound" described in the reference is not in existence or that there is no process shown in the reference for preparing the compound, or that there is no process known to a person having ordinary skill in the relevant art for preparing the compound*. In other words, a mere formula or a mere sequence of letters which constitute the designation of a "compound," is considered adequate to show that a compound in an application before the Patent Office, which compound is designated by the same formula or the same sequence of letters, is old. We do not think that the Von Bramer case should be so construed. [Emphasis added.]

To the extent that anyone may draw an inference from the Von Bramer case that the *mere* printed conception or the *mere* printed contemplation which

constitutes the designation of a "compound" is sufficient to show that such a compound is old, regardless of whether the compound is involved in a 35 U.S.C. 102 or 35 U.S.C. 103 rejection, we totally disagree. \* \* \* [Footnotes omitted.]

We concluded, relying on *In re Le Grice*, supra, and *E. I. du Pont de Nemours & Co. v. Ladd*, 328 F.2d 547, 140 USPQ 297 (D.C. Cir. 1964), that the "true test of any prior art relied on to show or suggest that a chemical compound is old, is whether the prior

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art is such as to place the disclosed 'compound' in the *possession of the public*. " 51 CCPA at 1259, 329 F.2d at 1011, 141 USPQ at 249.

While *In re Le Grice* was bottomed on an issue arising under 35 U.S.C. 102 where the reference was a "printed publication," that test, in our view, is also properly applicable to issues arising under 35 U.S.C. 103. See *In re Brown*, supra (pertinent portion quoted above); *Deutsche Gold-Und Silber-Scheideanstalt v. Commissioner*, 251 F.Supp. 624, 629-630, 148 USPQ 412, 416 (D.D.C. 1966), affirmed, \_\_\_ F.2d \_\_\_, 157 USPQ 549 (D.C. Cir. 1968).

[6] Thus, upon careful reconsideration it is our view that if the prior art of record fails to disclose or render obvious a method for making a claimed compound, at the time the invention was made, it may not be legally concluded that the compound itself is in the possession of the public.<sup>8</sup> In this context, we say that the absence of a known or obvious process for making the claimed compounds overcomes a presumption that the compounds are obvious, based on close relationships between their structures and those of prior art compounds.

The second aspect of the questions presented by this rehearing involves the issue of whether the burden is on the Patent Office to provide the evidence on which to predicate process obviousness.

35 U.S.C. 101 states, in its preamble, that an applicant is *entitled* to a patent *unless* certain patent-defeating provisions are met. The substantive patent-defeating provisions are encompassed in 35 U.S.C. 100-103.

[7] As we have stated, the Patent Office search resulted in citation of the De Boer reference which, under the prevailing law, rendered appellant's claimed compounds *prima facie* obvious. In other words, its citation shifted to appellant the burden of going forward with contrary evidence. Appellant filed the affidavit of Dr. Wiley which points out as a fact that De Boer—the only reference being relied on—does not disclose a process for producing the different compounds here claimed.

We think that portion of the Wiley affidavit set forth, supra note 6, states facts which were legally sufficient to overcome the position of the Patent Office as to the legal effect under section 103 of the De Boer reference.<sup>9</sup> Appellant's responsibility to overcome this reference as a "patent-defeating" reference under section 103 at that point in the prosecution was only to overcome De Boer as a reference pertinent to the issue of obviousness under section 103.

We think the Wiley affidavit is clearly sufficient for this purpose. The affidavit points out that there is no indication in the De Boer patent that the fermentation process used to produce De Boer's compounds could be used to produce appellant's compounds. Since we are of the view that the method for making the compounds is an integral part of the "invention as a whole" which we must consider under section 103, we conclude that the

the *Graham* factual inquiries. It should be noted that the Supreme Court's application of the *Graham* test to the fact circumstances in *Ag Pro* was somewhat stringent, as it was in *Black Rock*. Note *Republic Industries, Inc. v. Schlage Lock Co.*, 592 F.2d 963, 200 USPQ 769 (7th Cir. 1979). The Court of Appeals for the Federal Circuit stated in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1540, 218 USPQ 871, 880 (Fed. Cir. 1983) that

A requirement for "synergism" or a "synergistic effect" is nowhere found in the statute, 35 U.S.C. When present, for example in a chemical case, synergism may point toward nonobviousness, but its absence has no place in evaluating the evidence on obviousness. The more objective findings suggested in *Graham*, supra, are drawn from the language of the statute and are fully adequate guides for evaluating the evidence relating to compliance with 35 U.S.C. § 103. *Bowser Inc. v. United States*, 388 F.2d 346, 156 USPQ 406 (Cl. Cl. 1967).

### BASIC CONSIDERATIONS WHICH APPLY TO OBVIOUSNESS REJECTIONS

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

*Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

### OBJECTIVE EVIDENCE MUST BE CONSIDERED

Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence. The weight to be accorded to the evidence depends on the individual

factual circumstances of each case. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987). The ultimate determination on patentability is made on the entire record. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

See MPEP § 716- § 716.06 for a discussion of objective evidence and its role in the final legal determination of whether a claimed invention would have been obvious under 35 U.S.C. 103.

### 2141.01 Scope and Content of the Prior Art

#### I. PRIOR ART AVAILABLE UNDER 35 U.S.C. 102 IS AVAILABLE UNDER 35 U.S.C. 103

"Before answering *Graham's* 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987). Subject matter that is prior art under 35 U.S.C. 102 can be used to support a rejection under section 103. *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981) ("it appears to us that the commentator [of 35 U.S.C.A.] and the [congressional] committee viewed section 103 as including all of the various bars to a patent as set forth in section 102.").

A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date. For instance, an obviousness rejection over a U.S. patent which was issued more than 1 year before the filing date of the application is said to be a statutory bar just as if it anticipated the claims under 35 U.S.C. 102(b). Analogously, an obviousness rejection based on a publication which would be applied under 102(a) if it anticipated the claims can be overcome by swearing behind the publication date of the reference by filing an affidavit or declaration under 37 CFR 1.131.

For an overview of what constitutes prior art under 35 U.S.C. 102, see MPEP § 901 - § 901.06(d) and § 2121 - § 2129.

## II. SUBSTANTIVE CONTENT OF THE PRIOR ART

See MPEP § 2121 - § 2129 for case law relating to the substantive content of the prior art (e.g., availability of inoperative devices, extent to which prior art must be enabling, broad disclosure rather than preferred embodiments, admissions, etc.).

## III. CONTENT OF THE PRIOR ART IS DETERMINED AT THE TIME THE INVENTION WAS MADE TO AVOID HINDSIGHT

The requirement "at the time the invention was made" is to avoid impermissible hindsight. See MPEP § 2145, paragraph X.A. for a discussion of rebutting applicants' arguments that a rejection is based on hindsight.

"It is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

## IV. 35 U.S.C. 103(c) — EVIDENCE REQUIRED TO SHOW CONDITIONS OF 35 U.S.C. 103 APPLY

An applicant who wants to avail himself or herself of the benefits of 35 U.S.C. 103(c) has the burden of establishing that subject matter which qualifies as prior art under subsection (e), (f) or (g) of section 102 and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. *Ex parte Yoshino*, 227 USPQ 52 (Bd. Pat. App. & Inter. 1985). Note that for applications filed prior to November 29, 1999, 35 U.S.C. 103(c) is limited on its face to subject matter developed by another person which qualifies as prior art only under subsection (f) or (g) of section 102. See MPEP § 706.02(l)(1). See also *In re Bartfeld*, 925 F.2d 1450, 1453-54, 17 USPQ2d 1885, 1888 (Fed. Cir. 1991) (Applicant attempted to overcome a 35 U.S.C. 102(e)/103 rejection

with a terminal disclaimer by alleging that the public policy intent of 35 U.S.C. 103(c) was to prohibit the use of "secret" prior art in obviousness determinations. The court rejected this argument, holding "We may not disregard the unambiguous exclusion of § 102(e) from the statute's purview.").

See MPEP § 706.02(l)(2) for the requirements which must be met to establish common ownership.

## 2141.01(a) Analogous and Nonanalogous Art

### TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT MUST BE ANALOGOUS PRIOR ART

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); and *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

### PTO CLASSIFICATION IS SOME EVIDENCE OF ANALOGY, BUT SIMILARITIES AND DIFFERENCES IN STRUCTURE AND FUNCTION CARRY MORE WEIGHT

While Patent Office classification of references and the cross-references in the official search notes are some evidence of "nonanalogy" or "analogy" respectively, the court has found "the similarities and differences in structure and function of the inventions to carry far greater weight." *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) (The structural similarities and functional overlap between the structural gratings shown by one reference and the



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**In re WESSLAU**

**(CCPA)**

**147 USPQ 391**

**Decided Nov. 26, 1965**

**Appl. No. 7447**

**U.S. Court of Customs and Patent Appeals**

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**Headnotes**

**PATENTS**

**1. Patentability--Composition of matter (§ 51.30)**

Claims to process of polymerizing ethylene are not rejected on theory that applicant's catalyst system can be met merely by substitution of groups from two prior patents on the corresponding components of a third prior system since no one of the references suggests such a substitution, quite apart from the result which would be obtained thereby; such piecemeal reconstruction of prior art patents in light of applicant's disclosure is contrary to 35 U.S.C. 103.

**2. Patentability--Invention--In general (§ 51.501)**

Question in cases within ambit of 35 U.S.C. 103 is whether subject matter as a whole would have been obvious to one of ordinary skill in the art following teachings of prior art at time invention was made; it is impermissible within framework of section 103 to choose from any one reference only so much of it as will support a given position, to exclusion of other parts necessary to full appreciation of what reference fairly suggests to one of ordinary skill in the art.

**Particular patents--Polyethylene**

Wesslau, Process for the Production of Polyethylene with Narrow Distribution of the Molecular Weight, claims 35 to 43 of application allowed.

**Case History and Disposition:**

**Appeal from Board of Appeals of the Patent Office.**

**Application for patent of Hermann Wesslau, Serial No. 753,872, filed Aug. 8, 1959; Patent Office Group 140. From decision rejecting claims 35 to 43, applicant appeals. Reversed.**

**Attorneys:**

**ARNOLD SPRUNG, New York, N.Y., and ARNOLD B. CHRISTEN, Washington, D. C., for appellant.**

**CLARENCE W. MOORE (FRED W. SHERLING of counsel) for Commissioner of Patents.**

**Judge:**

Before WORLEY, Chief Judge, and RICH, MARTIN, SMITH, and ALMOND, Associate Judges.

**Opinion Text****Opinion By:**

**ALMOND, Judge.**

This appeal is from the decision of the Board of Appeals affirming the rejection of claims 35-43 <sup>1</sup> in appellant's application <sup>2</sup> entitled "Process for the Production of Polyethylene With Narrow Distribution of the Molecular Weight." No claims have been allowed.

The invention relates to a process of polymerizing ethylene utilizing a Ziegler-type catalyst system to produce solid polyethylene. Both appellant and the Patent Office have treated the appealed process claims as standing or falling together, and we will do the same. Claim 35, from which the remaining claims depend, is illustrative and reads as follows:

35. In the process of polymerizing ethylene to a solid polymer having a high molecular weight and a narrow molecular weight distribution range, the improvement which comprises polymerizing ethylene in the presence of a polymerization catalyst con

sisting essentially of a mixture of titanium trichloride, at least one compound of tetravalent titanium  $Ti(R)_4$  and at least one organic aluminum compound soluble in a liquid hydrocarbon and having the general formula  $R'Al(R)_2$  in which  $R'$  is alkyl and  $R$  is selected from the group consisting of halogen, alkoxy and aroxy radicals, wherein between said tetravalent titanium compound and said organic aluminum compound there is present in said mixture at least one halogen atom

and at least one member selected from the group consisting of alkoxy and aroxy radicals.

According to appellant's disclosure, polyethylene of high molecular weight may be produced by what has become known in the art as the Ziegler polymerization process. Analysis of the polyethylene so produced has revealed that although the *average* molecular weight of the polymer is high, a fairly large proportion of the individual polymer chains have a relatively low molecular weight. These low molecular weight fractions are particularly unfavorable for such properties as impact bending strength, rubbing, and fatigue. Appellant has discovered that the proportion of the lower molecular weight chains can be reduced, thereby narrowing the molecular weight distribution, by employing a three-component catalyst system in which either the  $Ti(R)_4$  or  $R'Al(R)_2$  contains an alkoxide or aroxide moiety.

The references relied on are:

Anderson 2,862,917 December 2, 1958

Muehlbauer 2,905,661 September 22, 1959

Ruhrchemie (Belgian) 553,694 June 24, 1957

The Ruhrchemie patent relates to a process for producing polyethylene of a desired molecular weight employing certain specified catalyst systems. The pertinent portion of the patent specification reads as follows:

\*\*\* when high molecular weight [polyethylene] products are to be obtained \*\*\*, the employed mixtures consist of aluminum alkyl compounds and/or halides of aluminum alkyl with quantities of titanium trichloride of at least 0.01 mole \*\*\* and quantities of titanium tetrachloride lower than 0.01 mole \*\*\*; on the other hand, when materials having low molecular weight are to be obtained the employed mixtures consist of aluminum alkyl and/or halide of aluminum alkyl with more than 0.1 mole \*\*\* of titanium tetrachloride per mole of aluminum alkyl and/or halide of aluminum alkyl, and with titanium trichloride at the rate of at least 0.1 mole, preferably 0.3-1 mole approximately per mole of aluminum alkyl and/or halide of aluminum alkyl.

The Anderson patent relates to a process of polymerizing ethylene whereby control over the weight average molecular weight of the polymer and the *molecular weight distribution* of the polymer is achieved by adhering to process conditions which insure the solubility of the ethylene during polymerization. The process employs coordination catalysts of titanium:

\*\*\* obtained by admixing a trivalent or tetravalent titanium compound of the class consisting of titanium salts and titanium alkoxides with a compound having at least one metal-to-hydrocarbon bond, such as metal alkyls, suitable compounds being lithium aluminum alkyls, aluminum alkyls, Grignard reagents, alkyl aluminum halides, tin alkyls, etc. \*\*\*

Anderson further states:

\*\*\* the steady state compliance [an indicia of molecular weight distribution] will vary from 3 to 7 when the critical conditions of the process of the present invention are maintained and will rise to a range of 12 to 28 when the polymerization is carried out at conditions other than required by the process of the present invention. \*\*\*

Muehlbauer relates to a process for producing high molecular weight polyolefins

employing a two-component catalyst system consisting of certain metal halides and a compound of the formula  $XAlR(OR')$ , where X is halogen, and R and R' are the same or different alkyl, cycloalkyl, or aryl radicals. Titanium trichloride and titanium tetrachloride are specifically disclosed as suitable metal halides.

The sole issue in this case is obviousness under 35 U.S.C. 103.

Appellant's principal contention is that:

\* \* \* since none of the reference[s] either singly or in combination teach a control of the molecular weight distribution range by specific selection of catalyst components, or even that the nature or composition of the catalyst could have an effect on this molecular weight distribution range, the subject matter of the invention as a whole could not possibly be obvious from the references. \* \* \*

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We agree. Appellant's specification contains ten examples in which various three-component catalyst systems were utilized in the polymerization of ethylene. The systems set forth in three of these examples consisted of (1) titanium trichloride; (2) titanium tetrachloride, and (3) diethyl aluminum monochloride in various molar ratios. These fall within the catalyst systems disclosed by Ruhrchemie. The U value, which according to appellant's specification is a measure of the molecular weight distribution, ranges from 6.3 to 12.8 for such catalysts. In the remaining seven examples, catalyst systems covered only by the appealed claims were employed, with the nonuniformity value  $U^3$  for the resultant polyethylene ranging from 2.6 to 3.9. We believe this to be a convincing demonstration that the alkoxide or aroxide moiety, when present in the catalyst systems of the appealed claims, possesses the property of conferring a significant degree of control over the ultimate molecular weight distribution of polyethylene. This property is neither taught nor suggested by the prior art.

The reasoning of the examiner and the board appears to be as follows: Ruhrchemie discloses a titanium trichloride - titanium tetrachloride - mono - ethyl aluminum dichloride system. This differs from appellant's system only in the latter's use of an alkoxide or aroxide group on either the tetravalent titanium or aluminum component or both. Since Anderson shows a tetravalent titanium compound containing an alkoxide group and Muehlbauer shows an aluminum compound containing an alkoxide group, appellant's catalyst system can be met merely by substitution of such alkoxide groups on the corresponding components of the Ruhrchemie system.

[1] The fallacy of this reasoning is that no one of the references *suggests* such a substitution, quite apart from the result which would be obtained thereby. Such piecemeal reconstruction of the prior art patents in the light of appellant's disclosure is contrary to the requirements of 35 U.S.C. 103. In re Rothermel, 47 CCPA 866, 276 F.2d 393, 125 USPQ 328.

[2] The ever present question in cases within the ambit of 35 U.S.C. 103 is whether the subject matter as a whole would have been obvious to one of ordinary skill in the art following the *teachings* of the prior art at the time the invention was made. It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of

ordinary skill in the art. The Anderson patent is the only reference before us which recognizes the desirability of producing polyethylene with a narrow molecular weight distribution range. Were one to follow the teachings of that patent in its entirety, he would be led to believe that control over the molecular weight distribution of polyethylene was gained independently of the catalyst system, a belief untenable in light of appellant's disclosure.

Both the board and the solicitor apparently assert the position that it is incumbent upon appellant to show that his results are outstanding as compared with the results accomplished by Anderson and Muehlbauer. If this is construed as requiring appellant to show unexpected results accruing from his claimed process, we think he has met the requirement. We perceive no teaching in the prior art of record suggesting that an alkoxide or aroxide moiety in a Ziegler-type catalytic system would produce the results obtained by appellant's process.

The decision of the board is *reversed*.

### Footnotes

Footnote 1. Appellant withdrew the appeal with respect to the only product claim 44, which was drawn to a polyethylene having a narrow molecular weight distribution characterized by a nonuniformity value U of magnitude between 2 and 4.

Footnote 2. Serial No. 753,872, filed August 8, 1958.

Footnote 3. Appellant's specification contains the following description of the nonuniformity value U:

\* \* \* the so-called non-uniformity is used for characterising the range of distribution of the molecular weights. According to G. V. Schulz in H. A. Stuart's *Die Physik der Hochpolymeren*, 2nd vol., the macromolecule in solutions is given on page 754 as:

*Graphic material consisting of a complex mathematical formula set at this point is not available. See text in hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

$\bar{M}_w$  and  $\bar{M}_n$  can be calculated from the molecular weight distribution by current methods (G. V. Schulz and M. Marx: *Makromolekulare Chemie* XIV (1954), pages 53-64).

- End of Case -

**FULL TEXT OF CASES (USPQ2D)**

All Other Cases

**In re Oetiker (CA FC) 24 USPQ2d 1443 In re Oetiker**

U.S. Court of Appeals Federal Circuit  
24 USPQ2d 1443

**Decided October 13, 1992**

**No. 91-1026**

**Headnotes**

**PATENTS**

**1. Practice and procedure in Patent and Trademark Office -- Prosecution -- In general (§ 110.0901)**

**Patentability/Validity -- Obviousness -- In general (§ 115.0901)**

"Prima facie" case is procedural tool of patent examination which allocates burdens of going forward as between examiner and applicant; examiner bears initial burden, on review of prior art or on any other ground, of presenting prima facie case of unpatentability, and if that burden is met, burden of coming forward with evidence or argument shifts to applicant, and after applicant submits such evidence in response, patentability is determined on totality of record, by preponderance of evidence with due consideration to persuasiveness of argument.

**2. Practice and procedure in Patent and Trademark Office -- Board of Patent Appeals and Interferences -- In general (§ 110.1101)**

Board of Patent Appeals and Interferences, in reviewing examiner's decision on appeal, must necessarily weigh all evidence and argument, and board's observation that examiner made prima facie case of unpatentability is not improper, as long as ultimate

determination of patentability is made on entire record.

**3. Practice and procedure in Patent and Trademark Office -- Prosecution -- In general (§ 110.0901)**

**Patentability/Validity -- Obviousness -- In general (§ 115.0901)**

Concept of "prima facie" case of obviousness, which places initial burden on examiner, is of broad applicability and is not limited to chemical practice; that prima facie case may be established, or rebutted, by different forms of evidence in various technologies does not restrict concept to any particular field of technology.

**4. Patentability/Validity -- Obviousness -- Relevant prior art -- In general (§ 115.0903.01)**

**Patentability/Validity -- Obviousness -- Combining references (§ 115.0905)**

Prior art reference, in order to be relied upon as basis for rejecting applicant's invention, must either be in field of applicant's endeavor or, if not, be reasonably pertinent to particular problem with which inventor was concerned; combination of elements from non-analogous sources, in manner that reconstructs applicant's invention only with benefit of hindsight, is insufficient to present prima facie case of obviousness.

**5. Patentability/Validity -- Obviousness -- In general (§ 115.0901)**

Simplicity of invention is not itself inimical to patentability.

**Case History and Disposition:**

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**Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.**

**Application for patent, no. 06/942,694, filed by Hans Oetiker. From decision holding claims unpatentable, applicant appeals. Reversed; Nies, C.J., and Plager, J., concurring in separate opinions.**

**Attorneys:**

**Paul M. Craig, Jr., Washington, D.C., for appellant.**

**John W. Dewhirst (Fred E. McKelvey, solicitor and Robert D.**

**Edmonds, associate solicitor, with him on brief), for appellee.**

**Judge:**

**Before Nies, chief judge, and Newman and Plager, circuit judges.**

### **Opinion Text**

**Opinion By:**

**Newman, J.**

Hans Oetiker appeals the decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences, holding unpatentable claims 1-14 and 6-21, all of the claims in patent application No. 06/942,694. 1 Oetiker appeals on procedural and substantive grounds.

#### **I *PROCEDURE* Background**

All of the claims were finally rejected for obviousness in terms of 35 U.S.C. Section 103. The

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Board, upholding the rejection, stated that "the examiner has . . . established a *prima facie* case of obviousness . . . which is unrebutted by any objective evidence of nonobviousness". Oetiker stated that this Board holding was the first rejection of his claims for being "*prima facie* obvious", and filed rebuttal evidence with a petition for reconsideration. The Board declined to consider the new evidence or change its decision.

Oetiker states that a holding of *prima facie* obviousness means, in patent examination, that the claimed invention is subject to a rebuttable presumption of obviousness; that is, if the applicant can provide evidence or argument in support of unobviousness, such evidence and argument will be considered, and the question of patentability will be redetermined on the entire record. Oetiker states that a rejection made in the words "*prima facie* obvious" is understood by patent examiners and practitioners as an invitation to provide such rebuttal evidence.

Thus Oetiker argues that a holding by the Board of *prima facie* obviousness is a new ground of rejection, for during prosecution the examiner did not reject the claims in these words. Treating it as such, Oetiker offered affidavit evidence not previously filed, and requested reconsideration on the basis of this new evidence, or remand to the examiner for this purpose, in accordance with 37 C.F.R. Section 1.196(b):

Section 1.196(b) . . . When the Board . . . makes a new rejection of an appealed claim, the appellant may exercise either of the following two options . . .:

(1) The appellant may submit . . . a showing of facts . . . and have the matter reconsidered by the examiner in which event the application will be remanded to the examiner. . . .

(2) The appellant may have the case reconsidered under Section 1.197(b) by the Board . . . upon the same record.



The Board on reconsideration granted neither of the options of Section 1.196(b), stating that it had not made a new rejection.

At argument before this court the Commissioner's counsel suggested that Oetiker could refile his patent application, pay a new fee, and obtain review of this new evidence in a new examination. Oetiker states that he was entitled to a complete examination, and did not get it.

### Discussion

[1] The *prima facie* case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant. *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir. 1990). The term " *prima facie* case" refers only to the initial examination step. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.

After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument. *See In re Spada, supra*; *In re Corkill*, 771 F.2d 1496, 1500, 226 USPQ 1005, 1008 (Fed. Cir. 1985); *In re Caveny*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985); *In re Johnson*, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984).

If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *See In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985); *In re Rinehart, supra*.

[2] In reviewing the examiner's decision on appeal, the Board must necessarily weigh all of the evidence and argument. An observation by the Board that the examiner made a *prima facie* case is not improper, as long as the ultimate determination of patentability is made on the entire record. *In re Piasecki*, 745 F.2d at 1472, 223 USPQ at 788; *In re Rinehart*, 531 F.2d at 1052, 189 USPQ at 147.

The record here reveals that the application was fully prosecuted. References were cited and applied by the examiner, the applicant responded with argument, and the examiner then issued a final rejection, stating why he was not persuaded by the applicant's argument. On review the Board stated that its decision was reached "after careful consideration of the appealed claims, the evidence of obviousness relied upon by the examiner and the arguments advanced by the appellant and the examiner". The Board explained why it was unpersuaded by Oetiker's arguments on appeal. We discern no irregularity in the procedure. The Board, in explaining that the examiner's rejections constituted a *prima facie* case of obviousness, did not make a new rejection.

[3] Oetiker also argues that the concept of a " *prima facie* case of obviousness" has no role outside of the chemical arts. Oetiker

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refers to the origins of this term in the chemical practice, where properties may not be apparent from chemical structure. Oetiker distinguishes mechanical inventions, where the properties and workings of a mechanical device are apparent in the drawing of the

structure. We think that the PTO is correct in treating the concept of the *prima facie* case as of broad applicability, for it places the initial burden on the examiner, the appropriate procedure whatever the technological class of invention. That a *prima facie* case may be established, or rebutted, by different forms of evidence in various technologies does not restrict the concept to any particular field of technology. " [T]he requirement of unobviousness in the case of chemical inventions is the same as for other types of inventions". *In re Johnson* , 747 F.2d at 1460, 223 USPQ at 1263. This procedural tool is recognized in fields outside of the chemical arts. *E.g.*, *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985); *In re McCarthy* , 763 F.2d 411, 226 USPQ 99 (Fed. Cir. 1985); *In re De Blauwe*, 736 F.2d 699, 222 USPQ 191 (Fed. Cir. 1984).

The Board's usage of the term *prima facie* was imprecise for, as discussed *supra*, the term " *prima facie* obvious" relates to the burden on the examiner at the initial stage of the examination, while the conclusion of obviousness *vel non* is based on the preponderance of evidence and argument in the record. However, it was clear that the Board did not make a new rejection. Therefore the Board did not err in declining to consider at that stage the proffered evidence of commercial success.

## II THE MERITS

Oetiker's invention is an improvement in a "stepless, earless" metal clamp, a hose clamp that was generally described in an earlier '004 patent of Oetiker, but that differs in the presence of a feature that is described as a preassembly "hook". This "hook" serves both to maintain the preassembly condition of the clamp and to be disengaged automatically when the clamp is tightened.

The cited references were Oetiker's earlier-granted '004 patent, combined with a certain Lauro '400 patent. Lauro describes a plastic hook and eye fastener for use in garments, in which "unitary tabs of sewing needle puncturable plastic material . . . are affixable to clothing and the like by sewing". Oetiker argues that there is no suggestion or motivation to the artisan to combine the teachings of the cited references, and that Lauro is nonanalogous art. Oetiker concludes that these references were improperly combined; that a person of ordinary skill, seeking to solve the problem facing Oetiker, would not look to the garment art for the solution. Oetiker also argues that even if combined the references do not render the claimed combination obvious.

The examiner stated that "since garments commonly use hooks for securement", a person faced with the problem of unreliable maintenance of the pre-assembly configuration of an assembly line metal hose clamp would look to the garment industry art. The examiner explained further by stating that "Appellant's device as disclosed could be utilized as part of a garment". The Board did not repeat or support the examiner's argument, or discuss its relevance. Indeed, the argument is not supportable. However, the Board held that the Lauro reference, although not "within the appellant's specific field of endeavor" is nonetheless "analogous art" because it relates to a hooking problem, as does Oetiker's invention.

The Board apparently reasoned that all hooking problems are analogous. At least, that is the argument now pressed by the Commissioner. The Commissioner states in his brief on appeal that "A disengageable catch, such as that used by Oetiker, is a common everyday mechanical concept that is variously employed in door latches and electrical and other switches, as well as in the hook and eye apparatus disclosed by Lauro". No such

references were cited, however. While this court may take judicial notice of common everyday mechanical concepts in appropriate circumstances, the Commissioner did not explain why a "catch" of unstated structure in an electrical switch, for example, is such a concept and would have made Oetiker's invention obvious. Indeed, the Commissioner did not respond to Oetiker's argument that the cited references provide no teaching or suggestion that Lauro's molded hook and eye fastener, even if combined with Oetiker's '004 clamp, would achieve Oetiker's purpose.

[4] In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *See In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986). Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably

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be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) -- in other words, common sense -- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147, 227 USPQ 543, 551 (Fed. Cir. 1985).

[5] Oetiker's invention is simple. Simplicity is not inimical to patentability. *See Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 279, 60 USPQ 386, 388 (1944) (simplicity of itself does not negative invention); *Panduit Corp. v. Dennison Mfg Co.*, 810 F.2d 1561, 1572, 1 USPQ2d 1593, 1600 (Fed. Cir.) (the patent system is not foreclosed to those who make simple inventions), *cert. denied*, 481 U.S. 1052 (1987). We conclude that the references on which the Board relied were improperly combined. Accordingly, the Board erred in holding the claims unpatentable under section 103. The rejection of claims 1-4 and 16-21 is **REVERSED**.

### Footnotes

Footnote 1. *Ex parte Oetiker*, No. 89-2230 (Bd. Pat App. & Interf. May 31, 1990; on

reconsideration, August 23, 1990).

### Concurring Opinion Text

**Concur By:**

**Nies, C.J., concurring.**

I agree with the panel decision and write only to express my understanding of the language that there must be some teaching, reason, suggestion, or motivation found "in the prior art" or "in the prior art references" to make a combination to render an invention obvious within the meaning of 35 U.S.C. Section 103 (1988). Similar language appears in a number of opinions and if taken literally would mean that an invention cannot be held to have been obvious unless something specific in a prior art reference would lead an inventor to combine the teachings therein with another piece of prior art.

This restrictive understanding of the concept of obviousness is clearly wrong. Other statements in opinions express the idea more generally. We have stated, for example, that the test is: "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention," *In re Gorman*, 933 F.2d at 986, 18 USPQ2d at 1888, and "what the combined teachings . . . would have suggested to one of ordinary skill in the art," *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). We have also stated that "the prior art as a whole must suggest the desirability . . . of making the combination." *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

I believe that it would better reflect the concept of obviousness to speak in terms of "from the prior art" rather than simply "in the prior art." The word "from" expresses the idea of the statute that we must look at the obviousness issue through the eyes of one of ordinary skill in the art and what one would be presumed to know with that background. What would be obvious to one of skill in the art is a different question from what would be obvious to a layman. An artisan is likely to extract more than a layman from reading a reference.

In any event, variance in the language used in opinions does not change the nature of the statutory inquiry. Under section 103, subject matter is unpatentable if it "would have been obvious . . . to a person having

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ordinary skill in the art." While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination. *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988). Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same or similar problem which it addresses. *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA

1979). *See, also, EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 906-07, 225 USPQ 20, 25 (Fed. Cir.), *cert. denied*, 474 U.S. 843 (1985); *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). *See also, Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) ("To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.").

In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference.

### Footnotes

Footnote 1. *See, e.g., Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569, 19 USPQ2d 1241, 1246 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 989, 18 USPQ2d 1885, (Fed. Cir. 1991); *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, (Fed. Cir. 1990); *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988); *In re Stencel*, 828 F.2d 751, 755, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *In re Grabiak*, 769 F.2d 729, 732, 226 USPQ 870, 872 (Fed. Cir. 1985).

### Concurring Opinion Text

**Concur By:**

**Plager, J., concurring.**

I join in the carefully-reasoned and well-written opinion of Judge Newman. With regard to Part I dealing with the PTO procedure, her explanation of the meaning and application of the 'prima facie case' concept should help clarify an area that remains marked by a lack of clarity. The need for that discussion, however, illustrates the pitfalls of the 'prima facie' practice of the PTO, and the difficulties created by this particular legalistically convoluted concept.

An applicant for a patent is entitled to the patent unless the application fails to meet the requirements established by law. It is the Commissioner's duty (acting through the examining officials) to determine that all requirements of the Patent Act are met. The burden is on the Commissioner to establish that the applicant is not entitled under the law to a patent. *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). In rejecting an application, factual determinations by the PTO must be based on a preponderance of the evidence, and legal conclusions must be correct. *In re Caveney*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985).

The process of patent examination is an interactive one. *See generally*, Chisum, *Patents*, Section 11.03 *et seq.* (1992). The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection

harbored by the examiner. The 'prima facie case' notion, the exact origin of which appears obscure ( see *In re Piasecki*, 745 F.2d 1468, 1472, 233 USPQ 785, 788 (Fed. Cir. 1984)), seemingly was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument. To that extent the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness.

But the ultimate decision that must be made by the PTO in the examination process, and by this court on appeal, is not whether a prima facie case for rejection was made; the only question is whether, on the whole record, the applicant has met the statutory requirements for obtaining a patent. When a final rejection is described in terms of whether a prima facie case was made, that intermediate issue diverts attention from what should be the question to be decided.

Specifically, when obviousness is at issue, the examiner has the burden of persuasion and therefore the initial burden of production. Satisfying the burden of production, and thus initially the burden of persuasion, constitutes the so-called prima facie showing. Once that burden is met, the applicant has the burden of production to demonstrate that the examiner's preliminary determination is not correct. The examiner, and if later involved, the Board, retain the ultimate burden of persuasion on the issue.

If, as a matter of law, the issue is in equipoise, the applicant is entitled to the patent. Thus on appeal to this court as in the PTO, the applicant does not bear the ultimate burden of persuasion on the issue. In the end there is no reason there or here to argue over whether a 'prima facie' case was made out. The only determinative issue is whether the record as a whole supports the legal conclusion that the invention would have been obvious.

- End of Case -

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**In re ELLIS**  
**(CCPA)**  
**177 USPQ 526**  
**Decided Apr. 26, 1973**  
**No. 8860**  
**U.S. Court of Customs and Patent Appeals**

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**Headnotes**

**PATENTS**

**1. Patentability — New use or function — Analogous art (§ 51.553)**

**Patentability — New use or function — Nonanalogous art (§ 51.557)**

While diverse Patent Office classification of references is some evidence of nonanalogy and while cross-reference in official search notes is some evidence of analogy, similarities and differences in structure and function of inventions disclosed in references carry greater weight.

**Particular patents—Grating**

Ellis, Floor Grating, claims 1 to 5 of application refused.

**Case History and Disposition:**

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**Appeal from Board of Appeals of the Patent Office.**

**Application for patent of William L. Ellis, Serial No. 618,203, filed Feb. 23, 1967; Patent Office Group 356. From decision rejecting claims 1 to 5, applicant appeals. Affirmed.**

**Attorneys:**

**FRANCIS D. THOMAS, JR., Washington, D.C., for appellant.**

**S. WM. COCHRAN (JOHN W. DEWHIRST of counsel) for  
Commissioner of Patents.**

**Judge:**

Before MARKEY, Chief Judge, RICH, BALDWIN, and LANE, Associate Judges,  
and WATSON, Judge, United States Customs Court, sitting by designation.

**Opinion Text**

**Opinion By:**

**BALDWIN, Judge.**

This appeal is from the decision of the Patent Office Board of Appeals, sustaining the examiner's rejection of claims 1-5, all the claims in appellant's application. <sup>1</sup>

**The Invention**

The claimed invention relates to floor gratings, and can be sufficiently understood from a reading of claim 1 with reference to appellant's Figure 3:

*Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

1. A floor grating, comprising: a plurality of main support members [12], a plurality of secondary support bars [16] supported by said members and extending in fixed parallel spaced relation therebetween,

a plurality of closely spaced wire rod members [18] secured to said secondary load bearing support bars and extended in parallel relation transversely thereacross for providing a walking surface thereover,

said secondary load bearing support bars being sufficiently deep and closely spaced to support said wire rod members for pedestrian traffic without undue flexing therebetween,

and said wire rod members being spaced in the order of  $\frac{1}{2}$  inch or less apart and having an exposed upper surface area more than one-half the open spacing therebetween for providing a substantially contiguous walking surface for pedestrian traffic thereover and the passage of snow and dirt therethrough.

Claim 2 requires that the wire rod members be tapered, to more readily pass dirt and debris. Claims 3-5 differ from claim 2 in respects unnecessary to describe in detail here.

**The Rejection**

The claims were rejected under 35 U.S.C. 103 as being unpatentable over a patent to Schulz <sup>2</sup> in view of a patent to Trixner. <sup>3</sup> Schulz deals with structural gratings which may be used for ceilings, walls, flooring for bridges, etc. While most of Schulz's gratings are filled with concrete in use, Schulz discloses an alternate opening grating not filled with concrete in Figure 8, page 527.

Trixner deals with non-clogging shoe scrapers. The application states:



*Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

The scraper is advantageously constructed so that the gaps cannot be clogged and the individual cleaning elements can be easily removed and replaced, which greatly facilitates cleaning after extensive use and removal of worn individual scraper elements. According to the invention this result is obtained by detachably inserting the channel-shaped rods which receive the rubber elements in corresponding slots in the flat perpendicular rods, and by providing the scraper elements, made of rubber or the like, with a cross section which is tapered from the surface downward.

One embodiment of the scraper is shown in Figure 3:

*Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

The examiner considered that it would have been obvious to closely space the wire rod members of Schulz in view of the Trixner patent. The board affirmed, stating:

It is a matter of notorious knowledge that floor gratings are made with their bars sufficiently close to permit easy walking thereon, such as not to permit woman's narrow heels to be caught therein. In our opinion, the expedient of placing the cross-bars in Fig. 8 of Schulz in close proximity to each other would have been an obvious variant even on the part of persons with less than ordinary skill in the art, particularly in view of Trixner where similar cross members 5 are spaced much closer. The precise spacing is deemed an obvious variant in degree.

\* \* \*

### Opinion

Appellant contends that the two references should not be combined because they are from non-analogous arts. Appellant contends that the Patent Office classification of Schulz's patent was in "Roads and Pavements," that the classification of Trixner's patent was under "Brushing, Scrubbing and General Cleaning," and that the skilled in the art "would not expect to find grid or grating structures which are installed in floors under the art 'Brushing, Scrubbing and General Cleaning.'" To this the Solicitor responds:

[A]ppellant is in error in his belief (Br-3) that Schulz is classified in the "Roads and Pavements" art. On the contrary, Schulz is classified with the "Static Structures" art (Class 52), in an area providing for structures having exposed surfaces for increasing friction or reducing wear caused by pedestrian traffic. Also of significance is the fact that the official search notes for this area of Class.52 direct the searcher to Class 15-238, where Trixner is classified, for related art. \* \*

\*

[1] While we find the diverse Patent Office classification of the references to be *some* evidence of "non-analogy," and likewise find the cross-reference in the official search notes to be *some* evidence of "analogy," we consider the similarities and differences in structure and function of the inventions disclosed in the references to carry far greater weight. Cf. *In re Heldt*, 58 CCPA 701, 706-07, 433 F.2d 808, 812, 167 USPQ 676, 679 (1970). Here the structural similarities and the functional overlap between pedestrian gratings and shoe scrapers of type shown by Trixner are readily apparent. We conclude

that, at the very least, the arts to which the Schulz and Trixner patents belong are *reasonably pertinent* to the art with which appellant's invention deals. See *In re Antle*, 58 CCPA 1382, 1387, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (1971).

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We have carefully considered appellant's other arguments. However, we are convinced on the record before us that it would have been obvious for one skilled in the art to arrange the wire rod members of Schulz in closer proximity, as shown by Trixner's scraper rods, should it be desired to avoid the catching of women's heels in pedestrian gratings. Accordingly, the decision of the board is *affirmed*.

### Footnotes

Footnote 1. Serial No. 618,203, filed February 23, 1967.

Footnote 2. U. S. Patent No. 2,031,007, issued February 18, 1936.

Footnote 3. Austrian Patent No. 175,037, published May 26, 1953.

- End of Case -

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**Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.**

**(CA FC)**

**230 USPQ 416**

**Decided July 14, 1986**

**No. 85-2578**

**U.S. Court of Appeals Federal Circuit**

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**Headnotes**

**PATENTS**

**1. Patentability -- Invention -- In general (§ 51.501)**

Federal district court erred by holding laser-marked contact lens patent to be invalid, in view of court's failure to grant patent its statutory presumption of validity, its over-reliance upon inventor's alleged opinion as to non-obviousness, its misuse of such opinion as substitute for determining level of skill of hypothetical person of ordinary skill, its use of improper hindsight analysis, its failure to consider prior art reference in its entirety, and its erroneous reliance upon irrelevant experiments.

**2. Infringement -- Tests of -- Comparison with claim (§ 39.803)**

Federal district court erred in its finding of non-infringement of contact lens patent, since court, in considering whether accused lenses were "smooth" like patented lenses, did not construe meaning of term "smooth" by resorting to specification, but instead distorted patent's claims by assessing smoothness according to approach that exceeded level of smoothness required in claim.

**Particular patents -- Contact Lenses**

4,194,814, Fischer, McCandless, and Hager, Transparent Ophthalmic Lens Having Engraved Surface Indicia, holding of invalidity and non-infringement vacated.

**Case History and Disposition:**

**Appeal from District Court for the Northern District of California, Aguilar, J.; 226 USPQ 780 .**

**Action by Bausch & Lomb, Inc., against Barnes-Hind/Hydrocurve, Inc., and Barnes-Hind International, Inc., for patent infringement, in which defendants counterclaim for declaration of patent invalidity and non-infringement. From judgment for defendants, plaintiff appeals. Vacated and remanded.**

**Attorneys:**

**Laurence H. Pretty, and Pretty, Schroeder, Brueggemann & Clark, both of Los Angeles, Calif. (Craig S. Summers, Bernard D. Bogdin, and Howard S. Robbins, all of Rochester, N.Y., on the brief) for appellant.**

**John M. Calimafde, and Hopgood, Calimafde, Kalil, Blaustein & Judlowe, both of New York, N.Y. (Eugene J. Kalil, Dennis J. Mondolino, and Gilbert W. Rudman, all of Tuckahoe, N.Y., on the brief) for appellees.**

**Judge:**

**Before Markey, Chief Judge, Friedman, Circuit Judge, and Nichols, Senior Circuit Judge.**

**Opinion Text**

**Opinion By:**

**Nichols, Senior Circuit Judge.**

**Appellant Bausch & Lomb, Inc. filed suit in the United States District Court for the North**

**ern District or California, alleging that appellee Barnes-Hind/Hydrocurve, Inc. and Barnes-Hind International, Inc. (hereinafter Barnes-Hind) infringed patent No. 4,194,814 ('814 patent) in the manufacture and sale of its laser-marked contact lens. Barnes-Hind denied infringement and counterclaimed that the '814 patent was invalid, void, and unenforceable. In No. C-83-20283-RPA, Judge Aguilar found the patent invalid for obviousness and not infringed. We vacate and remand.**

**Appellee Barnes-Hind relied to a large extent on deposition testimony which was never introduced into evidence. Because this testimony was not in evidence, it would have been improper for us to consider it and, therefore, we did not. This eliminated much of Barnes-Hind's arguments on appeal.**

## **Background**

### **1. The Technology**

Vision correcting contact lenses have become familiar; hard contact lenses were introduced in the early 1950's and soft lenses in 1971. Toric contact lenses, which correct for the eye condition known as astigmatism, have a similar history of usage: hard lenses from the early 1950's and soft from the first half of the 1970's. Toric lenses differ from standard contact lenses in having a prism base, *i.e.*, one edge portion of the lens is thicker. Proper prescription and fitting of toric lenses on the cornea of the eye requires alignment of a central lens axis with this prism base. Markings on the contact lens surface greatly facilitate the fitting process.

Inks and other substances have been used since the early 1950's, however, those marking procedures suffer several disadvantages: difficulty of accurate application with possible FDA disapproval; possibility of dissolution, blurring, and allergic reactions. Mechanical marking, as with a sharp scribing tool or an abrading tool such as a dental bur, is also available, but not without its problems: inaccurate and inconsistent positioning of the mark, lens damage, inadequate visibility, and the expense and time involved.

### **2. The Patent**

The '814 patent, entitled Transparent Ophthalmic Lens having Engraved Surface Indicia, discloses an engraved contact lens and provides a method of engraving using a source of high intensity electro-magnetic energy, such as a laser. The mark, not as deep as the lens is thick, is surrounded by a smooth surface of unsublimated or unaffected polymer material with the result that edges of the markings do not inflame or irritate the eyelid of the lens wearer.

The claims in suit are 1, 2, and 7. Claim 1 provides:

An ophthalmic lens adapted to be placed in direct contact with eye tissue formed of a transparent cross-linked polymer material, said lens being characterized by identifying indicia engraved in a surface thereof by subjecting said lens to a beam of radiation emerging from a laser having an intensity and wavelength at least sufficient to sublimate said polymer and form depressions in said lens surface to a depth less than the thickness of said lens, said lens having a smooth surface of unsublimated polymer material surrounding said depressions, and by varying in a predetermined manner the point at which said laser beam impinges upon said lens surfaces to engrave said identifying indicia in said lens surface.

Claim 2 depends from claim 1 with the limitation that the lens is formed by a cross-linked hydrophilic (water loving) polymer. Claim 7, a product claim, is similar to claim 1 but defines the depressions as relieved zones.

### **3. The Dispute**

In February 1976, Mr. Donald Hager, then production manager at the Milton Roy Company, a manufacturer of soft contact lenses which was purchased by appellant Bausch & Lomb in 1979, sent to Carco, Inc., a distributor of laser equipment, six soft contact lenses for laser marking. At least two lenses were successfully marked. Around September 1976, Dr. David Fisher and Mr. James A. McCandless, also of Milton Roy Company, met with Mr. Hager to debrief him on the work. Soon thereafter, Mr. Hager resigned.

Dr. Fisher and Mr. McCandless continued to work on the lens-marking system, and in

November 1977 filed an application for the patent in suit, listing themselves and Mr. Hager as inventors. Mr. Hager declined to execute the patent application, being at that time the employee of another lens manufacturing company, Sauflon International, Inc. and saying that he had not "invented anything in connection with laser marking of contact lens." He further said that he could not execute documents, under oath or otherwise, that represent the contrary. The patent and Trademark Office (PTO) initially, and on a second occasion, rejected all the claims as obvious over two prior art U.S. patents to Brucker (No. 3,833,786) (teaching the use of a laser to fenestrate, i.e., make holes, in contact lens to allow circulation of fluid through the lens) and to Caddell (No. 3,549,733) (disclosing the use of a laser to remove plastic from the surface of a printing plate to form a pattern). The PTO later issued the patent in 1980 as limited to a transparent cross-linked polymer having a smooth surface around the mark. Mr. Hager

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did sign as inventor in 1982. Meanwhile, Milton Roy commenced manufacture and marketing of laser-marked soft contact lenses in 1978.

Barnes-Hind's predecessor, Continuous Curve, Inc., introduced under the trademark HYDROCURVE a line of soft toric lenses around 1975-76 that were marked with an indentation by a bur. In 1981, Barnes-Hind offered a soft toric lens marked by a laser.

Bausch & Lomb filed suit, contending that certain laser-marked contact lenses manufactured and sold by Barnes-Hind infringe claims 1, 2, and 7 of the '814 patent. Barnes-Hind denied infringement and counterclaimed that the patent was invalid, void, and unenforceable. The parties narrowed the issue of infringement to whether the marks on the HYDROCURVE lenses are surrounded by a smooth surface of unsublimated polymer material with respect to claims 1 and 2 or a smooth and unaffected surface for claim 7.

#### **4. The District Court Proceedings**

The district court determined that Barnes-Hind "proved by clear and convincing evidence that the patent in suit (4,194,814) and each of its claims is invalid and therefore void." It concluded that the differences between the claims and the prior art would have been obvious, finding that "the fact that the claimed subject matter of the patent in suit was obvious to Mr. Hager is most indicative of the obviousness of the invention," and that "Dr. Brucker's experiments in laser marking contact lenses are further evidence in support of this court's finding of obviousness." The court further concluded that scanning electron microscope (SEM) photographs, showing "that the surface of these lenses surrounding the laser mark are not 'smooth and unsublimated' or 'unaffected' as those terms were defined by plaintiff [appellant] during the processing of the patent in suit," demonstrated lack of infringement in any case. Bausch & Lomb appealed.

#### **Opinion**

The judgment is premised on several legal errors: (1) disregard of the presumption of validity established by 35 U.S.C. § 282; (2) absence of the factual findings on the four inquiries mandated by *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966); and (3) improper claim construction leading to the conclusion of noninfringement. We vacate the court's opinion and remand for a determination consistent with this opinion.

## 1. *Presumption of Validity*

A patent shall be presumed valid, and each claim shall be presumed valid independently of the validity of other claims. 35 U.S.C. § 282. The burden is on the party asserting invalidity to prove it with facts supported by clear and convincing evidence. *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 872, 228 USPQ 90, 97 (Fed. Cir. 1985); *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984).

The record contains no reference to this statutory presumption of validity, nor does it appear that the district court considered separately the validity of the three claims at issue. By merely holding that "defendants have proved by clear and convincing evidence that the patent in suit (4,194,814) and each of its claims is invalid and therefore void," the district court improperly denied the '814 patent its statutory presumption of validity as to each claim.

The district court thought the examiner had been misled. Barnes-Hind argued and argues here that Bausch & Lomb (or rather its later acquired company Milton Roy) misled the examiner during prosecution. Appellees assert that "if the examiner had been correctly and forthrightly informed of Hager's and McCandless' opinions, the chemistry of the Brucker lens, and the teaching of the Caddell patent, he would not have issued the patent." The record, however, does not support this assertion.

The examiner did know of Hager's temporary refusal to execute the application during prosecution and, as discussed more fully *infra*, a determination of nonobviousness is based, *inter alia*, on the opinion of a hypothetical person of ordinary skill in the art, not on the inventors' opinion. The weight to be attached to Hager's refusal cannot be exaggerated as the court below has done without clear error in view of Hager's self interest as an employee of a competitor and his later change of position. Instances of inventors refusing even to cooperate in obtaining issuance of a patent to be owned by an assignee are common and machinery is provided in 37 C.F.R. § 1.47 to deal with them. Section 1.47 provides that either a joint inventor or a proper assignee may file the application without the consent or signature of the inventor, just so the oath or declaration is accompanied by a petition including proof of pertinent facts. It is clear, therefore, that the PTO does not allow the inventor to erect that type of obstacle to obtaining patent protection. Such forethought is necessary, as otherwise an inventor's changed self interest might nullify a proper assignment. The district court's heavy reliance on Mr. Hager's assertions, if persisted in, would allow a co-inventor another chance at sabotage if the first effort has failed.

Finally, the examiner, who with the deference we owe governmental officials we assume has some expertise in interpreting the refer

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ences and some familiarity with the level of skill in the art, *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359, 220 USPQ 763, 770 (Fed. Cir.), *cert. denied*, \_\_\_ U.S. \_\_\_, 105 S.Ct. 95, 224 USPQ 520 (1984), did have the Brucker and Caddell patents before him. Barnes-Hind's "misleading the examiner" contention is insufficiently supported to overcome the presumption of validity.

As a final matter, we recognize, as the district court did not, that when the prior art before the court is the same as that before the PTO, the burden on the party asserting invalidity is more difficult to meet. *American Hoist*, 725 F.2d at 1359, 220 USPQ at 770.

## 2. *Graham Findings*

Obviousness under 35 U.S.C. § 103 is a question of law based on the underlying factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966): (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) objective evidence of secondary considerations. See, e.g., *Loctite*, 781 F.2d at 872, 228 USPQ at 97-98.

The *Loctite* court further stated:

In patent cases, the need for express *Graham* findings takes on an especially significant role because of an occasional tendency of district courts to depart from the *Graham* test, and from the statutory standard of obviousness that it helps determine, to the tempting but forbidden zone of hindsight. Thus we must be convinced from the opinion that the district court actually applied *Graham* and must be presented with enough express and necessarily implied findings to know the basis of the trial court's opinion.

*Id.*, 228 USPQ at 98.

Here, as in *Loctite* and in *Jones*, we are not convinced that the district court applied the *Graham* findings. Instead, it found Mr. Hager's opinion that the subject matter was obvious "most indicative of the obviousness of the invention." This was legal error.

Unlike the district court, we have the benefit of the very clear exposition of the law in *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 454, 227 USPQ 293, 297-98 (Fed. Cir. 1985):

The issue of obviousness is determined entirely with reference to a *hypothetical* "person having ordinary skill in the art." It is only that hypothetical person who is presumed to be aware of all the pertinent art. The actual inventor's skill is irrelevant to this inquiry, and this is for a very important reason. The statutory emphasis is on a person of *ordinary* skill. Inventors, as a class, according to the concepts underlying the Constitution and the statutes that have created the patent system, possess something -- call it what you will -- which sets them apart from the workers of *ordinary* skill, and one should not go about determining obviousness under § 103 by inquiring into what *patentees* (i.e., inventors) would have known or would likely have done, faced with the revelation of references.

[Emphasis in original.]

[1] In this regard then, the district court erred at least three times: it relied too heavily on the alleged opinion of one who was an inventor and patentee, and misused that opinion as a substitute for determining the level of skill of the hypothetical person of ordinary skill and what that person would have been able to do when in possession of the prior art, the scope and contents of which the court should also have determined.

The court also engaged in improper hindsight analysis to conclude the '814 patent would have been obvious. The court essentially adopted Barnes-Hind's argument that "the concept of forming ridgeless depressions having smooth rounded edges using a laser beam to vaporize the material is explicitly disclosed in the Caddell patent. *This is exactly the same process claimed in the patent-in-suit and practiced by the plaintiff.*"

Barnes-Hind selected a single line out of the Caddell specification to support the above assertion: "one way in which this [forming ridgeless depressions] can be achieved is to use a laser with high enough intensity to vaporize the plate material without melting



it." Col. 5, lines 53-54. This statement, however, was improperly taken out of context. As the former Court of Customs and Patent Appeals held:

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.

*In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); *see also In re Mercer*, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778 (CCPA 1975).

A full appreciation of Caddell's statement requires consideration of the immediately following sentences in the same paragraph and the paragraph after that. Viewed in that context, it is apparent that Caddell's ideal printing plate would have no ridges around the depression. The use of a high intensity laser is offered as a possible means to achieve the goal but is limited by several disadvantages. To overcome these disadvantages, Caddell suggests the use of a special class of polymer that forms ridgeless depressions. A complete read

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ing demonstrates quite clearly that Caddell is setting up a strawman and pointing out its disadvantages to highlight the advantages of Caddell's invention, that special class of polymers. The district court improperly viewed an isolated line in Caddell in light of the teaching of the '814 patent to hold for obviousness. This is improper hindsight analysis.

The district court also failed to consider the Caddell reference in its entirety and thereby ignored those portions of the reference that argued against obviousness. *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, \_\_\_ U.S. \_\_\_, 105 S. Ct. 172 (1984). Caddell compared the ridge formation of his special class of polymers against, *inter alia*, Lucite, a copolymer composed of ethyl acrylate with methylmethacrylate -- very similar to the chemical referred to in the '814 patent -- and found that *only* his special class formed depressions without ridges. Thus, Caddell actually taught away from laser etching of soft contact lenses.

As further evidence of obviousness, the district court relied on Dr. Brucker's experiments in laser marking contact lenses. This too was error, in this case clearly erroneous factual error. The record does not support, indeed it contradicts, the supposition that Dr. Brucker had engaged in laser marking of soft contact lenses at the time of the present invention. On page 385 of the Appendix, in reply to Mr. Calimafde's question "when did Continuous Curve begin to experiment with laser marking of soft contact lenses?", Dr. Brucker replied "I believe it was in '79 -- '79, '80, somewhere in that area." The filing date of the '814 patent was November 10, 1977. Brucker's 3,833,786 patent for a method of fenestrating (putting windows in) contact lenses applies according to its claims to such lenses, both soft and hard. However, the record reflects that the need for such fenestration was as a mode of escape for fluid accumulating between the lens and the eye. Such a need does not exist respecting the soft lenses, the principal subject of the claims in suit, of which claim 2 is expressly limited to soft lenses. They, being hydrophilic, absorb the fluid.

In sum, the district court improperly determined the '814 patent was obvious: it failed to make the Graham inquiries, it improperly focused on what was obvious to the inventor,

it engaged in hindsight analysis, and it considered evidence that was not prior art. This court, as an appellate court, may not make the required Graham factual findings, and must therefore remand that determination to the district court. The district court should not ignore the four-part analysis the authorities require.

**a. The scope and content of prior art**

To determine whether a reference is within the scope and content of the prior art, first determine if the reference is within the field of the inventor's endeavor. If it is not, then next consider whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Richard M. Deminski*, 230 USPQ 313, 315, No. 85-2267, slip op. at 9 (Fed. Cir. July 8, 1986); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983). *Orthopedic Equipment Co., Inc. v. United States*, 702 F.2d 1005, 1008-11, 217 USPQ 193, 196-97 (Fed. Cir. 1983) focused on the claims in suit, the art the PTO applied to the claims, and the nature of the problem confronting the inventor. Further, the art must have existed as of the date of invention, presumed to be the filing date of the application until an earlier date is proved.

**b. The differences between the claimed invention and the prior art**

The court must view the claimed invention *as a whole*. See, e.g., *Jones*, 727 F.2d at 1527-28, 220 USPQ at 1024. We add, as a cautionary note, that the district court appeared to distill the invention down to a "gist" or "core," a superficial mode of analysis that disregards elements of the whole. It disregarded express claim limitations that the product be an ophthalmic lens formed of a transparent, cross-linked polymer and that the laser marks be surrounded by a smooth surface of unsublimated polymer. See also, *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984).

**c. Level of ordinary skill in the art**

In *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 697, 218 USPQ 865, 868-69 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984), the court listed six factors relevant to a determination of the level of ordinary skill: educational level of the inventor, type of problems encountered in the art, prior art solutions, rapidity of innovation, sophistication of technology, and educational level of active workers in the field. As to educational level of the inventor, see *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 227 USPQ 293 (Fed. Cir. 1985); *Orthopedic Equipment Co. v. All Orthopedic Appliances*, 707 F.2d 1376, 1382, 217 USPQ 1281, 1285 (Fed. Cir. 1983) ("Although the educational level of the inventor may be a factor in determining the level of ordinary skill in the art, it is by no means conclusive.")

**d. Objective indicia of obviousness**

Such "secondary considerations," when present, must always be considered. *Stratoflex*, 713 F.2d at 1538, 218 USPQ at 878-79. See also *Cable Electric Products, Inc. v. Genmark*,

*Inc.*, 770 F.2d 1015, 1026-28, 226 USPQ 881, 887-88 (Fed. Cir. 1985). Such evidence includes commercial success, long felt but unresolved needs, and failed attempts. *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 895-96, 221 USPQ 669, 675 (Fed.

Cir.), *cert. denied*, \_\_\_ U.S. \_\_\_, 105 S.Ct. 187, 225 USPQ 792 (1984).

We shall vacate the trial court's opinion and remand for an obviousness determination consistent with this opinion.

### **3. Infringement**

The parties narrowed the infringement issue for trial to the question whether the surface of Barnes-Hind lenses surrounding the laser mark is "smooth and unsublimated" or "unaffected." The district court concluded that "the laser-engraved depressions in the surface of the HYDROCURVE II lenses have been examined by scanning electron microscope. These photographs show that the surface of these lenses surrounding the laser mark are not 'smooth and unsublimated' or 'unaffected' as those terms were defined by plaintiff during the prosecution of the patent in suit." Appellant Bausch & Lomb argues on appeal that the trial court's approach of assessing smoothness at the very high levels of magnification obtainable by a SEM exceeds the level of smoothness required in the claims. We agree.

Because the first step in determining infringement is claim construction, improper claim construction can distort the entire infringement analysis. *Moeller v. Lonetics, Inc.*, 229 USPQ 992, 994, No. 85-2646, slip op. at 7 (Fed. Cir. June 4, 1985). Such a distortion occurred below.

Disputed issues such as the meaning of the term "smooth," should be construed by resort to extrinsic evidence such as the specification, other claims, and the prosecution history. Here, resort to the specification clearly demonstrates that "smooth" meant that "the edges of the craters neither inflame nor irritate the eyelid of the lens wearer \* \* \*." The markings provided on the lens surface in accordance with this invention \* \* \* are not perceived by the lens wearer \* \* \*." The prosecution history supports this construction. A reading of the amendment and its accompanying remarks demonstrates that smooth means the absence of a ridge that "would scratch either the eye or eyelid and would lead to infection." There is no indication that smooth means absolutely ridge-free. (This review of the prosecution history also leads us to disagree with Barnes-Hind's final argument that the prosecution history estops Bausch & Lomb from asserting infringement against the allegedly ridged HYDROCURVE lens.) Testimony from Dr. Mandell, Bausch & Lomb's expert in the field of contact lenses, indicates that to a person of ordinary skill in the art, smooth would mean an absence of "roughness or significant elevation" so that a wearer "would not feel it with the [eye]lid." Further, there is testimony that a person of ordinary skill in the art would use an optical microscope, not an SEM, to gauge the relative smoothness of an etched contact lens.

[2] We hold that smooth means smooth enough to serve the inventor's purposes, *i.e.*, not to inflame or irritate the eyelid of the wearer or be perceived by him at all when in place. Accordingly, we vacate the district court's conclusion that the surface of the HYDROCURVE lenses are not smooth or unaffected, and remand for a determination of infringement based on the proper construction of and proper test for smooth.

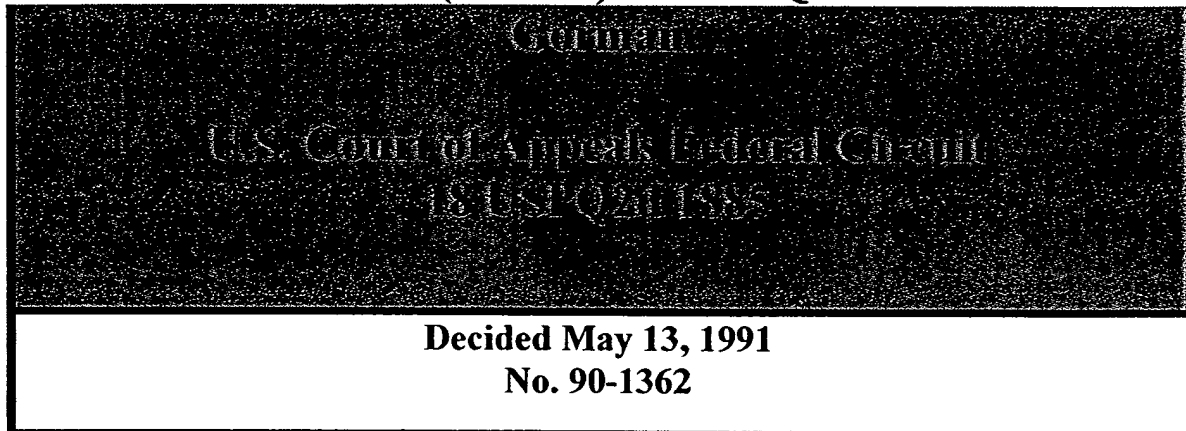
### **Conclusion**

We vacate the district court's determination that the '814 patent is invalid and remand for a reconsideration of validity in light of the presumption of validity and the *Graham* findings on obviousness. We further vacate the decision of noninfringement and remand for proper claim construction and infringement analysis.

### **VACATED AND REMANDED**

**FULL TEXT OF CASES (USPQ2D)**

All Other Cases

**In re Gorman (CA FC) 18 USPQ2d 1885 In re****Headnotes****PATENTS****1. Patentability/Validity - Obviousness - Combining references (§ 115.0905)**

Patent and Trademark Office's reliance on teachings of large number of references in rejecting patent application for obviousness does not, without more, weigh against holding of obviousness on appeal, since criterion is not number of references, but whether references are in fields which are same as or analogous to field of invention, and whether their teachings would, taken as whole, have made invention obvious to person skilled in that field.

**2. Patentability/Validity - Construction of claims (§ 115.03)****Patentability/Validity - Obviousness - In general (§ 115.0901)**

Claim which describes features of invention in great detail is nevertheless obvious in view of prior art, since claim that is narrowly and specifically drawn must still meet requirements of 35 USC 103, and details listed in claim are shown in references and thus do not contribute to unobviousness.

**3. Patentability/Validity - Obviousness - Relevant prior art - Particular inventions (§ 115.0903.03)****Patentability/Validity - Obviousness - Combining references (§ 115.0905)**

Application claim for candy sucker on stick, molded in elastomeric mold in shape of human thumb, is obvious in view of prior art, since all elements of claim, including molded lollipop having chewing gum base plug, with elastomeric mold serving as product wrapper, and candy in shape of human thumb, are shown in prior art references in various subcombinations, used in same manner and for same purpose as in claimed invention.

**Case History and Disposition:**

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**Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.**

**Patent application of Jeffrey B. Gorman and Marilyn Katz, serial no. 06/882,480 (composite food product). From decision of Board of Patent Appeals and Interferences upholding examiner's rejection of all claims in application, applicants appeal. Affirmed.**

**Attorneys:**

**Thomas W. Tolpin, Highland Park, Ill., for appellant.**

**Teddy S. Gron, associate solicitor (Fred E. McKelvey, solicitor, with him on brief), for appellee.**

**Judge:**

**Before Rich, Newman, and Rader, circuit judges.**

**Opinion Text****Opinion By:**

**Newman, J.**

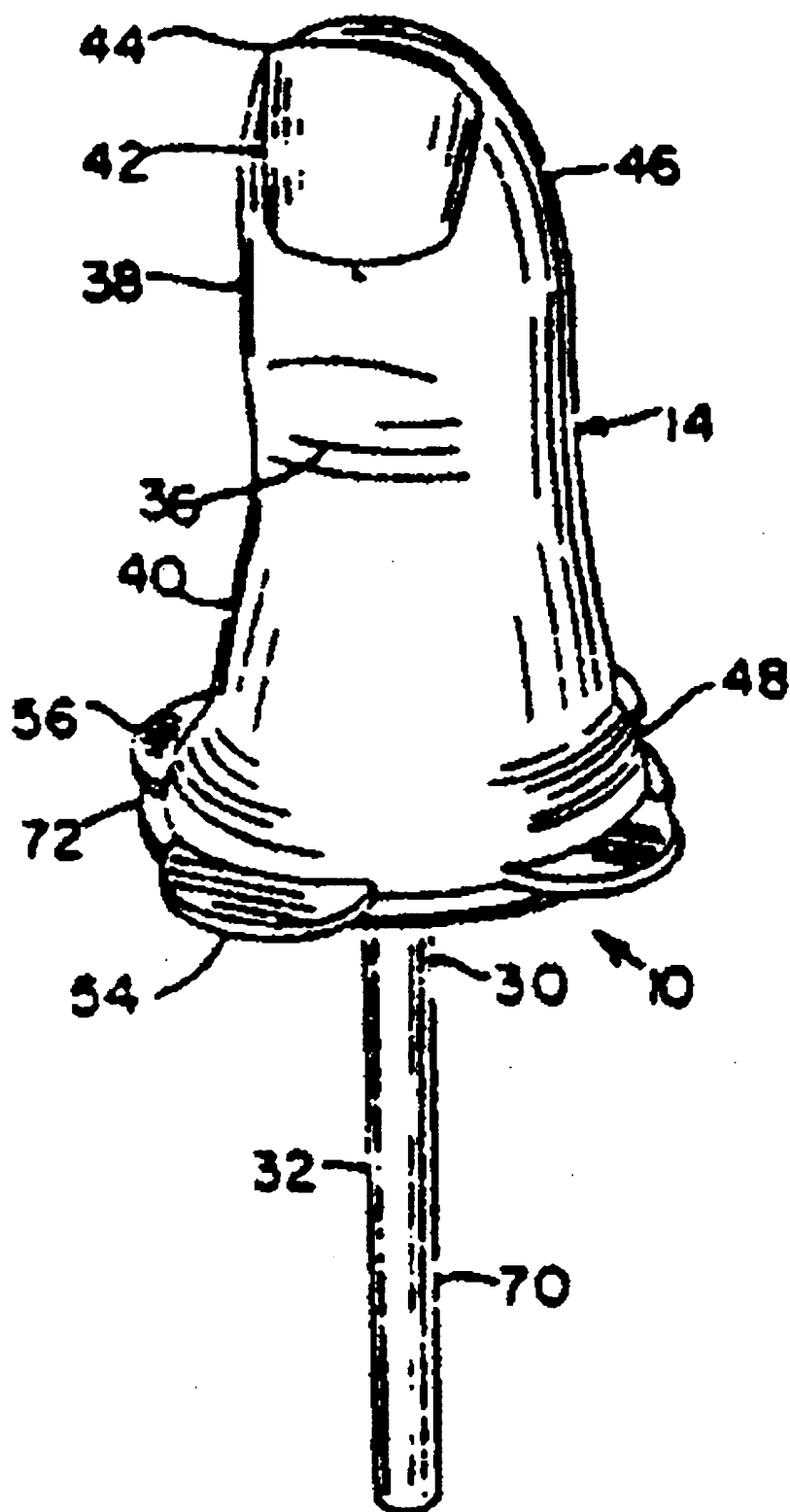
Jeffrey B. Gorman and Marilyn Katz (hereinafter "Gorman") appeal the decision of the United States Patent and Trademark Office, Board of Patent Appeals and Interferences (the "Board") denying patentability to all the claims of Gorman's patent application Serial No. 06/882,480, entitled "Composite Food Product." We affirm.

### ***The Invention***

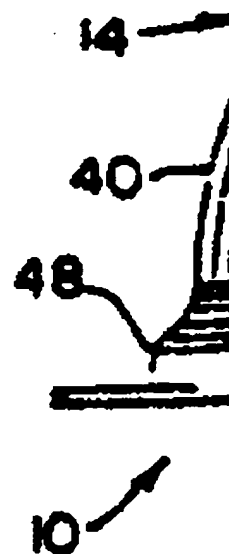
The claimed invention is a composite candy sucker on a stick, molded in an elastomeric mold in the shape of a human thumb. During the manufacturing process liquid candy is poured into the mold, and an edible plug of bubble or chewing gum or chocolate or food-grade wax is poured into the mold after the candy has hardened, serving as a seal for the end portion of the candy. A paper or plastic disc abuts and covers the plug. The mold serves as a cover that can be removed from the candy by means of protruding flanges. The cover is described as a "toy and novelty item".

Figure 1 shows the invention in the form in which it is marketed. Figure 2 shows the cover partially removed to reveal the candy portion (12) and the chewable or edible plug (58):

FIG. 1



46-



The claims describe the product in detail, as is apparent from claim 16, the claim pressed by Gorman in this appeal:

16. A composite food product, comprising:

a candy core, said candy core being in a generally liquified form when formulated,

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heated, blended and poured into a mold and in a substantially thumb-shaped hardened form when cooled and removed from said mold;

said thumb-shaped hardened form comprising said candy core positioned along a vertical axis and comprising a rigid joint-shaped portion, a rigid upper portion extending upwardly from said rigid joint-shaped portion along said vertical axis, and a rigid lower portion extending downwardly from said rigid joint-shaped portion along said vertical axis, said upper portion having a rigid finger nail-shaped portion with an upper rigid tip providing a rigid top end of said thumb-shaped hardened form and a rigid convex back extending rearwardly and downwardly from said rigid tip, and said rigid lower portion having a rigid bottom end and defining a recessed opening comprising a handle-receiving socket about said vertical axis;

a removable resilient shell comprising a substantially thumb-shaped, elastomeric material selected from the group consisting of rubber and flexible plastic, said shell providing a mold for receiving and molding said liquified candy form,

a removable outer protective cover positioned about and covering said hardened form comprising said candy core, and

a toy and novelty item for placement upon the thumb of the user when removed from said hardened form comprising said candy core;

said thumb-shaped elastomeric material comprising said removable resilient shell comprising a flexible joint-shaped portion, a flexible upper portion extending upwardly from said flexible joint-shaped portion along said vertical axis, and a flexible lower portion extending downwardly from said flexible joint-shaped portion along said vertical axis, said upper portion having a flexible finger nail-shaped portion with an upper flexible tip providing a flexible top end of said shell and a flexible convex back extending rearwardly and downwardly from said flexible tip, and said flexible lower portion having an enlarged open ended diverging base, said base having a larger circumference and transverse cross-sectional area than other portions of said shell and providing the bottom of said shell, said open ended base defining a plug-receiving chamber and an access opening for entrance of said liquified form and discharge of said hardened candy form, and a set of substantially symmetrical arcuate lobes extending radially outwardly from said base, said lobes being circumferentially spaced from each other and providing manually grippable flange portions to facilitate manual removal of said shell from said core;

a plug positioned in said plug-receiving chamber adjacent said bottom of said shell, said plug abutting against the bottom of said core and providing a cap for substantially plugging and sealing the open end of said mold and cover to help enclose said candy core, and said plug comprising a food grade material selected from the group consisting of bubble gum, chewing gum, chocolate, and food grade wax;

a handle having a connecting portion connected to said plug and said candy core and positioned in said plug-receiving opening and having a manually grippable handle



portion extending downward from said connecting portion along said vertical axis; and a substantially planar annular disk for abuttingly engaging and removably seating against said base and said lobes adjacent said plug, said disk defining a central axial hole for slidably receiving said handle portion and having an outer edge with a maximum span larger than said access opening but less than the maximum diameter of said symmetrical set of lobes to substantially minimize the interference with manually gripping of said manual grippable flange portions of said lobes, said disk being of a material selected from the group consisting of paper, paperboard, and plastic, and providing a removable closure member and seal for substantially closing said access opening and sealing said plug and said candy core within said shell.

The claims were rejected in view of thirteen references. The primary references, patents to Siciliano, Copeman, and Pooler, show ice cream or candy molded in a plastic, rubber or elastomeric mold. In Siciliano and Copeman the mold also serves as the product wrapper. In Siciliano the ice cream is poured into the mold, a stick is inserted, the ice cream is hardened, and a cardboard cover seals the area between the stick and the elastomeric wrapper. Copeman and Kuhlke show candy lollipops molded in elastomeric molds. Copeman states that the mold may take "varying shapes, such as in the form of fruit, or animals" and Kuhlke discusses the desirability of sealing candy from the outside air. In Siciliano, Copeman and Kuhlke, the mold is peeled from the confection prior to use.

The two Nolte patents teach that gripping flanges may be placed on an ice cream wrap

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per to facilitate removal. Ahern and Knaust each show a disc-shaped seal or cover for a frozen confection. Ahern shows the cover in conjunction with ice cream on a stick. Harris shows a hollow thumb-shaped lollipop into which the thumb is inserted, and Craddock shows a thumb-shaped confection supported on a disc-shaped handle; in both cases without the other elements shown by Gorman. Fulkerson shows a candy coating surrounding a block of ice cream, and a candy plug for retaining liquid syrup inside a cavity in the ice cream. Webster shows chewing gum entirely enclosing a liquid syrup product. Spiegel shows a chocolate layer having an alcohol diffusion barrier to plug the end of a plastic container of liqueur. Fulkerson, Webster and Spiegel all suggest the greater appeal to consumers of providing two different components in the same confection.

The Board found that all of the features of Gorman's product were known to the art, and that various combinations of these elements existed in known similar structures. The Board concluded that the applicant's claimed combination was suggested by and would have been obvious in light of the references.

### ***Discussion***

#### ***A***

Each element of the Gorman claims is in the prior art, separately or in sub-combination. Gorman argues that when it is necessary to combine the teachings of a large number of references in order to support a rejection for obviousness under 35 U.S.C. §103, this of itself weighs against a holding of obviousness.

[1] The criterion, however, is not the number of references, but what they would have

meant to a person of ordinary skill in the field of the invention. In *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987), the court held that a combination of about twenty references that "skirt[ed] all around" the claimed invention did not show obviousness. In other instances, on other facts, we have upheld reliance on a large number of references to show obviousness. Compare *In re Miller*, 159 F.2d 756, 758-58, 72 USPQ 512, 514-15 (CCPA 1947) (rejecting argument that the need for eight references for rejection supported patentability) with *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1149, 219 USPQ 857, 860 (Fed. Cir. 1983) (where teachings relied upon to show obviousness were repeated in a number of references, the conclusion of obviousness was strengthened). See also, e.g., *In re Troiel*, 274 F.2d 944, 947, 124 USPQ 502, 504 (CCPA 1960) (rejecting appellant's argument that combining a large number of references to show obviousness was "farfetched and illogical").

Determination of whether a new combination of known elements would have been obvious to one of ordinary skill depends on various facts, including whether the elements exist in "analogous art", that is, art that is reasonably pertinent to the problem with which the inventor is concerned. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986). When the references are all in the same or analogous fields, knowledge thereof by the hypothetical person of ordinary skill is presumed, *In re Sernaker*, 702 F.2d 989, 994, 217 USPQ 1, 5 (Fed. Cir. 1983), and the test is whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention. See *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990) (quoting *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986)).

The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the applicant's invention. As in all determinations under 35 U.S.C. §103, the decisionmaker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps.

*Interconnect Planning*, 774 F.2d at 1143, 227 USPQ at 551. The references themselves must provide some teaching whereby the applicant's combination would have been obvious.

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## B

Gorman argues that the references showing ice cream in a mold or wrapper on a stick and the references showing candy in a mold or wrapper on a stick are not analogous, for they require different conditions of production. However, the Copeman reference shows the

close relationship of these arts, stating that his elastomeric mold may be used for "frozen confections and other solid confections". We conclude that the ice cream on a stick and candy on a stick arts are analogous, and that the Siciliano, Copeman, Pooler, and Kuhlke references show or suggest Gorman's candy on a stick and covered with an elastomeric mold, for which the thumb-shape is shown by Harris or Craddock.

The suggestion of providing a layer of chewing gum, chocolate or the like, surrounding the candy core in the area not covered by the mold, to seal the candy and provide a second food product, is provided by Fulkerson, Webster, or Spiegel. The paper disc adjacent the base of the candy structure is shown in Ahern and Knaust. Harris and Craddock both show thumb-shaped candy. Gorman argues that the prior art does not suggest using the thumb-shaped cover as a toy after the candy is removed. However, Copeman states that his rubber mold may be used as a "toy balloon" after the candy is removed. Gorman argues that Craddock teaches away from the claimed invention because of Craddock's admonition that lollipops on sticks are dangerous to children. However, candy on a stick is too well known for this caution to contribute to unobviousness.

[2] Claim 16 recites details such as a "joint-shaped portion", a "finger nail portion", an "upper portion", a "lower portion" and a "convex back", as descriptive of the thumb shape. Such details are shown in the references and do not contribute to unobviousness. A claim that is narrowly and specifically drawn must nevertheless meet the requirements of §103:

The mere fact that a claim recites in detail all of the features of an invention (i.e., is a "picture claim") is never, in itself, justification for the allowance of such a claim.

Manual of Patent Examining Procedure, §706 (Rev. 6, Oct. 1987) at p. 700-6; *In re Romito*, 289 F.2d 518, 129 USPQ 359 (CCPA 1961) (rejecting a "picture claim").

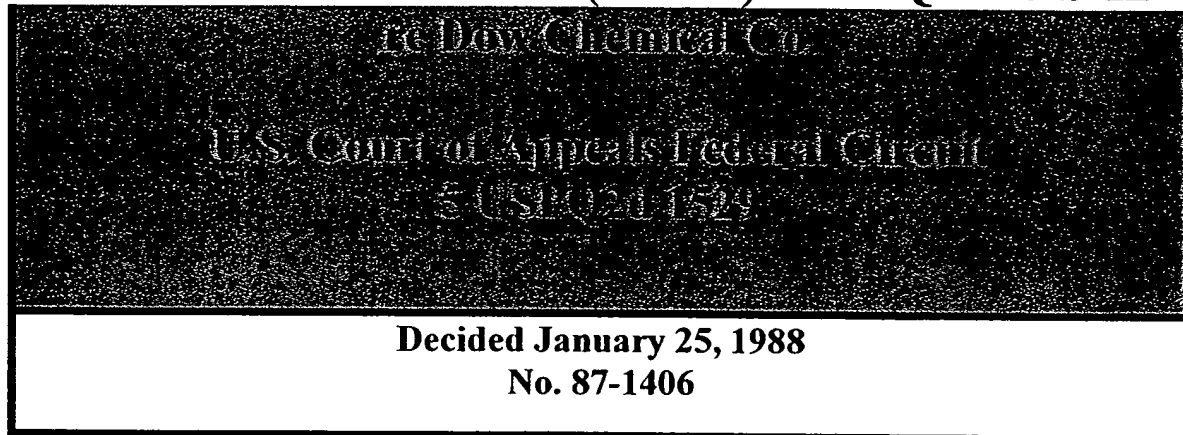
[3] Applying the principles of *Graham v. John Deere & Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), we discern all of the elements of claim 16, used in substantially the same manner, in devices in the same field of endeavor. The various elements Gorman combined: the molded lollipop with a chewing gum plug, with the mold serving as the product wrapper; and candy in the shape of a thumb; are all shown in the cited references in various sub-combinations, used in the same way, for the same purpose as in the claimed invention. The Board did not, as Gorman argues, pick and choose among isolated and inapplicable disclosures in the prior art. Rather, the claim elements appear in the prior art in the same configurations, serving the same functions, to achieve the results suggested in prior art. *In re Sernaker*, 702 F.2d at 994, 217 USPQ at 5. The large number of cited references does not negate the obviousness of the combination, for the prior art uses the various elements for the same purposes as they are used by appellants, making the claimed invention as a whole obvious in terms of 35 U.S.C. §103.

The Board's decision is *AFFIRMED*.

- End of Case -

**FULL TEXT OF CASES (USPQ2D)**  
All Other Cases

**In re Dow Chemical Co. (CA FC) 5 USPQ2d 1529 In**



**Headnotes**

**PATENTS**

**1. Patentability/validity -- Obviousness -- Evidence of (§ 115.0903)**

**Patentability/validity -- Obviousness -- Secondary considerations (§ 115.0907)**  
Board of Patent Appeals and Interferences erred in rejecting as obvious claims for invention of impact resistant rubber-based resin suitable for molding and extrusion containing preferred ingredients styrene, maleic anhydride, and synthetic diene rubbers, since none of prior art references cited by patent holder and PTO suggest that any process could be used successfully in such three-component system to produce resin having desired properties, and since board did not give fair evidentiary weight to expert's skepticism concerning invention, or to five to six years necessary to produce invention, in determining obviousness issue.

**Particular Patents -- Chemical -- Rubber Based Resins**  
3,919,354, Moore, Lehrer, Lyons and McKeever, impact resistant polymers of a resinous copolymer of an alkenyl aromatic monomer and unsaturated dicarboxylic anhydride, holding of obviousness reversed.

**Case History and Disposition:**

Page 1529

**Appeal from the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences.**

**Reexamination of Patent No. 3,919,354, held by The Dow Chemical Company. From decisions rejecting all claims of patent as obvious, patent holder appeals. Reversed.**

**Attorneys:**

**Douglas N. Deline, Midland, Mich. (Berndt W. Sandt with him on the brief) for appellant.**

**John H. Raubitschek, associate solicitor, Arlington, Va. (Joseph F. Nakamura, solicitor, and Fred E. McKelvey, deputy solicitor, with him on the brief) for appellee.**

**Judge:**

**Before Smith, Nies, and Newman, Circuit Judges.**

**Opinion Text****Opinion By:**

**Newman, Circuit Judge.**

Dow Chemical Company appeals the decisions of the United States Patent and Trademark Office Board of Patent Appeals and Interferences, No. 86-3426 (Feb. 25, 1987) and No. 662-81 (Mar. 25, 1986), together rejecting all the claims on reexamination of United States Patent No. 3,919,354 entitled "Impact Resistant Polymers of a Resinous Copolymer of an Alkenyl Aromatic Monomer and an Unsaturated Dicarboxylic Anhydride.". We reverse.

***The Rejection***

The invention is an impact resistant rubber-based resin having improved resistance to heat distortion. Claim 28, the broadest claim on appeal, is illustrative:

28. A polymer suitable for molding and extrusion, of substantially improved resistance to mechanical shock and impact, the polymer consisting essentially of the polymerization product of

a. a monovinyl alkenyl aromatic monomer containing up to 12 carbon atoms and having the alkenyl group attached directly to the benzene nucleus, the al

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kenyl aromatic compound being present in a proportion of from about 65 to 95 parts by weight and from 35 to 5 parts by weight of an unsaturated dicarboxylic acid anhydride readily copolymerizable therewith, and

b. from 5 to 35 parts by weight of a diene rubber per 100 parts of (a) plus (b), the rubber consisting essentially of 65 to 100 weight percent butadiene, or isoprene and up to 35 weight percent of an alkenyl aromatic hydrocarbon as the sole other monomer in the rubber, the rubber having a glass temperature not higher than 0° C., the rubber being in the form of a plurality of particles having diameters within the range of 0.02 to 30 microns dispersed throughout a matrix of polymer of alkenyl aromatic monomer and the anhydride, at least a major portion of the rubber particles containing distinct occlusions of the polymer of (a), with the further limitation that the polymer of (a) is a nonequimolar random copolymer.

The preferred ingredients are styrene, maleic anhydride, and synthetic diene rubbers, and our discussion will be in these terms, as was the Board's.

The Board's decision that the claimed invention would have been obvious in terms of 35 U.S.C. §103 was based on the combination of two references: a 1966 article by Molau and Keskkula entitled "Heterogeneous Polymer Systems IV. Mechanism of Rubber Particle Formation in Rubber-Modified Vinyl Polymers", and Baer U.S. Patent No. 2,971,939. Also discussed were Farmer U.S. Patent No. 2,275,951 and a publication by Bacon and Farmer entitled "The Interaction of Maleic Anhydride with Rubber", although the Board stated that the rejection was sustainable without relying on either of these references.

### ***The Prior Art***

The Molau/Keskkula article shows the preparation of a resin having high impact strength by dissolving synthetic diene rubber in styrene and polymerizing the styrene. This reference teaches that phase inversion is necessary to the formation of these moldable, extrudable resins. Baer prepares nonequimolar random maleic anhydride-styrene copolymers by a technique whose salient feature is adding the maleic anhydride slowly to polymerizing styrene under controlled conditions.

Farmer shows the reaction among natural rubber, styrene, and maleic anhydride, and also states that maleic anhydride reacts directly with the rubber. The Bacon and Farmer article also shows the reaction of maleic anhydride with natural rubber. These products, according to Dow's evidence and as found by the Board, do not have a dispersed rubber phase containing occlusions, and are not moldable.

Dow argues that the Board has engaged in hindsight reconstruction of the claimed invention. To support its position Dow refers to several scientific publications and other references, in addition to those cited by the PTO, and evidence submitted by declaration and deposition.

The first group of references to which Dow refers shows the reaction of maleic anhydride with natural or synthetic rubbers. These references show both intermolecular and intramolecular reactions between maleic anhydride and the various rubbers, but not a grafted rubber, which is said by Dow to characterize its product. Additional references are cited by Dow to show that maleic anhydride is much more reactive with diene-type synthetic rubbers than with natural rubber, and that the reaction with the synthetic rubbers is difficult to control and the product is unpredictable.

Another reference cited by Dow, the *Encyclopedia of Science and Technology*, states the general rule, derived from experience with acrylonitrile, that copolymers with synthetic diene rubbers have elevated glass transition temperatures; Dow advises that this is a highly undesirable property for a high-impact strength resin.

Another series of references cited by Dow shows several known techniques of reacting styrene and maleic anhydride to prepare nonequimolar copolymers, all different from the technique shown in the Baer patent.

### ***Analysis***

The Board held that the claimed product results from the application of the Baer technique to a styrene-maleic anhydride polymer system which includes synthetic diene rubber, and that it would have been obvious to do that which these inventors did if one wanted to increase the heat stability of a known high impact styrene rubber resin.

The crux of Dow's argument is that no reference shows or suggests that these references should or could be combined successfully. Indeed, the Board agreed, stating that "[i]t is not apparent from the evidence whether rubber and maleic anhydride would have been expected to react *in the process suggested by the combined disclosure of Molau and Baer . . .*" (Emphasis in original).

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Dow also points out, referring to the Keskkula evidence, that it was believed that these products could not be made by the mass polymerization techniques of the prior art. Dow asserts that no reference, including Baer, suggested that the Baer technique could produce the requisite phase inversion in a system containing diene rubber, and could produce a diene-rubber containing resin that could be molded and had the other desired high-impact and thermal properties.

Dow refers to the Farmer patent, cited by the examiner and the Board, which shows that the reaction of styrene, maleic anhydride, and natural rubber forms a product that is unsuitable as a molding resin. Dow argues that Farmer leads away from the Dow invention, in that Farmer obtains precisely the "runaway" reaction, and undesirable product, that Keskkula believed was characteristic of reactions involving styrene, maleic anhydride, and rubbers. Dow points to Dr. Keskkula's Report to Dow management, written in 1966 at about the time the present invention was made, pointing out the many problems in attempting to produce the three-component product that these inventors later succeeded in producing.

In response, the Commissioner argues that even though an expert polymer scientist, Dr. Keskkula, "personally may have been surprised by the invention at the time it was made, it does not necessarily follow that the invention would have been unobvious to one of ordinary skill in the art." The Commissioner suggests that one less encumbered by knowledge of the need for phase inversion, as described in the Molau/Keskkula article, might have achieved the Dow product by combining the references in the way suggested by the Commissioner. Reflecting on this theory of invention, we observe that such a person did not do so, despite the decades of experimentation with these components, and the recognition of need, as evidenced by the many references cited by both sides. *See In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.

Cir. 1984).

The Board held that Dow's statement in the patent specification that it was known that styrene/maleic anhydride copolymers had improved heat resistance as compared with styrene rubbers, made it *prima facie* obvious to combine these three components. Indeed, the record shows that such combinations had previously been made, in various ways, but without producing the product here desired. That there were other attempts, and various combinations and procedures tried in the past, does not render obvious the later successful one. The PTO's reliance on Dow's "admission" of longfelt need as *prima facie* evidence of obviousness is contrary to logic as well as law. Recognition of need, and difficulties encountered by those skilled in the field, are classical indicia of unobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966); *Custom Accessories v. Jeffrey-Allan Industries*, 807 F.2d 955, 960, 1 USPQ2d 1196, 1199 (Fed. Cir. 1986). Further, a patent applicant's statement of the purpose of the work is not prior art.

The Board thus concluded that although one would not know in advance whether the Baer technique would work at all in the presence of diene rubber, or produce a moldable high-impact product, if it did succeed it would have been obvious. The Board criticized Keskkula's evidence for not stating whether, after these inventors proposed the procedure here at issue, Keskkula would have expected the maleic anhydride to react preferentially with the diene rubber or with the styrene and to what effect on the impact properties of the product. The PTO argues that unless the prior art is shown to have led one of ordinary skill to expect the Baer technique to fail, the applicant's burden is not met. This is not the criterion. That these inventors eventually succeeded when they and others had failed does not mean that they or their colleagues must have expected each new idea to fail. Most technological advance is the fruit of methodical, persistent investigation, as is recognized in 35 U.S.C. §103 ("Patentability shall not be negated by the manner in which the invention was made").

The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. See *Burlington Industries v. Quigg*, 822 F.2d 1581, 1583, 3 USPQ2d 1436, 1438 (Fed. Cir. 1987); *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1987); *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 1013, 217 USPQ 193, 200 (Fed. Cir. 1983); *In re Rinehart*, 531 F.2d 1048, 1053-54, 189 USPQ 143, 148 (CCPA 1976). Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure.

In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill is charged

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with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention. The Commissioner argues that since the PTO is no longer relying on Farmer or the Bacon and Farmer article, the applicant is creating a "straw man". It is indeed pertinent that these references teach against the present invention. Evidence that supports, rather than negates, patentability must be fairly considered.



[1] The PTO presents, in essence, an "obvious to experiment" standard for obviousness. However, selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure. *Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). Of the many scientific publications cited by both Dow and the PTO, none suggests that any process could be used successfully in this three-component system, to produce this product having the desired properties. The skepticism of an expert, expressed before these inventors proved him wrong, is entitled to fair evidentiary weight, *see In re Piasecki*, 745 F.2d 1468, 1475, 223 USPQ 785, 790 (Fed. Cir. 1984); *In re Zeidler*, 682 F.2d 961, 966, 215 USPQ 490, 494 (CCPA 1982), as are the five to six years of research that preceded the claimed invention. The evidence as a whole does not support the PTO's conclusion that the claimed invention would have been obvious in terms of 35 U.S.C. §103.

**REVERSED**

**- End of Case -**

**APPENDIX X**

Serial No.: 09/955,064

Docket No.: 49933US032

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Examiner's Answer mailed from the U.S. Patent and Trademark Office on January  
14, 2003.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 11

Application Number: 09/955,604  
Filing Date: September 19, 2001  
Appellant(s): HOOPMAN ET AL.

MAILED  
JAN 14 2003  
GROUP 1700

Ann M. Mueting  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 23, 2002.

(1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The appellant's statement that there are no appeals or interferences known to appellant's representatives which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Note that this application is a continuation of U.S. Application No. 09/520,032 and that U.S. Application No. 09/520,032 is currently on appeal to the Board of Patent Appeals and Interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is substantially correct. However, one further issue is missing.

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The changes are as follows: addition of the following third issue to the two issues already listed.

3. Whether claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143 and 145-148 are properly provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 in view of Rochlis(-583).

**(7) Grouping of Claims**

The appellant's statement that claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143 and 145-148 stand or fall together is acknowledged.

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

3,312,583

ROCHLIS

4-1967

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 23, 30, 31, 89, 92, 134-136, 138-143 and 145-148 stand rejected under 35 U.S.C. 102(b) as being anticipated by Rochlis(-583). Rochlis(-583) teaches a production tool suitable

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for use in manufacturing an abrasive article (col. 1, lines 50-56) which includes a plurality of cavities having different geometric shapes, angles and dimensions. Note that some of the shapes have at least four planar surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween (see figures). The production tool can be a coating roll (fig. 19) or an etched (engraved) metal roll (col. 3, lines 52-63; col. 13, lines 15-17 and 62-67). The production tool can have parallel rows of cavities as shown in figs. 21 and 22 with a first plurality of rectangular cavities, a second plurality of circular cavities, and a third plurality of triangular cavities. At least one of the angles or base edge lengths of the first plurality is different from all the angles or base edge lengths of the second plurality and of the third plurality. At least one of the angles or base edge lengths of the second plurality is different from all the angles or base edge lengths of the first plurality and of the third plurality. Rochlis(-583) discloses that the cavities of the production tool can have different sizes (col. 2, lines 66-70; col. 6, lines 17-22; col. 9, line 61, to col. 10, line 52; col. 13, lines 62-66; i.e., different heights). Rochlis(-583) discloses that the cavities and products can have pyramidal or truncated pyramidal shapes (i.e., figs. 10-13; col. 13, lines 51-58). Rochlis(-583)

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discloses that the production tool can have a plurality of different shapes of cavities (col. 3, lines 25-29; col. 6, lines 17-22; col. 11, lines 56-66; col. 11, line 75, to col. 12, line 4; col. 13, lines 29-35 and 62-66; figs. 21 and 22). Figs. 21 and 22 show a first row of cavities with a rectangular cross section which defines a first base edge length extending parallel to the first row and a second base edge length extending perpendicular to the first row, wherein the second base length of all the cavities in the first row is the same (of course they also can be different sizes as mentioned above), and show a first rectangular cavity adjacent a second circular cavity, the second circular cavity being adjacent a third triangular cavity. Each of the cavities has a single opening. Furthermore, Rochlis(-583: col. 3, lines 40-46) discloses that "most embodiments" permit air or other evolved gas to escape, and Rochlis(-583: col. 13, lines 70-75) discloses that evolved air or gas "may" escape between mating surfaces of the laminated layers. Thus, in the embodiments (in opposition to "most embodiments") where there are no openings to permit air or other evolved gas to escape, each cavity has a single opening.

Claims 23, 24, 31, 32, 89, 90, 92, 93, 134-136, 138-143 and 145-148 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rochlis(-583). The 102 rejection above is

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based upon the interpretation of the alternatives for the production tool disclosed by Rochlis(-583) as being anticipatory. If appellants believe that the disclosed alternatives are NOT anticipatory, then it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the production tool of Rochlis(-583) with the alternatives disclosed by Rochlis(-583) because Rochlis(-583) explicitly discloses that the production tool can be modified with such disclosed alternatives. Rochlis(-583) discloses a production tool, as mentioned above, having 3 different types or shapes of cavities defining three pluralities or groups of cavities (figs. 21 and 22), but does NOT explicitly disclose a fourth plurality or group of cavities having a fourth different type of cavity. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the production tool to have four pluralities or group of cavities having four different types of cavity because Rochlis(-583) discloses that the production tool can have a plurality of different types (shapes and/or sizes) of cavities and/or because Rochlis(-583: figs. 21 and 22) discloses a production tool example having not just two but three pluralities or groups of cavities having three different types of cavities (i.e., that a tool can have a plural number of



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groups of cavities having different types of cavities to produce a plural number of groups of products having different types of products). Note that different shapes will read on the respective instant claims. For example, if the three different types had cross sections of a square, a pentagon, and a hexagon, then each of the cavities would have a boundary defined by at least four surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein the at least one angle of intersection of the first cavity is different from all the angles of the second and third cavities, and wherein at least one angle of intersection of the second cavity is different from all the angles of intersection of the first and third cavities. Various different types would also provide different base edge lengths.

Claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143 and 145-148 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 in view of Rochlis(-583). Claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 disclose the production tool substantially as instantly claimed. Rochlis(-583) discloses a production tool as mentioned above. It would have

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been obvious to one of ordinary skill in the art, at the time of the invention, to modify the production tool of claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 such that the cavities have a first, second, third, or more plurality of cavities, each plurality having a different shape because such a modification would produce a product having a first, second, third, or more plurality of different shapes on the product as disclosed by Rochlis(-583). Note that the possible different shapes and combinations thereof disclosed by Rochlis(-583) would provide the dimensions, planar surfaces, angles, edges, boundaries and shapes as recited by the instant claims. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**(11) Response to Argument**

Appellants argue that claims 23, 30, 31, 89, 92, 134-136, 138-143 and 145-148 are not anticipated under 35 U.S.C. 102(b) by Rochlis(-583).

Appellants argue that Rochlis(-583) does not disclose every element of the claimed invention, particularly each of the cavities having a single opening, and that Rochlis(-583: col. 3, lines 40-49) requires the mold to have a laminate construction with multiple openings (i.e., openings between the laminate

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layers in addition to the openings through which mold material enters the cavity), the openings between the laminate layers allowing air or gas from the mold material to escape. The examiner agrees that there are multiple openings: openings between the laminate layers which define vent openings in addition to openings receiving the molding material which define mold cavity openings. Clearly, the vent openings do not perform any shaping function and thus are NOT part of the cavity. Each cavity has a single opening which defines the cavity.

Appellants further traverse the assertion (by the examiner) that the vent openings are not part of the mold cavities. It appears that appellant's arguments are not corresponding to what is actually claimed. Each of the cavities having a single opening does NOT negate the mold from having other non-cavity openings. Again, as mentioned above, the vent openings do not perform any shaping function and thus are NOT part of the molding cavity. Furthermore, if the vent openings were a part of the mold cavity, then wouldn't the mold material flow into the vent openings to also escape from the mold. Clearly, appellants interpretation of Rochlis(-583) that the mold cavities include the vent openings is incorrect. The vent openings are NOT a part of the cavity.

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Appellants further traverse the examiner alleging that Appellants (instant claims language) do not preclude multiple openings in the instant claims. Appellants argue that single is defined as "one only; only one in number". Note that the instant claim language requires each of the cavities to have a single cavity, and thus each cavity has one opening only, only one opening in number. Rochlis(-583) discloses that each cavity has a single cavity opening; whereas the mold or production tool has vent openings in addition to the cavity openings. Thus, each of the cavities having a single opening does not preclude the mold or production tool from having other openings.

Appellants argue that there is no disclosure in Rochlis(-583) of mold constructions without openings between the laminate layers. The examiner disagrees. Rochlis(-583: col. 3, lines 40-46) discloses that "most embodiments" permit air or other evolved gas to escape, and Rochlis(-583: col. 13, lines 70-75) discloses that evolved air or gas "may" escape between mating surfaces of the laminated layers. Thus, in the embodiments (in opposition to "most embodiments") where there are no openings to permit air or other evolved gas to escape, each cavity has a single opening.

Appellants argue that Rochlis(-583) does not contain an enabling disclosure. Appellants argue that Rochlis(-583) does

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not teach how one of skill in the art would make a production tool with even one mold cavity having a single opening. It appears that appellants are arguing that Rochlis(-583) does not have an enabling disclosure for making a mold or production tool without the vent openings. The examiner agrees that Rochlis(-583) is enabling for a laminated mold construction that includes openings between the mating surfaces of the laminations.

However, as mentioned above, in other embodiments of Rochlis(-583), the laminated mold has no openings for gas or air to escape. Thus, Rochlis(-583) is enabling for making a laminated mold or production tool without the vent openings which would define each mold cavity with a single opening.

Appellants argue that claims 23, 24, 31, 32, 89, 90, 92, 93, 134-136, 138-143 and 145-148 are not obvious under 35 U.S.C. 103(a) over Rochlis(-583).

Appellants argue that Rochlis(-583) does not teach or suggest how one of ordinary skill in the art would make a production tool with each cavity having a single opening or with a single opening in each cavity. The examiner disagrees as this is discussed at length above. Appellants argue that the Office Action fails to establish a prima facie case of obviousness. However, modifying the production tool of Rochlis(-583) with the alternatives disclosed by Rochlis(-583) has clear motivation

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since Rochlis(-583) explicitly discloses that the production tool can be modified with such disclosed alternatives.

Appellants argue that Rochlis(-583) teaches away from the claimed invention in view of the fact that Rochlis(-583) emphasizes the importance of the openings between the mating surfaces of the laminations to allow evolved air or gas to escape. Appellants argue that one of skill would expect that a mold with only a single opening in each cavity would not be functional since the openings between the mating surfaces of the laminations allow evolved air or gas to escape. The examiner disagrees. Rochlis(-583) does NOT disclose that allowing evolved air or gas to escape is CRITICAL or REQUIRED for the apparatus to operate. Furthermore, Rochlis(-583) explicitly discloses that in some embodiments there are no openings in the laminated mold or laminated production tool allowing evolved air or gas to escape, as mentioned above.

Appellants argue that it is impermissible to use hindsight as an obviousness test. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's

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disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Appellants argue that the use of Rochlis(-583) alone in an obviousness rejection can only occur by the impermissible use of hindsight reasoning. The examiner disagrees that a single reference rejection can only occur by hindsight reasoning, and appellants have not given any factual evidence to support such a conclusory statement. Note that the obviousness rejection by the examiner took into account only the knowledge disclosed by Rochlis(-583) and knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from appellant's disclosure.

Appellants do NOT argue the standing provisional rejection of claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143 and 145-148 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 in view of Rochlis(-583). In the Summary of the Appeal Brief, appellants state that, if patentability of the instant claims is confirmed, appellants will file a Terminal Disclaimer if such rejection is maintained.

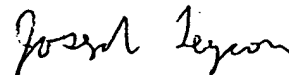
Note that Appendices II-X have been considered by the examiner. Appendices II-VII only contains copies of papers

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already entered and considered in the application. Appendix VIII is a copy of the prior art, Rochlis(-583). Appendix IX is a dictionary citation for the definition of "single" which is the same definition used and understood by the examiner, as gleaned from the instant disclosure, throughout the prosecution of this application. Appendix X includes copies of case law cited by appellants.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Joseph Leyson

Patent Examiner

*N*

jl

January 10, 2003

Conferees

Wanda Walker

Douglas McGinty

APPEAL CONFERENCE

  
~~DOUGLAS MCGINTY~~

QUALITY ASSURANCE SPECIALIST  
TECHNOLOGY CENTER 1700

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**APPENDIX XI**

Serial No.: 09/955,064

Docket No.: 49933US032

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Reply Brief Under 37 C.F.R. §1.193(b)(1) filed with the U.S. Patent and  
Trademark Office on March 12, 2003 via facsimile transmission.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	HOOPMAN et al.	)	Group Art Unit: 1722
		)	
Serial No.:	09/955,604	)	Examiner: J. Leyson
Confirmation No.:	1214	)	
		)	
Filed:	19 September 2001	)	
		)	
For:	TOOLS TO MANUFACTURE ABRASIVE ARTICLES		

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**REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)(1)**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

Appellants present this Reply Brief in response to the Examiner's Answer dated 14 January 2003 and in support of the appeal from the final rejections of claims 23, 24, 30-32, 89, 90, 92, 93, and 133-148 of the above-identified application under 35 U.S.C. § 102 (claims 23, 30, 31, 89, 92, and 133-148) and 35 U.S.C. § 103 (claims 23, 24, 31, 32, 89, 90, 92, 93, and 133-148), as set forth in the Final Office Action mailed July 22, 2002 and maintained in the Advisory Action mailed October 4, 2002. Appellants incorporate by reference their Appeal Brief dated 23 December 2003.

**Response to Examiner's Arguments**

**II. RELATED APPEALS AND INTERFERENCES**

Although the Examiner stated that the parent (Serial No. 09/520,032) of the present application is currently on appeal to the Board of Patent Appeals and Interferences, Appellants note that in the parent application a Notice of Appeal and an Appeal Brief have been filed, an Examiner's Answer has been received, and a Reply Brief is being filed on even date herewith.

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## **VI. ISSUE(S) PRESENTED FOR REVIEW**

As noted in the Appeal Brief, Appellants appeal the following two issues:

1. Whether claims 23, 30, 31, 89, 92, 134-136, 138-143, and 145-148 are anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 3,312,583 (Rochlis '583, Appendix VIII).
2. Whether claims 23, 24, 31, 32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 are obvious under 35 U.S.C. § 103(a) over U.S. Patent No. 3,312,583 (Rochlis '583).

Appellants do not wish to appeal the provisional obviousness-type double patenting rejection of the claims over the parent (Serial No. 09/520,032) of the present application in view of Rochlis '583. In fact, in the Appeal Brief Appellants acknowledged the pending provisional obviousness-type double patent rejection over copending Application No. 09/520,032 and stated that, after patentability of the instant invention is confirmed, a Terminal Disclaimer will be filed if such a rejection is maintained. This is not an admission that a Terminal Disclaimer is necessary; rather, Appellants will make such a submission merely to expedite prosecution.

## **VIII. ARGUMENT**

Appellants continue to traverse each of the rejections and disagree with the Examiner's position and assertions.

### **A. Claims 23, 30, 31, 89, 92, 134-136, 138-143, and 145-148 are not anticipated under 35 U.S.C. § 102(b) by Rochlis '583.**

Appellants traverse the Examiner's continued rejection of these claims under 35 U.S.C. § 102(b) over Rochlis '583. Specifically, Appellants would like to make the following additional points and address certain Examiner's statements.

Each of Appellants' independent claims recites a production tool for manufacturing an abrasive article, wherein the production tool has a plurality of cavities, each of which has a single

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opening. Appellants' claims recite that each cavity has a single opening. According to the Random House College Dictionary, "single" is defined as "one only; only one in number" (copy previously sent with Appeal Brief).

In contrast, the mold disclosed in Rochlis '583 requires a laminate construction with multiple openings (i.e., openings between the layers in addition to the opening through which mold material enters the cavity) (col. 3, lines 40-49). Specifically, these openings between the mating surfaces of the laminations allow that "air or gas evolved in the molding or hardening procedure may escape" (col. 13, lines 70-73). There is no disclosure in Rochlis '583, however, that any cavity, let alone each of the cavities, has only a single opening. That is, there is no disclosure that Rochlis '583 has laminated mold constructions without openings between the mating surfaces of the laminations. Furthermore, there is no disclosure that Rochlis '583 has mold constructions with a single opening.

In response to the Examiner's statement at page 12 of the Examiner's Answer that Rochlis '583 does not disclose that allowing air or gas to escape is critical or required for the operation of the apparatus, Appellants disagree. At column 14, lines 19-26, Rochlis '583 states that allowing air and gas to escape is an "important aspect" of the invention and that no gas can accumulate in "any embodiment":

An important aspect of the present invention, in regard to method and apparatus, resides in the fact that the assembly of a lamination of notched mold plates permits air or other gas to escape during the molding and setting operation. Thus, there is no possibility of such gas accumulation tending to mar the individual outlines of the pile elements or components, in any embodiment of the product (emphasis added).

Furthermore, Appellants respectfully submit that it is inappropriate for the Examiner to allege that a positive teaching of embodiments with a single opening results from the use of the phrase "most embodiments" in the context of permitting air or gas to escape (column 3, lines 40-46 of Rochlis) and the term "may" in the context of air or gas escaping (column 13, lines 70-75).

---

That is, it is inappropriate for the Examiner to take these statements out of context and necessarily interpret them to mean that "in the embodiments (in opposition to 'most embodiments') where there are no openings to permit air or other evolved gas to escape, each cavity has a single opening" (page 10 of Examiner's Answer).

It is respectfully submitted that the entire document must be read for a positive teaching of the "embodiments in opposition to most embodiments." There is no such teaching. Rochlis '583 does not disclose any embodiments of mold constructions that would not be laminated and that would not have openings between the mating surfaces of the laminations. Thus, the Examiner's assertion at page 11 of the Examiner's Answer that Rochlis '583 "is enabling for making a laminated mold or production tool without vent openings which would define each mold cavity with a single opening" must be withdrawn.

Appellants also traverse the assertion that the vent openings are not part of the mold cavities simply because they do "not perform any shaping function" (page 9 of the Examiner's Answer). Rochlis '583 clearly states that the vent openings are provided to prevent entrapment of gas "in the mold cavity in a manner to possibly alter the shape or size of the pile elements" (column 3, lines 47-48). In other words, the vent openings allow gas to escape from the cavities to allow them to fill properly. As a result, any assertion that the vent openings are not located in the cavities is simply not supported by Rochlis '583 and must be withdrawn.

**B. Claims 23, 24, 31, 32, 89, 90, 92, 93, 134-136, 138-143, and 145-148 are not obvious under 35 U.S.C. § 103 over Rochlis '583.**

Appellants traverse the Examiner's continued rejection of these claims under 35 U.S.C. § 103 over Rochlis '583. Specifically, Appellants would like to make the following additional points and address certain of the Examiner's statements.

Rochlis '583 does not explicitly teach or suggest a production tool with any cavity having only a single opening, let alone each of a plurality of cavities having only a single opening.

---

The Examiner stated at pages 11-12 of the Examiner's Answer that "modifying the production tool of Rochlis (-583) with the alternatives disclosed by Rochlis (-583) has clear motivation since Rochlis (-583) explicitly discloses that the production tool can be modified with such disclosed alternatives." Although it is not entirely clear from the Examiner's Answer, it is believed that these "alternatives" are those that are discussed above – "in the embodiments (in opposition to 'most embodiments') where there are no openings to permit air or other evolved gas to escape, each cavity has a single opening." Again, even in an obviousness rejection, it is inappropriate for the Examiner to make such a definitive inference from the use of the words "most" and "may" instead of depending on the specific disclosure of a description of what those "other" embodiments would be. There is no such disclosure in Rochlis '583. Thus, one of skill in the art would not be motivated to make a mold or production tool for manufacturing an abrasive article with a single opening as a result of the teachings of Rochlis '583 based on the "disclosed alternatives". This rejection must be withdrawn.

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Serial No.: 09/955,604

Confirmation No.: 1214

Filed: 19 September 2001

For: TOOLS TO MANUFACTURE ABRASIVE ARTICLES

---

**C. Summary**

For the reasons provided herein and in the Appeal Brief dated 23 December 2003, Appellants respectfully submit that pending claims are patentable in view of the cited references. Review and reversal of the rejections are respectfully requested.

Respectfully submitted,

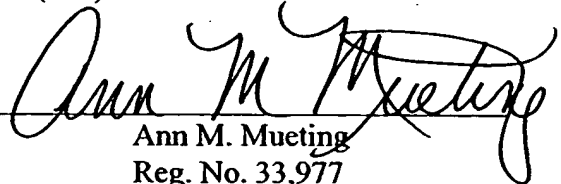
HOOPMAN et al.,

By their attorneys,

Mueiting, Raasch & Gebhardt, P.A.  
P.O. Box 581415  
Minneapolis, MN 55458-1415  
(612)305-1220

March 12, 2003  
Date

By:



Ann M. Mueiting

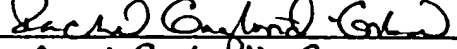
Reg. No. 33,977

Direct Dial: (612) 305-1217

---

**CERTIFICATE UNDER 37 CFR §1.8:**

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on this 12<sup>th</sup> day of March, 2003, at 2:01 p.m. (Central Time).

By:   
Name: Rachel Gaylord-Gebhardt

---

**APPENDIX XII**

Serial No.: 09/955,064

Docket No.: 49933US032

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Request for Continued Examination (RCE) Transmittal and Information

Disclosure Statement filed with the U.S. Patent and Trademark Office on June 26, 2003.



**Request for Continued Examination (RCE) Transmittal**

Mail Stop RCE  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450



First Named Inventor: Hoopman, Timothy L.  
 Application No.: 09/955604 Group Art Unit: 1722  
 Filed: September 19, 2001 Examiner: Joseph Leyson  
 Title: TOOLS TO MANUFACTURE ABRASIVE ARTICLES  
**This is a Request for Continued Examination (RCE) under 37 CFR § 1.114 of the above-identified application.**

**1. Submission required under 37 CFR § 1.114**

- a. ☐ Previously submitted
- i. ☐ Consider the amendment(s)/reply under 37 CFR § 1.116 previously filed on  
 (Any unentered amendment(s) referred to above will be entered)
- ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on
- iii. ☐ Other
- b. ☒ Enclosed
- i. ☐ Amendment/Reply
- ii. ☐ Affidavit(s)/Declaration(s)
- iii. ☒ Information Disclosure Statement (IDS)/Supplemental IDS
- iv. ☐ Other

**2. ☐ A Request for Extension of Time is being filed concurrently****3. Fees** (The RCE fee under 37 CFR § 1.17(e) is required by 37 CFR § 1.114 when the RCE is filed.)

- a. ☒ The Director is hereby authorized to charge the following fees or credit any overpayments to:  
 Deposit Account No. 13-3723. A duplicate copy of this letter for fees processing is enclosed.
- i. ☒ RCE fee required under 37 CFR § 1.17(e)
- ii. ☐ Other

Respectfully submitted,

Date

*June 26, 2003*

By:

*[Signature]*  
 Gregory D. Allen, Reg. No.: 35,048  
 Telephone No.: (651) 736-0641

Office of Intellectual Property Counsel  
 3M Innovative Properties Company  
 Facsimile No.: (651) 736-3833

**Certificate of Mailing or Transmission**

I certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office on the date indicated below:

Sent to Facsimile No.:

Signature:

Date: *June 27, 2003*

*[Signature]*  
 Printed Name: Lisa Hengen

☒ Customer Number for  
 Correspondence Address:

**32692**

PATENT TRADEMARK OFFICE



32692

PATENT TRADEMARK OFFICE

Patent  
Case No.: 49933US032

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: HOOPMAN, TIMOTHY L.  
Application No.: 09/955604      Group Art Unit: 1722  
Filed: September 19, 2001      Examiner: Joseph Leyson  
Title: TOOLS TO MANUFACTURE ABRASIVE ARTICLES

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

June 27, 2003

Date

Lisa Hengen

Signed by: Lisa Hengen

Dear Sir:

Pursuant to 37 CFR §§ 1.56, 1.97, and 1.98, enclosed is a completed Form PTO-1449, citing references submitted for consideration by the Examiner. A copy of each cited reference is also enclosed. It is respectfully requested that the Examiner initial and return the enclosed Form PTO-1449 to indicate that each reference has been considered.

It is believed that no fee is due; however, in the event a fee is required, please charge the fee to Deposit Account No. 13-3723.

Respectfully submitted,

Date

June 26, 2003

By:

Gregory D. Allen

Gregory D. Allen, Reg. No.: 35,048

Telephone No.: (651) 736-0641

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833

# INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Use as many sheets as necessary)

Page 1 of 1

Filing Date	September 19, 2001
First Named Inventor	Hoopman, Timothy L.
Art Unit	1722
Examiner Name	Joseph Leyson
Attorney Case Number	49933US032

## U.S. Patent Documents

Exam. Init.*	Cite No.	Document Number	Publication Date or Issue Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Doc. Number-(Kind Code if Known)			
	A1	US-			
	A2	US-			
	A3	US-			
	A4	US-			
	A5	US-			
	A6	US-			
	A7	US-			

## Foreign Patent Documents

Exam. Init.*	Cite No.	Foreign Patent Document		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	Translation (Check if yes)
		Ctry. Code	Number-KindCode (If known)				
	B1	JP	57-59054	09/24/1980			X
	B2	JP	7-164330	06/27/1995			*
	B3	JP	3-73276	03/28/1991			**
	B4						

## OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS

Exam. Init.*	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published
	C1	

\* JP 7-164330 claims priority to USSN 120,297 which is the same application from which U.S. Patent 5,489,235 issued. U.S. Patent No. 5,489,235 was cited in a previous Information Disclosure Statement dated June 7, 2000.

\*\* JP 3-73276 claims priority to USSN 347,663 which is the same application from which U.S. Patent 5,014,468 issued. U.S. Patent No. 5,014,468 was cited in a previous Information Disclosure Statement dated June 7, 2000.

\*Examiner:

Date Considered:

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Information Disclosure Statement()

**APPENDIX XIII**

Serial No.: 09/955,064

Docket No.: 49933US032

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Order Dismissing Appeal mailed from the U.S. Patent and Trademark Office on  
July 23, 2003.

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

**MAILED**

**JUL 23 2003**

**PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

---

**Ex parte TIMOTHY L. HOOPMAN and NELSON D. SEWALL**

---

**Appeal No. 2003-1026  
Application 09/955,604**

---

**ORDER DISMISSING APPEAL**

---

Before STONER, Chief Administrative Patent Judge, HARKCOM, Vice Chief Administrative Patent Judge, and WILLIAM F. SMITH, Administrative Patent Judge.

Per curiam.

On June 30, 2003, counsel for the appellants filed, among other documents, a Request for Continued Examination (RCE) under 37 CFR § 1.114. Pursuant to the notice entitled "Request for Continued Examination Practice and Changes to Provisional Application Practice," 65 Fed. Reg. 50092, 50095 (Aug. 16, 2000), and the provisions of 37 CFR § 1.114(d), a request for continued examination under 37 CFR § 1.114 filed after appeal has been taken, but prior to a decision on the appeal, "will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner."

Appeal No. 2003-1026  
Application 09/955,604

3M INNOVATIVE PROPERTIES COMPANY  
P.O. BOX 33427  
ST. PAUL , MN 55133-3427

**APPENDIX XIV**

Serial No.: 09/955,064

Docket No.: 49933US032

---

Office Action mailed from the U.S. Patent and Trademark Office on August 26, 2003.



**UNITED STATES PATENT AND TRADEMARK OFFICE**

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22315-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,604	09/19/2001	Timothy L. Hoopman	49933US032	1214

32692 7390 08/26/2003

3M INNOVATIVE PROPERTIES COMPANY  
PO BOX 33427  
ST. PAUL, MN 55133-3427

EXAMINER

LEYSON, JOSEPH S

ART UNIT

PAPER NUMBER

1722

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



# Office Action Summary

Application No.

09/955,604

Applicant(s)

HOOPMAN ET AL.

Examiner

Joseph Leyson

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143 and 145-148 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143 and 145-148 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 30 June 2003 has been entered.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 23, 30, 31, 89, 92, 134-136, 138-143 and 145-148 are rejected under 35 U.S.C. 102(b) as being anticipated by Rochlis(-583).

Rochlis(-583) teaches a production tool suitable for use in manufacturing an abrasive article (col. 1, lines 50-56) which includes a plurality of cavities having different geometric shapes, angles and dimensions. The production tool can be a coating roll (fig. 19) or an etched (engraved) metal roll (col.

3, lines 52-63; col. 13, lines 15-17 and 62-67). The production tool can have parallel rows of cavities as shown in figs. 21 and 22 with a first plurality of rectangular cavities, a second plurality of circular cavities, and a third plurality of triangular cavities. At least one of the angles or base edge lengths of the first plurality is different from all the angles or base edge lengths of the second plurality and of the third plurality. At least one of the angles or base edge lengths of the second plurality is different from all the angles or base edge lengths of the first plurality and of the third plurality. Rochlis(-583) discloses that the cavities of the production tool can have different sizes (col. 2, lines 66-70; col. 6, lines 17-22; col. 9, line 61, to col. 10, line 52; i.e., different heights). Rochlis(-583) discloses that the cavities and products can have pyramidal or truncated pyramidal shapes (i.e., figs. 10-13; col. 13, lines 51-58). Rochlis(-583) discloses that the production tool can have a plurality of different types (shapes) of cavities (col. 13, lines 29-35). Figs. 21 and 22 show a first row of cavities with a rectangular cross section which defines a first base edge length extending parallel to the first row and a second base edge length extending perpendicular to the first row, wherein the second base length of all the cavities in the first row is the same (of course they also can

Art Unit: 1722

be different sizes as mentioned above), and show a first rectangular cavity adjacent a second circular cavity, the second circular cavity being adjacent a third triangular cavity. Each of the cavities has a single opening.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1722

5. Claims 23, 24, 31, 32, 89, 90, 92, 93, 134-136, 138-143 and 145-148 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rochlis(-583).

The 102 rejection above is based upon the interpretation of the alternatives for the production tool disclosed by Rochlis(-583) as being anticipatory. If applicants believe that the disclosed alternatives are NOT anticipatory, then it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the production tool of Rochlis(-583) with the alternatives disclosed by Rochlis(-583) because Rochlis(-583) explicitly discloses that the production tool can be modified with such disclosed alternatives.

Rochlis(-583) discloses a production tool, as mentioned above, having 3 different types or shapes of cavities defining three pluralities or groups of cavities (figs. 21 and 22), but does NOT explicitly disclose a fourth plurality or group of cavities having a fourth different type of cavity. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the production tool to have four pluralities or group of cavities having four different types of cavity because Rochlis(-583) discloses that the production tool can have a plurality of different types of cavities and/or because Rochlis(-583: figs. 21 and 22) discloses

a production tool example having not just two but three pluralities or groups of cavities having three different types of cavities. Note that different shapes will read on the respective instant claims. For example, if the three different types had cross sections of a square, a pentagon, and a hexagon, then each of the cavities would have a boundary defined by at least four surfaces wherein adjacent planar surfaces of one cavity meet at an edge to define an angle of intersection therebetween, wherein the at least one angle of intersection of the first cavity is different from all the angles of the second and third cavities, and wherein at least one angle of intersection of the second cavity is different from all the angles of intersection of the first and third cavities. Various different types would also provide different base edge lengths.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 1722

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 23, 24, 30-32, 89, 90, 92, 93, 134-136, 138-143 and 145-148 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 in view of Rochlis(-583). Claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 disclose the production tool substantially as instantly claimed. Rochlis(-583) discloses a production tool as mentioned above. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify the production tool of claims 17, 20, 21, 25-28, 33-54, 94-96 and 98-111 of copending Application No. 09/520,032 such that the cavities have a first, second, third, or more plurality of cavities, each plurality having a different shape because such a modification would produce a product having a first, second, third, or more plurality of different shapes on the product as disclosed by Rochlis(-583). Note that the possible different shapes and combinations thereof disclosed by Rochlis(-583) would provide the dimensions, planar surfaces, angles, edges, boundaries and shapes as recited by the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Leyson whose telephone number is (703) 308-2647. The examiner can normally be reached on M-F(8:30-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (703) 308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*JL*

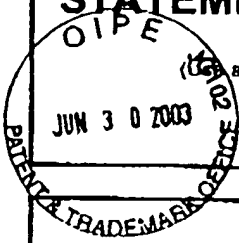
JL  
20 August 2003

*James P. Mackey*  
JAMES P. MACKEY  
PRIMARY EXAMINER

*8/22/03*



# INFORMATION DISCLOSURE STATEMENT BY APPLICANT



(Use as many sheets as necessary)

Page 1 of 1

Filing Date	September 19, 2001
First Named Inventor	Hoopman, Timothy L.
Art Unit	1722
Examiner Name	Joseph Leyson
Attorney Case Number	49933US032

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## U.S. Patent Documents

Exam. Init.*	Cite No.	Document Number	Publication Date or Issue Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Doc. Number-(Kind Code if Known)			
	A1	US-			
	A2	US-			
	A3	US-			
	A4	US-			
	A5	US-			
	A6	US-			
	A7	US-			

## Foreign Patent Documents

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		Ctry. Code	Number-KindCode (if known)				
JP	B1	JP	57-59054	09/24/1980			X
JP	B2	JP	7-164330	06/27/1995			.
JP	B3	JP	3-73276	03/28/1991			**
	B4						

Class	Sub Class
-	-
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## OTHER PRIOR ART -- NON PATENT LITERATURE DOCUMENTS

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	C1	

\* JP 7-164330 claims priority to USSN 120,297 which is the same application from which U.S. Patent 5,489,235 issued. U.S. Patent No. 5,489,235 was cited in a previous Information Disclosure Statement dated June 7, 2000.

\*\* JP 3-73276 claims priority to USSN 347,663 which is the same application from which U.S. Patent 5,014,468 issued. U.S. Patent No. 5,014,468 was cited in a previous Information Disclosure Statement dated June 7, 2000.

*Examiner: <i>Joseph Leyson</i>	Date Considered: <i>8-20-03</i>
EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

Information Disclosure Statement)

**APPENDIX XVI**

Serial No.: 09/955,604

Docket No.: 49933US032

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1. Urdang et al., The Random House College Dictionary, New York, NY; Title page, Publication page, Table of Contents, and pg. 1228 (1973).



# College Dictionary

**Laurence Urdang**

Editor in Chief

**Stuart Berg Flexner**

Managing Editor

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Based on

**The Random House  
Dictionary of the  
English Language**

The Unabridged Edition

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# Preface

**I**N THE DECADES recently past, especially since World War II, the educational standards of the world have been extended to embrace more people than ever before. Literacy has increased enormously. Coupled with the technological advances of the period, the necessity for reading and study has resulted in an unprecedented interest in words.

The dictionary has traditionally been the only source of information on language for the majority of people. In it they expect to find how a word is spelled, how it may be hyphenated, how it is pronounced, what its various forms are, what its meanings are, and what its origins and history are. They also expect to find whether a word is technical or general, whether it can be used in polite company or not, and even whether someone who is called a certain word is justified in feeling offended. They want unfamiliar objects illustrated and particular places pinpointed on maps; they want biographical information, geographical, demographical, and political data, abbreviations, symbols, synonyms, antonyms, usage notes—in short, people expect to find condensed between the covers of a dictionary the knowledge of the world as reflected in their language. Above all, they demand that this knowledge be accurate and up to date. Indeed, why not? The dictionary is often the only reference book of any kind that many people ever own.

That these prodigious demands are met is, of course, no accident. A dictionary is the product of specialists, linguists, and highly trained editors who are devoted to researching language and information and to interpreting it and presenting it in understandable form.

The *Random House College Dictionary* is an abridgment of *The Random House Dictionary of the English Language—The Unabridged Edition*, and its style follows that of the *RHD*. No dictionary, no matter how extensive, could record the entire English language. It is obvious, then, that the editors of any dictionary are compelled to exercise discretion in what is to be included. The goal cannot be completeness: the goal must be judicious selectivity. There is no dearth of re-

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Based on *The Random House Dictionary of the English Language—The Unabridged Edition*  
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PUBLISHED IN THE UNITED STATES OF AMERICA BY RANDOM HOUSE, INC., NEW YORK  
RANDOM HOUSE OF CANADA LIMITED, TORONTO

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# **Collegiate Dictionary**

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1. pertaining to Ceylon, its native people, or their language.  
 —n. 2. a member of the Sinhalese people. 3. an Indic language that is the language of most of Ceylon, including Colombo. Also, Sinhalese. [var. of *Sinhalese* < Skt *Sinhala* (a Ceylon) + *-ness*]  
**single** (sɪŋɡəl), *adj.* v., *gled*, *-gling*, *n.* —*adj.* 1. one only; only one in number; sole: a single example. 2. of, pertaining to, or suitable for one person only: a single bed. 3. unique; solitary: He was the single survivor. 4. unmarried. 5. pertaining to the unmarried state. 6. of one against one, as combat or fight. 7. consisting of only one part, element, or member: a single lens. 8. sincere; honest; undivided: single devotion. 9. separate; individual. 10. uniform; applicable to all. 11. (of a flower) having only one set of petals. 12. Brit. of only moderate strength or body, as ale or beer. 13. (of the eye) seeing rightly. —*v.* 14. to pick or choose out from others (usually fol. by *out*): to single out a fact for special mention. 15. Baseball. a. to cause the advance of (a base runner) by a one-base hit. b. to cause (a run) to be scored by a one-base hit (often fol. by *in*). —*n.* 16. Baseball. to make a one-base hit. 17. Obs. (of a horse) to go at single-foot. —*n.* 18. one person or thing; a single one. 19. an accommodation for one person, as a hotel room, cabin on a ship, etc. 20. Also called one-base hit. Baseball. a base hit that enables a batter to reach first base safely. 21. singles, (constructed as sing.) a match with one player on each side. 22. Golf. twosome (def. 4). 23. Cricket. a hit for which one run is scored. 24. Informal. a one-dollar bill: a five and five singles. [late ME; ME *single* < MF < L *single* (us); see *SINGLE*] —*Syn.* 1. distinct, particular. 4. unwe. 14. select. 18. individual.  
**single-act-ing** (sɪŋɡəl ək'tɪŋ), *adj.* (of a reciprocating engine, pump, etc.) having pistons accomplishing work only in one direction. Cf. *double-acting* (def. 1).  
**single-ac-tion** (sɪŋɡəl ək'shən), *adj.* (of a firearm) requiring the cocking of the hammer before firing each shot: a single-action revolver.  
**single bond**, *Chem.* a chemical linkage consisting of one covalent bond between two atoms of a molecule, represented in chemical formulas by one line or two vertical dots, as C-H or C-H.  
**single-breast-ed** (sɪŋɡəl bres'tɪd), *adj.* (of a garment, esp. a coat or jacket) having a single button or row of buttons in front for the center closing. Cf. *double-breasted*.  
**single-cross** (sɪŋɡəl kros'), *n.* Genetics. a cross between two inbred lines.  
**single cut**, *Jewelry.* a simple form of brilliant cut, having eight facets above and eight facets below the girdle. Also called half-brilliant cut.  
**single-cut** (sɪŋɡəl kʊt'), *adj.* noting a file having a series of parallel cutting ridges in one direction only.  
**single en-try**, *Bookkeeping.* a simple accounting system noting only amounts owed by and due to a business. Cf. *double entry*. —*single-en-try*, *adj.*  
**single file**, a line of persons or things arranged one behind the other; Indian file.  
**single-foot** (sɪŋɡəl fʊt'), *n.* 1. rack<sup>2</sup>. —*v.* 2. (of a horse) to go at a rack.  
**single-hand-ed** (sɪŋɡəl hændɪd), *adj.* 1. accomplished or done by one person alone; unaided. 2. having, using, or requiring the use of only one hand or one person. —*adv.* 3. by oneself; alone; without aid. —*single-hand-ed-ly*, *adv.* —*single-hand-ed-ness*, *n.*  
**single-heart-ed** (sɪŋɡəl hɑrtɪd), *adj.* sincere and undivided in feeling or spirit; dedicated.  
**single-mind-ed** (sɪŋɡəl maɪndɪd), *adj.* 1. having or showing a single aim or purpose: a single-minded program. 2. dedicated; steadfast. —*single-mind-ed-ly*, *adv.* —*single-mind-ed-ness*, *n.*  
**single-ness** (sɪŋɡəl nəs), *n.* the state or quality of being single.  
**single-phase** (sɪŋɡəl fāz'), *adj.* Elec. noting or pertaining to a circuit having an alternating current with one phase or with phases differing by 180°.  
**single quotes**, one pair of single quotation marks, written as single and used for a quotation within another quotation: He said, "I told you to say 'Open sesame' when you want to enter the mountain." Cf. *double quotes*.  
**single-shot** (sɪŋɡəl ʃɒt'), *adj.* (of a firearm) requiring loading before each shot; not having a cartridge magazine.  
**single-space** (sɪŋɡəl spās'), *v.* —*spaced*, *-spacing*. —*i.* 1. to type (copy) on each line space. —*i.* 2. to type copy leaving no blank spaces between lines.  
**single Span-ish bur-ton**, a tackle having a runner as well as the fall supporting the load. See *diag. at tackle*.  
**single stand-ard**, 1. a single set of principles or rules applying to everyone, as a single moral code applying to both men and women. Cf. *double standard*. 2. monometallism.  
**single-stick** (sɪŋɡəl stɪk'), *n.* 1. a short, heavy stick. 2. (formerly) a wooden stick held in one hand, used instead of a sword in fencing. b. fencing with such a stick.  
**single-let** (sɪŋɡəl lɪt'), *n.* Chiefly Brit. a man's undershirt or jersey.  
**single tape**. See under *magnetic tape*.  
**single tax**, *Econ.* a tax, as on land, that constitutes the sole source of public revenue. —*single-tax*, *adj.*  
**single-ton** (sɪŋɡəl tən), *n.* 1. something occurring singly. 2. Cards. a card that is the only one of a suit in a hand.  
**single-track** (sɪŋɡəl træk'), *adj.* having a narrow scope; one-track: a single-track mind.  
**single-tree** (sɪŋɡəl trɪ'), *n.* whittletree. [var. of *whittletree*]  
**single whip**. See under *whip* (def. 20). See *diag. at tackle*.  
**single-ly** (sɪŋɡəlɪ), *adv.* 1. apart from others; separately. 2. one at a time; as single units. 3. single-handed; alone. [ME *singlely*]  
**sing-song** (sɪŋɡ/sɒŋ/, -sɒŋ'), *n.* 1. verse, or a piece of verse, of a jingling or monotonous character. 2. monotonous rhythmical cadence, tone, or sound. 3. Brit. a group sing. —*adj.* 4. monotonous in rhythm.  
**sing-spiel** (sɪŋɡ/spɛɪ/, Ger. *sɪŋɡ/shpɛɪ*'), *n.* a German opera, esp. of the 18th century, using spoken dialogue. [C. G. lit. sing-play]  
**sin-gu-lar** (sɪŋɡ/yə lər), *adj.* 1. extraordinary; remarkable; exceptional: a singular success. 2. unusual or strange;

odd; different: singular behavior. 3. being the only one of its kind; unique: a singular example. 4. separate; individual. 5. Gram. noting or pertaining to a member of the category of number indicating that a word form has one referent or denotes one person, place, thing, or instance, as boy, a singular noun, or goes, a singular form of the verb. Cf. *dual* (def. 4), *plural* (def. 4). 6. Logic. of or pertaining to something individual, specific, or not general. 7. Obs. personal; private. 8. Obs. single. —*n.* Gram. 9. the singular number. 10. a form in the singular. [ME < L *singularis* (is). See *SINGLE*, -*ness*] —*sin-gu-lar-ly*, *adv.* —*Syn.* 1-4. peculiar. 2. bizarre, queer, curious. 3. uncommon, rare. —*Ant.* 1. usual.  
**sin-gu-lar-ize** (sɪŋɡ/yə lə rɪz'), *v.* —*ized*, *-izing*. Chiefly Brit. singularize. —*sin-gu-lar-iza-tion*, *n.*  
**sin-gu-lar-ity** (sɪŋɡ/yə lərɪ tɪ), *n.* pl. -ties for 2. 1. the state, fact, or quality of being singular. 2. a singular, unusual, or unique quality. [ME *singularitas* < LL *singularitas*]  
**sin-gu-lar-ize** (sɪŋɡ/yə lə rɪz'), *v.* —*ized*, *-izing*. to make singular. Also, esp. Brit., *singularise*. —*sin-gu-lar-iza-tion*, *n.*  
**sinh** (sɪŋ), *n.* Math. hyperbolic sine. [SIN(x) + H(YPERBOLIC)]  
**Sin-ha-lese** (sɪn/hə lɛz', -lɛz'), *adj.* *n.* pl. -lese. Sinhalese.  
**Sin-i-cism** (sɪn/i sɪz/əm), *n.* something characteristic of or peculiar to the Chinese. [SINIC (Chinese) < ML *Sinicus* < MGK *Sinikos* = LGK *Sin* (the Chinese) + *-ikos* (ic) + *-ism*]  
**Sin-ing** (ʃɪŋ/ɪŋ), *n.* a city in and the capital of Chinghai in W China, 300,000 (est. 1957). Also, *Hsinling*.  
**sin-is-ter** (sɪn/i stər), *adj.* 1. threatening or portending evil, harm, or trouble; ominous. 2. malevolent; evilly intended. 3. Heraldry. noting the side of an escutcheon or achievement of arms that is to the left of the hypothetical bearer (opposed to *dexter*). 4. Archaic. of or on the left side; left. [late ME < L: on the left hand or side, hence unfavorable, injurious (from the Roman belief that unfavorable omens appear on one's left)] —*sin-is-ter-ly*, *adv.* —*Syn.* 1. inauspicious, portentous. —*Ant.* 1. benighted.  
**sinistr-**, a learned borrowing from Latin meaning "left," "on the left," used in the formation of compound words: *sinistrous*. Also, esp. before a consonant, *sinistro-*. [C. L. *sinister*, s. of *sinister*]  
**sin-is-tral** (sɪn/i strəl), *adj.* 1. of, pertaining to, or on the left side; left (opposed to *dextral*). 2. left-handed. [late ME < ML *sinistralis*] —*sin-is-tral-ly*, *adv.*  
**sin-is-tro-gy-ra-tion** (sɪn/i strɔʃ/ɪ rəʃən, sɪ nɪs'trɔ-), *n.* Chem. levorotation. —*sin-is-tro-gy-ric* (sɪn/i strɔʃ/ɪ rɪk), *adj.*  
**sin-is-trorse** (sɪn/i strɔrs', sɪ nɪs'trɔrs, sɪ nɪs'trɔrs'), *adj.* Bot. (from a point of view at the center of the spiral) rising spirally from right to left, as a stem (opposed to *dextrorse*). [C. L. *sinistorsus* (us), lit., turned leftwards, contr. of *\*sinistorsorsus*, var. of *\*sinistorsorsus*. See *SINISTRO-*, *VERAUS*]  
**sin-is-trous** (sɪn/i strɔs'), *adj.* 1. ill-omened; unlucky; disastrous. 2. sinister; left. —*sin-is-trous-ly*, *adv.*  
**Sin-it-ic** (sɪn/i tɪk), *n.* 1. a branch of Sino-Tibetan consisting of the various local languages and dialects whose speakers share literary Chinese as their standard language. —*adj.* 2. of or pertaining to the Chinese, their language, or their culture. [C. LL *Sin(ae)* the Chinese (< LGK *Sinai*) + *-itic*]  
**sink** (sɪŋk), *v.* sank or, often, sunk; sunk or sunk-en; sink-ing; *n.* —*v.* 1. to fall, drop, or descend gradually to a lower level. 2. to go down toward or below the horizon. 3. to slope downward; dip. 4. to displace the volume of an underlying substance or object and become submerged or partially submerged (often fol. by *in* or *into*): The battleship sank within two hours. His foot sank in the mud. 5. to fall or collapse slowly from weakness, fatigue, etc. 6. to become absorbed in or gradually to enter a state or condition (usually fol. by *in* or *into*): to sink into slumber. 7. to pass or fall into some lower state or condition. 8. to fall in physical strength or health. 9. to become lower in loudness, tone, or pitch. 10. to enter or permeate the mind; become known or understood (usually fol. by *in* or *into*): I repeated it till the words sank in. 11. to become hollow, as the cheeks. 12. to sit, recline, or lie (usually fol. by *down*, *in*, *on*, etc.): He sank down on the bench. —*v.* 13. to cause to fall, drop, or descend gradually. 14. to cause to become submerged. 15. to lower or depress the level of. 16. to bury, plant, or lay (a pipe, conduit, etc.) into or as into the ground. 17. to bring to a worse or lower state or status. 18. to reduce in amount, extent, intensity, etc. 19. to lower in loudness, tone, or pitch. 20. to invest in the hope of making a profit or gaining some other return. 21. to dig, bore, or excavate (a hole, shaft, well, etc.). —*n.* 22. a basin or receptacle connected with a water supply, used for washing. 23. a low-lying, poorly drained area where waters collect or disappear by sinking down into the ground or by evaporation. 24. sinkhole (def. 2). 25. a place of vice or corruption. 26. a drain or sewer. 27. any pond or pit for sewage or waste, as a cesspool or a pool for industrial wastes. [ME; OE *sincan*]; c. D *sinken*, G *sinken*, Icel *sökkva*, Goth *sinkan*]  
**sink-age** (sɪŋk/ɪdʒ), *n.* the act, process, or an amount of sinking.  
**sink-er** (sɪŋk/ər), *n.* 1. a person or thing that sinks. 2. a person employed in sinking, as one who sinks shafts. 3. a weight, as of lead, for sinking a fishing line or net below the surface of the water. 4. Slang. a doughnut.  
**sink-hole** (sɪŋk/hɒl), *n.* 1. a hole formed in soluble rock by the action of water, serving to conduct surface water to an underground passage. 2. Also called sink, a depressed area in which waste or drainage collects. [ME]  
**Sin-kiang** (sɪn/kyɑŋ/; Chin. *shín/kyāŋ*'), *n.* the westernmost division of China, bordering Tibet, India, the Soviet Union, and Mongolia; formerly a province. 5,640,000 (est. 1957); 635,829 sq. mi. Cap.: Urumchi. Official name, *Sin-kiang-Ui-gur Autonomous Re-gion* (sɪn/kyɑŋ/wɛ/gʊr).  
**Sin-kiang** (sɪn/kyɑŋ/wɛ/gʊr), *n.* the act, process, or an amount of sinking.  
**sink-ing fund**, a fund to extinguish an indebtedness, usually a bond issue.  
**sink-ing spell**, a temporary decline, as in health.  
**sin-less** (sɪn/lɪs), *adj.* free from or without sin. [ME *sinles*, OE *synlās*]  
**sin-ner** (sɪn/ər), *n.* a person who sins; transgressor. [ME]

## APPENDIX XVII

Serial No.: 09/955,604

Docket No.: 49933US032

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1. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986) cert. denied, 480 U.S. 947 (1987).
  2. In re Hoeksema, 399 F.2d 269, 158 U.S.P.Q. 596 (CCPA 1968).
  3. M.P.E.P. § 2121.01.
  4. M.P.E.P. § 2141.01.
  5. In re Wesslau, 353 F.2d 238, 147 U.S.P.Q. 391 (CCPA 1965).
  6. Bausch & Lomb, Inc. v. Barnes-Hind/Hycrocurve, Inc., 796 F.2d 443, 230 U.S.P.Q. 416 (Fed. Cir. 1986) cert. denied, 484 U.S. 823 (1987), on remand, 10 U.S.P.Q. 2d 1929 (N.D. Calif. 1989).
  7. In re Gorman, 933 F.2d 982, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).
  8. In re Dow Chem., 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988).

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**Hybritech Incorporated v. Monoclonal Antibodies, Inc.****(CA FC)****231 USPQ 81****Decided September 19, 1986****No. 86-531****U.S. Court of Appeals Federal Circuit**

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**Headnotes****PATENTS****1. Patentability -- In general (§ 51.01)**

Federal district court's finding that evidence was lacking as to when, before May 1980, claimed invention of using monoclonal antibodies in "sandwich" assays was conceived by patent holder, is clearly erroneous, in view of evidence demonstrating patent holder's earlier efforts in developing claimed invention by using prior art technology to produce necessary monoclonal antibodies in diagnostic sandwich assay kits, in view of evidence demonstrating that exploiting monoclonal antibodies for use in sandwich assays was one of patent holder's major objectives, and in view of laboratory notebooks and research program that fully corroborate testimonial evidence of conception, since such evidence clearly supports holding that patent holder conceived claimed invention before patent challenger and that patent challenger's work is not prior art.

**2. Patentability -- Anticipation -- In general (§ 51.201)**

Prior art work that involved "sandwich" assay to extent that antigen was sandwiched between two monoclonal antibodies, but that did not involve detecting presence of or quantitating antigen, did not anticipate claimed invention, since it did not meet its every element.

**3. Patentability -- Invention -- In general (§ 51.501)**

Articles which "predicted" widespread use of monoclonal antibodies but which are dated well after patented monoclonal assay's date of conception and within one year of its



filing date, are not prior art, nor should earlier articles which discussed production of monoclonal antibodies, although clearly prior art, have been relied upon to establish obviousness of trying monoclonal antibodies of particular affinity in "sandwich" immunoassay that detects presence of or quantitates antigen, since such articles do not suggest how that end may be accomplished, and since "obvious to try" is improper consideration in adjudicating obviousness issue.

**4. Patentability -- Evidence of -- Commercial success -- Causes (§ 51.4555)**

Trial court's finding that "sudden availability" of monoclonals was reason for commercial success of patented diagnostic kits is clearly erroneous, in view of evidence demonstrating that at least three years passed between time monoclonal antibodies were available in adequate supply and time patent holder began selling its kits.

**5. Claims -- Indefinite -- Chemical (§ 20.553)**

Federal district court erred in holding that claims for monoclonal assay are indefinite because antibody affinity cannot be estimated with any consistency, since calculating affinity was known in art at time of filing, and since such claims reasonably apprise those skilled in art and are as precise as subject matter permits, even though calculations are not precise or "standard."

**Particular patents -- Assays**

4,376,110, David and Green, Immunometric Assays Using Monoclonal Antibodies, holding of invalidity reversed.

**Case History and Disposition:**

Page 81

**Appeal from District Court for the Northern District of California, Conti, J.; 227 USPQ 215 .**

**Action by Hybritech Incorporated, against Monoclonal Antibodies, Inc., for patent infringement. From judgment for defendant, plaintiff appeals. Reversed and remanded.**

**Attorneys:**

**Douglas E. Olson, and Lyon & Lyon, both of Los Angeles, Calif. (James W. Geriak and Bradford J. Duft, both of Los Angeles, Calif., on the brief) for appellant.**

**David J. Brezner, and Flehr, Hohback, Test, Albritton & Herbert,**

**both of San Francisco, Calif. (Barry E. Britschneider and Herbert I. Cantor, both of Washington, D.C., of counsel) for appellee.**

**Judge:**

Before Rich, Davis, and Smith, Circuit Judges.

**Opinion Text**

**Opinion By:**

Rich, Circuit Judge.

This appeal is from the August 28, 1985, decision of the United States District Court for the Northern District of California, 623 F.Supp. 1344, 227 USPQ 215, in favor of defendant Monoclonal Antibodies, Inc. (Monoclonal) holding that all 29 claims of plaintiff's patent No. 4,376,110 entitled "Immunometric Assays Using Monoclonal Antibodies" ('110 patent), issued to Dr. Gary S. David and Howard E. Greene and assigned to Hybritech Incorporated (Hybritech), are invalid as anticipated under 35 USC 102(g), for obvious

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ness under §103, and under §112 first and second paragraphs. We reverse and remand.

**Background**

Vetebrates defend themselves against invasion by microorganisms by producing antibodies, proteins which can complex with the invading microorganisms and target them for destruction or removal. In fact, any foreign molecule of sufficient size can act as a stimulus for antibody production. Such foreign molecules, or antigens, bear particular sites or epitopes that represent antibody recognition sites. B cell lymphocytes, the cells that actually produce antibodies, recognize and respond to an epitope on an antigen by reproducing or cloning themselves and then producing antibodies specific to that epitope. Even if the antigen is highly purified, the lymphocytes will produce antibodies specific to different epitopes on the antigen and so produce antibodies with different specificities. Furthermore, because the body is exposed to many different antigens, the blood of a vertebrate will contain antibodies to many different antigenic substances.

Scientists and clinicians have long employed the ability of antibodies to recognize and complex with antigens as a tool to identify or label particular cells or molecules and to separate them from a mixture. Their source of antibodies has been primarily the serum separated from the blood of a vertebrate immunized or exposed to the antigen. Serum, however, contains a mixture of antibodies directed to numerous antigens and to any number of epitopes on a particular antigen. Because such a mixture of antibodies arises from many different clones of lymphocytes, it is called "polyclonal."

Recent technological advances have made it possible to isolate and cultivate a single clone of lymphocytes to obtain a virtually unlimited supply of antibodies specific to one particular epitope. These antibodies, known as "monoclonal antibodies" because they arise from a single clone of lymphocytes, are produced by a relatively new technology known as the hybridoma. Hybridomas are produced by fusing a particular cancer cell,

the myeloma cell, with spleen cells from a mouse that has been injected or immunized with the antigen. These fusions are isolated by transferring them to a growth fluid that kills off the unfused cancer cells, the unfused spleen cells dying off by themselves. The fused hybrid spleen and myeloma cells, called hybridomas, produce antibodies to the antigen initially injected into the mouse. The growth fluid containing the hybridomas is then diluted and put into individual test tubes or wells so that there is only one hybridoma per tube or well. Each hybridoma then reproduces itself and these identical hybridomas each produce identical monoclonal antibodies having the same affinity and specificity. In this way, a virtually unlimited supply of identical antibodies is created, directed to only one epitope on an antigen rather than, as with polyclonal antibodies, to many different epitopes on many different antigens.

In addition to the specificity of antibodies to particular epitopes discussed above, antibodies also have a characteristic "sensitivity," the ability to detect and react to antigens. Sensitivity is expressed in terms of "affinity:" the greater an antibody's ability to bind with a particular antigen, the greater the antibody's affinity. The strength of that antibody-antigen bond is in part dependent upon the antibody's "affinity constant," expressed in liters per mole, for the antigen.

Immunoassays, the subject matter of the '110 patent are diagnostic methods for determining the presence or amount of antigen in body fluids such as blood or urine by employing the ability of an antibody to recognize and bind to an antigen. Generally, the extent to which the antibody binds to the antigen to be quantitated is an indication of the amount of antigen present in the fluid. Labelling the antibody or, in some cases, the antigen, with either a radioactive substance, I 125, or an enzyme makes possible the detection of the antibody-antigen complex. In an extreme case, where the fluid sample contains a very low level of the antigen, binding might not occur unless the antibodies selected or "screened" for the procedure are highly sensitive.

In the case of a "competitive" immunoassay, a labelled antigen reagent is bound to a limited and known quantity of antibody reagent. After that reaction reaches equilibrium, the antigen to be detected is added to the mixture and competes with the labelled antigen for the limited number of antibody binding sites. The amount of labelled antigen reagent displaced, if any, in this second reaction indicates the quantity of the antigen to be detected present in the fluid sample. All of the antigen attached to the antibody will be labelled antigen if there is no antigen in the test fluid sample. The advantage of this method is that only a small amount of antibody is needed, its drawback, generally, that the system must reach equilibrium, and thus produces results slowly.

In the case of a "sandwich" assay, otherwise known as an immunometric assay, the latter being a term coined by Dr. Lawton Miles in 1971, a quantity of unlabelled antibody reagent is bound to a solid support surface such as the inside wall of a test tube containing a complex of the fluid sample containing the

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antigen to be detected and a labelled *antibody* reagent. The result is an insoluble three part complex referred to as a sandwich having antibody bread and antigen filling. This figure is illustrative of the sandwich concept:

*Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

The advantage of the sandwich assay is that it is fast and simple, its drawback that enormous quantities of antibodies are needed.

### **Hybritech**

Hybritech, started in 1978 and joined thereafter by coinventors Green and Dr. David, has, since 1979, been in the business of developing diagnostic kits employing monoclonal antibodies that detect numerous antigens and thus a broad range of conditions such as pregnancy, cancer, growth hormone deficiency, or hepatitis. Examples of antigens include influenza viruses, immunoglobulin E (IgE) which indicates allergic reaction, human chorionic gonadotropin (HCG) which indicates pregnancy, and prostatic acid phosphatase (PAP) which indicates prostate cancer, to name a few. Dr. Adams, a business-experienced scientist, joined the company in May 1980 as head of research and development. The '110 patent, application for which was filed August 4, 1980, issued March 8, 1983, with claims defining a variety of sandwich assays using monoclonal antibodies. Claim 19, apparently the broadest of the twenty-nine in the patent, is directed generally to a sandwich assay and reads (emphasis ours):

19. In an *immunometric assay* to determine the presence or concentration of an antigenic substance in a sample of a fluid comprising forming a ternary complex of a first labelled antibody, said antigenic substance, and a second antibody said second antibody being bound to a solid carrier insoluble in said fluid wherein the presence of the antigenic substance in the samples is determined by measuring either the amount of labelled antibody bound to the solid carrier or the amount of unreacted labelled antibody, *the improvement comprising* employing monoclonal antibodies having an affinity for the antigenic substance of at least about 10<sup>8</sup>liters/mole for each of said labelled antibody and said antibody bound to a solid carrier.

Claim 1, directed particularly to a reverse sandwich assay, explained *infra*, reads:

1. A process for the determination of the presence of [sic, or] concentration of an antigenic substance in a fluid comprising the steps:
  - (a) contacting a sample of the fluid with a measured amount of a soluble first monoclonal antibody to the antigenic substance in order to form a soluble complex of the antibody and antigenic substance present in said sample, said first monoclonal antibody being labelled;
  - (b) contacting the soluble complex with a second monoclonal antibody to the antigenic substance, said second monoclonal antibody being bound to a solid carrier, said solid carrier being insoluble in said fluid, in order to form an insoluble complex of said first monoclonal antibody, said antigenic substance and said second monoclonal antibody bound to said solid carrier;
  - (c) separating said solid carrier from the fluid sample and unreacted labelled antibody;
  - (d) measuring either the amount of labelled antibody; associated with the solid carrier or the amount of unreacted labelled antibody; and
  - (e) relating the amount of labelled antibody measured with the amount of labelled antibody measured for a control sample prepared in accordance with steps (a)-(d), said control sample being known to be free

of said anti-genic substance, to determine the presence of antigenic substance in said fluid sample, or relating the amount of labelled antibody measured with the amount of labelled antibody measured for samples containing known amounts of antigenic substance prepared in accordance with steps (a)-(d) to determine the concentration of antigenic substance in said fluid sample, the first and second monoclonal antibodies having an affinity for the antigenic substance of at least about 10<sup>8</sup> liters/mole.

### ***The District Court Decision***

Hybritech sued Monoclonal March 2, 1984, for damages and an injunction alleging that the manufacture and sale of Monoclonal's diagnostic kits infringed the '110 patent. Trial without a jury began on August 5, 1985, and concluded August 23, 1985, thirty witnesses having been heard and over 2,000 pages of transcript generated. The district court produced the reported opinion, findings, and con

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clusions, which use nearly verbatim Monoclonal's *pre-trial* brief and *pre-trial proposed* findings of fact and conclusions of law, in three days, in support of the judgment now on appeal.

The district court held that the claimed subject matter of the '110 patent was neither conceived nor actually reduced to practice before May 1980, and was anticipated under §102(g) by the actual reduction to practice of the invention by Drs. Uotila and Ruoslahti at the La Jolla Cancer Research Foundation (LJCRF) as early as November of 1979 and by the actual reduction to practice of the invention by Drs. Oi and Herzenberg (Oi/Herzenberg work) at the Stanford University Laboratory as early as July 1978, later published in December of 1979.

The district court also held the claims of the '110 patent invalid for obviousness from the Oi/Herzenberg work in view of (1) a February 1979 article by M. E. Frankel and W. Gerhard (Frankel article) which discloses high-affinity monoclonal antibodies, and apparently in view of numerous other references including (2) the work of Nobel Prize winners G. Kohler and C. Milstein disclosing a Nobel Prize-worthy method for producing monoclonal antibodies in vitro (outside the body) published in an August 7, 1975, article; (3) U.S. Patent No. 4,244,940 issued to Jeong et al. disclosing a simultaneous polyclonal assay (Jeong), U.S. Patent No. 4,098,876 to Piasio et al. disclosing a reverse polyclonal sandwich assay (Piasio), U.S. Patent No. 4,016,143 to Schurrs et al. disclosing a forward polyclonal sandwich assay (Schurrs); (4) a July 1979 publication by A. C. Cuello et al. disclosing the use of monoclonal antibodies in competitive assays; and (5) eight articles dated between January 1979 and March 6, 1980, "predicting" that monoclonal antibodies would be used in future immunoassays.<sup>1</sup>

The district court also invalidated the patent on various grounds based on 35 USC 112, first and second paragraphs, as hereinafter discussed.

### ***A. The References***

#### ***1. Kohler and Milstein's Nobel Prize-Winning Work: Producing Monoclonal Antibodies In Vitro For the First Time***

In early immunoassay work, polyclonal antibodies produced in vivo (in the body) in mice were used to bind with the antigen to be detected in the body fluid sample. Mice

were immunized by injection with antigen so that the lymphocytes in their bodies produced antibodies that attacked the injected antigen. Those polyclonal antibodies were withdrawn from the animal's blood and used in immunoassays. The major problem was that when the mice's immune systems changed or the mice died, the antibodies changed or died too; supply was limited and uncertain.

As the examiner was aware, Kohler and Milstein developed a technique not only for producing antibodies in vitro, independent of a living body, thus eliminating dependence on a particular animal, but for in vitro production of monoclonal antibodies by hybridomas, discussed in the Background section, *supra*.

Given that sandwich assays require enormous amounts of antibodies, companies like appellant and appellee, which utilize monoclonal antibodies for sandwich assays, would not be in business were it not for the work of Kohler and Milstein.

## **2. The Work of Drs. Ruoslahti, Uotila, and Engvall at the La Jolla Cancer Research Foundation (LJCRF) in 1979 and 1980**

Dr. Ruoslahti performed mostly competitive immunoassays using polyclonal antibodies to alphafetoprotein (AFP) antigens at the City of Hope since 1970. Dr. Uotila joined him in late 1978 to perform immunoassays using monoclonal antibodies to AFP. After producing monoclonal antibodies to AFP and performing competitive radio immunoassays (RIA -- a competitive assay that uses a radioactive label) with monoclonal antibodies at the City of Hope in mid-1979, Drs. Ruoslahti, Uotila and Engvall left LJCRF.

In the fall of 1979, September or October according to Dr. Uotila, discussion and work began on using monoclonal antibodies to AFP in a sandwich assay. Dr. Uotila, the principal researcher in this particular endeavor, generated six notebooks while at the City of Hope and LJCRF. The next-to-last page of notebook four contained a note to Dr. Uotila from Dr. Ruoslahti reading:

Sometime you should enzyme label a good monoclonal antibody so that you can set up a sandwich assay. If you use two monoclonal antibodies, you may be able to do the assay with a single incubation, since the monoclonal antibodies are likely to be

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directed against different determinants and not compete with one another. Although Dr. Uotila's notebook pages were, for the most part, unsigned, undated, and uncorroborated, Dr. Ruoslahti's testimony, placed the date of this note at about October 1979 by referring to the first pages of notebook five which were dated in early November 1979. Dr. Ruoslahti testified that one curve on one graph on page 43D of notebook five showed a successful simultaneous sandwich assay using monoclonal antibodies about November 5, 1979, although no data supporting that graph could be found elsewhere in the notebook. He further testified that the affinity of the monoclonal antibodies used for that test was not calculated until 1980 but that the raw data necessary for that calculation was generated in 1979.

Dr. Uotila stated in her deposition (she did not testify at trial) that she started work on a sandwich assay using monoclonal antibodies between October 4 and the end of that month, 1979, and that she could not remember the procedure used nor was there enough

information in her notebook, including page 43D, to refresh her memory. She did remember, although she continued work on this assay because the tests did not yield repeatedly good curves without which she would not publish her work, that the assay on page 43D was successful. Dr. Engvall testified about a discussion of Dr. Uotila's monoclonal antibody work with her while at the City of Hope and about first performing a sandwich assay after arriving at LJCRF in 1979.

### **3. *The Work of Drs. Oi and Herzenberg at the Stanford University Laboratory in 1978 Published in December 1979***

Drs. Oi and Herzenberg used monoclonal antibodies to "map" epitopes or determine the number and location of different antibody binding sites on a known quantity of IgE antigen by attaching to it an antibody bound to a carrier and exposing that antigen to other monoclonal antibodies. The antibodies either attached to epitopes on the antigen or were blocked from doing so by the other monoclonal antibodies, depending on the location and number of epitopes; if the epitopes on the antigen were too close together and the number of antibodies too great, few antibodies would bind to the antigen. Hybritech points out that both Dr. Herzenberg and Dr. Oi testified that *their work did not involve determining the presence or quantity of antigen*, that they had no idea what the affinities of the monoclonal antibodies used were, and that those values were never calculated.

One unsigned, unwitnessed page from three large laboratory notebooks, which Hybritech argues is insufficient because it does not identify the chemical reagents or protocol used, was relied on by Monoclonal to establish actual reduction to practice of the Oi/Herzenberg work in 1978 to establish a case of §102(g) prior invention by another. The district court agreed with Monoclonal that the Oi/Herzenberg work anticipated the claimed invention and, in addition, combined this work with the Frankel publication to hold that the claimed subject matter was obvious under §103.

### **4. *The Frankel Article: Monoclonal Antibodies Having Affinities of 10<sup>9</sup> liters/mole***

Frankel describes an RIA (radioimmunoassay) method for the rapid determination of affinity constants for monoclonal antibodies produced from hybridomas. The article states that the assay used is applicable only to antibodies with binding constants of about 10<sup>10</sup> liters/mole and discloses the binding constants for antibodies to several closely related strains of influenza virus.

The district court found that Frankel disclosed monoclonal antibodies having the affinity constants claimed in the '110 patent, 10<sup>8</sup> to over 10<sup>9</sup> liters/mole.

### **5. *The Cuello Article and the Jeong, Piasio, and Schurr Patents Considered by the Examiner***

Cuello, dated July 1979, states that it describes the usefulness of monoclonal antibodies in the characterization and localization of neurotransmitters such as Substance P, a peptide clearly associated with the transmission of primary sensory information in the spinal cord. The article discloses producing monoclonal antibodies from hybrid myelomas (hybridomas), their use in conventional radioimmunoassay techniques, and the benefits from doing so which flow from the ability to derive permanent cell lines capable of continuous production of highly specific antibodies.

The district court found that the examiner twice rejected all of the claims of the '110

patent based on Cuello alone or in combination with the Jeong, Piasio, and Schurr references which disclose various sandwich assays using polyclonal antibodies. The court also found that the examiner allowed the claims after they were amended to include the 10 8affinity limitation and after Richard Bartholomew, a Hybritech employee, submitted an affidavit alleging the advantages of using monoclonal rather than polyclonal antibodies in sandwich assays.

Apparently based on the testimony of Monoclonal's expert witness Judith Blakemore, a named inventor of the Jeong patent, manager of antibody programs at Bio-Rad Laboratories from 1975 to 1982, and currently manager of monoclonal antibody therapeutics at Cetus Corporation, a Hybritech competitor in immunoassay diagnostics, the district court stated

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that the "reasons for allowance were not well-founded because (1) the alleged advantages were expected as naturally flowing from the well-known natural characteristics of monoclonal antibodies . . .; (2) . . . were not significant . . .; or (3) were at best minor," although they were "argued to the examiner as if they were" important. These were Monoclonal's words from its pretrial submission adopted by the court.

#### ***6. The References That "Predicted" the Use of Monoclonal Antibodies in Immunoassays***

The district court stated, again in Monoclonal's words, that "it is of the utmost importance" that the advantages of monoclonal antibodies were "predicted by a number of authorities," eight to be exact, not important enough to list here, after the Kohler and Milstein discovery and after monoclonal antibodies became available.

#### ***B. The Claimed Subject Matter of the '110 Patent***

Hybritech argues that the district court's determination that there is no credible evidence of conception or reduction to practice of the '110 invention before May 1980 is error because Dr. David's laboratory notebooks, Nos. 21 and 24, clearly show successful sandwich assays using monoclonal antibodies in August, September, and October of 1979. At the least, argues Hybritech, the invention was conceived in January of 1979, long before Drs. Ruoslahti, Engvall, and Uotila began work on a sandwich assay using monoclonal antibodies, and diligence was thereafter exercised until constructive reduction to practice occurred by the filing of the '110 patent application on August 4, 1980.

Dr. David and Greene testified that pages 2118 to 2122 of Dr. David's notebook, dated January 4, 1979, and witnessed January 30, 1979, disclose the generic conception of the invention in the context of the physical support structure used to carry out a sandwich assay, and Dr. David testified on redirect that (1) Page 1128 of notebook 21, dated May 27, 1979, recorded an early attempt at a sandwich assay that failed, (2) on August 3, 1979, as recorded at page 1166, a sandwich assay using monoclonal antibody 068 attached to a solid carrier, a radio-labelled 068 antibody, and a hepatitis antigen from an Abbott Labs polyclonal competitive assay kit was successfully performed, and (3) a sandwich assay using a bound 259 antibody, a radio-labelled 068 antibody, and a hepatitis antigen was successfully performed on September 21, 1979. Hybritech also urges that work in October 1979 directed to determining whether certain monoclonal



antibodies were recognizing the same or different determinants, was a reduction to practice.

Monoclonal points out that these notebook pages do not expressly state that monoclonal antibodies of 10 8liters/mole affinity were used in a sandwich assay and that the May, August, and September notebook entries were not witnessed until about the time Dr. Adams, experienced in patent matters, joined Hybritech and advised its researchers on properly recording laboratory work. They therefore claim that actual reduction to practice was not shown before May 1980.

## OPINION

### I. Review Under Rule 52(a) Fed.R. Civ. P.

Rule 52(a) "ensures care in the preparation of an opinion . . . and provides appellate courts with the benefit of the District Court's insights into a case," *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309 318, 227 USPQ 766, 772 (Fed. Cir. 1985) (Harvey, Senior District Judge, concurring) by requiring a district court to "find the facts specially and state separately its conclusions of law thereon." With the exception of the first eight paragraphs, the first half of the district court's opinion here is Monoclonal's *pretrial* brief and the last three pages of the opinion are Monoclonal's *pretrial* findings of fact and conclusions of law. The district court adopted the above documents virtually verbatim, with the exception of portions of each concerning inequitable conduct and noninfringement, apparently without inviting a response from Hybritech, resulting in a repetitious (as the district court admitted in the opinion), sometimes internally inconsistent, and hard to follow opinion that presents us with a difficult task in gleanng the basis for many of the conclusions. For some of the findings, submitted before trial, no supporting evidence was introduced at trial.

The Supreme Court, in *Anderson v. City of Bessemer City, N.C.*, 105 S.Ct. 1504 (1985), strongly criticized the practice of "verbatim adoption of findings of fact prepared by prevailing parties, particularly when those findings have taken the form of conclusory statements unsupported by citation to the record." *Anderson*, *supra* at 1511. This court also has cautioned against the adoption of findings, especially when proposed by a party before trial, as here, and stated that the likelihood of clear error in those findings increases in such a situation. *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 730 F.2d 1452, 1457, 221 USPQ 481, 485 (Fed. Cir. 1984).

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Notwithstanding our misgivings about whether the findings in this case, prepared before any evidence was introduced, satisfy the objectives of Rule 52(a) -- a carefully prepared opinion providing the reviewing court with the benefit of the district court's *reasoned insights* into the case -- those findings are the district court's and may be reversed only if clearly erroneous. *See Anderson*, *supra*, at 1511; *Lindemann*, 730 F.2d at 1457, 221 USPQ at 485.

"A finding is clearly erroneous when, although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed." *United States v. United States Gypsum Co.*, 333 U.S. 364, 395 (1948). "This standard plainly does not entitle a reviewing court to reverse the finding of the trier of fact simply because it is convinced that it would have decided the

case differently." *Anderson*, supra, at 1511. In other words, "if the district court's account of the evidence is plausible in light of the record viewed in its entirety" or "where there are two permissible views of the evidence," the factfinder cannot be clearly erroneous. *Anderson*, supra, at 1511 (quoting *United States v. Yellow Cab Co.*, 338 U.S. 338, 342 (1949)). This is so, stated the Court in dictum, see *Anderson*, supra, at 1516 (Blackmun, J., concurring), even when the district court's findings rest on physical or documentary evidence or inferences from other facts and not on credibility determinations. See also Rule 52(a) Fed.R. Civ. P. (as amended Aug. 1, 1985). If the latter are involved, "Rule 52 demands even greater deference to the trial court's findings" but a trial judge may not "insulate his findings from review by denominating them credibility determinations"; if documents or objective evidence contradict the witness' story, clear error may be found even in a finding purportedly based on a credibility determination. *Anderson*, supra, at 1512-13. We proceed in light of all these principles.

## **II. Presumption of Validity**

Under 35 USC 282, a patent is presumed valid, and the one attacking validity has the burden of proving invalidity by clear and convincing evidence. See, e.g., *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1360, 220 USPQ 763, 770 (Fed. Cir. 1984). Notwithstanding that the introduction of prior art not before the examiner may facilitate the challenger's meeting the burden of proof on invalidity, the presumption remains intact and on the challenger throughout the litigation, and the clear and convincing standard does not change. See, e.g., *Jervis B. Webb Co. v. Southern Systems, Inc.*, 742 F.2d 1388, 1392 & n.4, 222 USPQ 943, 945 & n.4 (Fed. Cir. 1984). The only indication that the district court recognized the presumption of validity and its proper application was its statement that "[t]he key issue in this case is whether the defendant has overcome the presumption of nonobviousness." That statement, however, speaks only part of the truth; the presumption of validity goes to validity of the patent in relation to the patent statute as a whole, not just to nonobviousness under Section 103.

## **III. Prior Invention of Another, 35 USC 102(g)**

Section 102(g) states that a person shall be entitled to a patent unless "before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it." Section 102(g) "relates to prior inventorship by another in this country" and "retains the rules governing the determination of priority of invention . . . ." *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1444, 223 USPQ 603, 606 (Fed. Cir. 1984) (quoting P.J. Federico, *Commentary on the New Patent Act*, 35 USCA page 1, at 19 (1954)). Section 102(g) says: "In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

Reduction to practice, and conception as well, is a legal determination subject to review free of the clearly erroneous standard. *Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd.*, 731 F.2d 831, 837, 221 USPQ 561, 565-66 (Fed. Cir. 1984); *D.L. Auld Co. v. Chroma Graphics Corp.*, 714 F.2d 1144, 1151, 219 USPQ 13, 18 (Fed. Cir. 1983). Findings of fact supporting that legal conclusion, are, of course, reviewed under the clearly erroneous standard.

Conception is the "formation in the mind of the inventor, of a definite and permanent

idea of the complete and operative invention, as it is hereafter to be applied in practice." 1 *Robinson On Patents* 532 (1890); *Coleman v. Dines*, 754 F.2d 353, 359, 224 USPQ 857, 862 (Fed. Cir. 1985). Actual reduction to practice requires that the claimed invention work for its intended purpose, *see, e.g., Great Northern Corp. v. Davis Core & Pad Co.*, 782 F.2d 159, 165, 228 USPQ 356, 358, (Fed. Cir. 1986), and, as has long been the law, constructive reduction to practice occurs when a patent application on the claimed invention is filed. *Weil v. Fritz*, 572 F.2d 856, 865 n.16,

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196 USPQ 600, 608 n.16 (CCPA 1978) (citing with approval *Automatic Weighing Machine Co. v. Pneumatic Scale Corp.*, 166 F. 288 (1st Cir. 1909)).

[1] After a review of the record in its entirety, including the numerous corroborating Hybritech laboratory notebooks, internal documents, and pertinent testimony, we hold clearly erroneous the district court's finding that there is no clear or corroborated evidence "with regard to when before May 1980, the idea of actually using monoclonals in sandwich assays" was conceived or, more properly, of when the *claimed invention* was conceived, and therefore reverse the court's holding, as a matter of law, that Hybritech's inventors did not conceive the claimed invention before May 1980.

Hybritech's claim of conception, generally, is evidenced by the sometimes sparsely documented work of a start-up company whose first small advances evolved into the myriad activities of a mature company with efforts directed toward developing the claimed invention by first employing the Kohler and Milstein technology to produce the necessary monoclonal antibodies and using those antibodies in diagnostic sandwich assay kits. There is no doubt that exploiting monoclonal antibodies for use in sandwich assays was one of the major objectives of Hybritech. In a letter to Pharmacia Fine Chemicals dated April 26, 1979, Greene, in responding to Pharmacia's interest in Hybritech's products, outlined the latter's "efforts to bring the exciting new hybridoma technology into routine medical use" and its exploration of "several intriguing concepts for which monoclonals may open up new immunodiagnostic techniques heretofore infeasible with animal serums." Although company minutes in early 1979 contain little about the claimed subject matter and some of the discussions thereon, such as Greene's and Dr. Adams' conversation about monoclonal sandwich assays when the former was trying to woo Dr. Adams to join Hybritech were unrecorded, the Hybritech laboratory notebooks and the nature of Hybritech's research program fully corroborate the testimonial evidence of conception and thus clearly support our holding that Hybritech conceived the claimed invention before LJCRF.

Dr. David's January 1979 notebook describes, in detail, as explained by Greene and Dr. David at trial, a nylon apparatus that undoubtedly could be used for performing a sandwich assay using monoclonal antibodies, although Dr. David testified on cross-examination that at that time Hybritech had not yet developed any monoclonal antibodies, including attaching one of the reagents to a solid carrier ring, contacting that ring with a fluid sample in a microtiter plate well, adding a labelled reagent to the well after rinsing, and then "counting" or measuring the amount of either the labelled or unlabelled reagent after a prescribed time and second rinsing. The notebook then describes the procedure for detecting an antibody "(a-x)" to an antigen "(x)" complete with diagrams and text, both illuminated by Dr. David at trial. The notebook further

states, "Alternatively, if one wished to quantitate an antigen, y, the identical procedure would be followed, except that reagents would be reversed, i.e. the reaction would be:" and there follows a clear illustration of an antibody attached to a solid carrier reacting with an antigen to form a complex, and that complex reacting with a second labelled antibody. The notebook was signed by Dr. David on January 4, 1979, and witnessed and signed on January 30 of the same year by Dr. Curry, the first cell biologist hired at Hybritech to set up the hybridoma production program.

Dr. David testified on direct that monoclonal antibodies were developed in the following months: antigens were purchased from outside sources and purified before being injected into mice; the spleen cells from those mice were fused with myelomas; and the resultant hybridomas were separated into well plates for development, and a radioimmunoassay procedure was carried out to determine the affinity of the antibodies.

The May 1979 failed sandwich assay, witnessed in May 1980, corroborates Dr. David's testimony that a polyclonal antibody bound to a solid carrier and a labelled monoclonal antibody were used in a sandwich assay with an antigen from Abbott Labs' Ausria polyclonal diagnostic kit for hepatitis. No binding was detected.

Dr. David testified about the experiment documented in the August 1979 notebook, a sandwich assay with a hepatitis antigen from an Abbott Labs Ausria kit with two Hybritech 068 monoclonal antibodies, one attached to a solid carrier bead and the other labelled; the purpose of the experiment was to quantitate the antigen. The notebook corroborates Dr. David's testimony that the test was positive and lists the counts per minute of the labelled antibody. Defendant Monoclonal's expert Ciotti testified about this experiment:

Also, of course, it is limited to -- it is limited to hepatitis antigen. And without a generic conception, it would just be merely a -- if it did work for its intended purpose -- which I would assume for purposes of discussion -- it *would be a reduction to practice of one embodiment*. And without a corresponding generic conception, I don't think it would be held to be the making of the invention in

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terms of, for instance, in claim 19. [Emphasis ours.]

Dr. David further testified that the September 21, 1979, record in David's notebook, witnessed months later, shows a reverse sandwich assay using a bound 259 monoclonal antibody and a labelled 068 monoclonal antibody with a hepatitis antigen with results confirmed by a dose response curve. <sup>2</sup> Hybritech further alleges that a laboratory notebook page dated October 1979 is a reduction to practice of the claimed invention but fails to cite any related testimony or other evidence in support thereof.

Finally, the record shows that the claimed affinity limitation "of at least about 10<sup>8</sup>liters/mole" was determined and appreciated during the course of the development of the claimed subject matter. Dr. David and Dr. Adams separately testified that the screening procedures used by Hybritech ensured that only monoclonal antibodies having at least 10<sup>8</sup>liters/mole affinity would be used in assays. An October 1979 internal memorandum from Greene to the staff states "To improve comparisons we will express all affinities to the base ten to the eighth which represents the lower end of the useable range."

We are left with the definite and firm conviction that a mistake has been committed because the district court's account of the evidence that "there was no credible evidence

of conception before May 1980" is insupportable. There is such evidence. The laboratory notebooks, alone, are enough to show clear error in the findings that underlie the holding that the invention was not conceived before May 1980. That some of the notebooks were not witnessed until a few months to one year after their writing does not make them incredible or necessarily of little corroborative value. Admittedly, Hybritech was a young, growing company in 1979 that failed to have witnesses sign the inventors' notebooks contemporaneously with their writing. Under a reasoned analysis and evaluation of all pertinent evidence, however, we cannot ignore that Hybritech, within a reasonable time thereafter, prudently had researchers other than those who performed the particular experiments witness the notebooks in response to Tom Adams' advice. The notebooks clearly show facts underlying and contemporaneous with conception of the claimed invention and in conjunction with the testimony of Dr. David and Greene, and others, are altogether legally adequate documentary evidence, under the law pertaining to conception, of the formation in the minds of the inventors of a definite and permanent idea of the complete and operative invention as it was thereafter applied in practice. We thus are not moved by Monoclonal's argument that the findings of fact underlying conception are based on credibility determinations and are more sacrosanct than usual. *See Anderson, supra*, at 1512-13.

### **1. LJCRF Is Not Prior Art**

Hybritech laboratory notebooks and the uncontradicted testimony of Dr. David and Mr. Greene show that development of the claimed invention proceeded diligently through the rest of 1979 and 1980, there being absolutely no evidence of record nor even argument by Monoclonal that Hybritech was not diligent in its efforts to reduce to practice the claimed invention during the period January 1979 to the '110 application filing date of August 4, 1980. We therefore hold as a matter of law that Hybritech's conception, which was before LJCRF conceived the claimed invention, coupled by diligence to its constructive reduction to practice by the filing of the '110 application, entitle Hybritech to priority over LJCRF. *See* 35 USC 102(g). The work of LJCRF is therefore not prior art.

We also note that there is inadequate factual basis for the district court's holding that LJCRF reduced the claimed invention to practice as early as November 1979 because the only evidence that corroborates the testimony of Ruoslahti, Uotila, and Engvall is the note from Ruoslahti to Uotila, *see* section A, 2, *supra*, which indisputably is not the claimed invention, and the *one* curve from *one* graph from only one page, 43D, of the six Uotila notebooks. After a reasoned examination, analysis, and evaluation of this pertinent evidence we conclude that it falls far short of showing the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice," *see Coleman*, 754 F.2d at 359; 224 USPQ at 862, and therefore is legally inadequate to support even a holding of *conception* of the claimed invention by LJCRF personnel in 1979.

(1) It is undisputed that page 43D was not signed, witnessed, or dated; (2) the deposition testimony of Uotila was that she could not remember the procedure used to arrive at the dose-response curve on page 43D and there was not enough information in her notebook to refresh her memory; (3) the testimony of

Ruoslahti was that he could find *no* data in the notebook supporting that graph, none of the *later* graphs shown there represented successful assays and that "especially after this was done, we ran into more severe problems. And it took us a while to do away with the problems;" (4) Ruoslahti also testified that they never determined, in 1979, the affinities of the monoclonal antibodies they used, and that the title of page 43D had been altered at some point -- the word "inhibition" had been crossed out and "sandwich" written in; and (5) the testimony of Engvall was that there was nothing about the shape of those curves which indicates that they were sandwich assays. We also note, as evidence bearing upon the credibility of Ruoslahti's testimony (that LJCRF actually reduced the claimed invention to practice in 1979), that when LJCRF attempted to provoke an interference in the PTO with Hybritech based on the U.S. filing of an application that was the counterpart to a Swedish application disclosing similar subject matter, LJCRF could not demonstrate even a *prima facie* reduction to practice prior to Hybritech's August 4, 1980, filing date. During that proceeding, the earliest dates Ruoslahti set down on paper to support conception and reduction to practice were in 1980.

## **2. The Work of Oi/Herzenberg Is Not the Claimed Invention**

[2] It is axiomatic that for prior art to anticipate under §102 it has to meet every element of the claimed invention, and that such a determination is one of fact. *See, e.g., Lindemann, supra*, 730 F.2d at 1458, 221 USPQ at 485; *Great Northern Corp. v. Davis Core & Pad Co.*, 782 F.2d 159, 165, 228 USPQ 356, 358 (Fed. Cir. 1986). Section 102(g) upon which the district court relied is one type of "anticipation," i.e., prior invention by another of the same invention. Drs. Oi and Herzenberg testified that their work did not involve detecting the presence of or quantitating antigen but a determination of the number and location of epitopes on a *known* quantity of antigen. Although this work did involve a sandwich assay to the extent that an antigen was sandwiched between two monoclonal antibodies, it is clear that the similarity between that work and the claimed invention goes no further. Furthermore, both doctors testified that they did not know the affinities of the antibodies that were used in their mapping work and in fact never calculated them. Ciotti, Monoclonal's expert, testified that the 10<sup>8</sup> affinity limitation cannot be found anywhere in the Oi/Herzenberg work. Again we are left with a definite and firm conviction that a mistake was made because that work does not meet every element of the claimed invention. The district court's finding to the contrary is clearly erroneous.

We note that the district court, in also holding the patent invalid under §103, next considered, combined the Oi/Herzenberg work with the Frankel reference, one justifiable inference therefrom being that the court recognized that Frankel discloses a claim *element* that Oi/Herzenberg does not, namely, at least about 10<sup>8</sup> liters/mole affinity.

## **IV. Obviousness, 35 USC 103**

A section 103 obviousness determination -- whether the claimed invention *would have been* (not "would be" as the court repeatedly stated because Monoclonal's pretrial papers used that improper language) obvious at the time the invention was made is reviewed free of the clearly erroneous standard although the underlying factual inquiries -- scope and content of the prior art, level of ordinary skill in the art,<sup>3</sup> and differences between the prior art and the claimed invention -- integral parts of the subjective determination involved in §103, are reviewed under that standard. Objective evidence such as commercial success, failure of others, long-felt need, and unexpected results must

be considered *before* a conclusion on obviousness is reached and is not merely "icing on the cake," as the district court stated at trial. *See Lindemann, supra*, 730 F.2d at 1461, 221 USPQ at 488; *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 219 USPQ 857 (Fed. Cir. 1983); *W.L. Gore & Associates v. Garlock Inc.*, 721 F.2d 1540, 220 USPQ 303, 314 (Fed. Cir. 1983).

### **1. The Eight Articles "Predicting" Widespread Use of Monoclonal Antibodies**

Before discussing the more pertinent references in this case -- the Oi/Herzenberg and Frankel works -- we cull the other prior art references relied on by the trial court.

[3] First, the latest four of the eight articles that the court stated were of the "utmost importance" because they "predicted" that the breakthrough in production of monoclonal antibodies by Kohler and Milstein would lead to widespread use of monoclonal antibodies in

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immunoassays are neither 102(a)/103 nor 102(b)/103 prior art because they are dated between late 1979 and March 6, 1980, well after the date of conception and within one year of the filing date of the '110 patent.

The earliest four of the eight articles, on the other hand, although clearly prior art, discuss *production* of monoclonal antibodies -- admittedly old after Kohler and Milstein showed how to produce them -- but none discloses sandwich assays. At *most*, these articles are invitations to try monoclonal antibodies in immunoassays but do not suggest how that end might be accomplished. To the extent the district court relied upon these references to establish that it would have been *obvious to try* monoclonal antibodies of 10<sup>8</sup>liters/mole affinity in a sandwich immunoassay that detects the presence of or quantitates antigen, the court was in error. *See Jones v. Hardy*, 727 F.2d 1524, 1530, 220 USPQ 1021, 1026 (Fed. Cir. 1984) ("Obvious to try" is improper consideration in adjudicating obviousness issue). <sup>4</sup>

### **2. The Kohler and Milstein Work, the Cuello Article and the Jeong, Piasio, and Schurr Patents Considered by the Examiner**

The district court's finding that Kohler and Milstein developed a method for producing monoclonal antibodies in vitro is correct, but that finding proves no more; although it made possible all later work in that it paved the way for a supply of monoclonal antibodies, it indisputably does not suggest using monoclonal antibodies in a sandwich assay in accordance with the invention claimed in the '110 patent.

The Cuello reference discloses monoclonal antibodies but not in a sandwich assay. The competitive assay in Cuello, moreover, uses only one monoclonal antibody and thus in no way suggests the claimed invention wherein a ternary complex of two monoclonal antibodies and an antigen form a sandwich. Furthermore, the court did not explain how this art, by itself or in combination with any of the other art, suggests the claimed subject matter and thus why that combination would have been obvious. We are of the opinion that it does not.

The district court correctly found that the use of polyclonal antibodies in sandwich assays was well known. The Jeong patent discloses the use of polyclonal antibodies in a

simultaneous sandwich assay, with no suggestion that monoclonal antibodies be so used. It is prior art by virtue of §102(e), application for the patent having been filed September 5, 1978, its effective date as a reference. The Piasio patent, disclosing a reverse sandwich assay using polyclonal antibodies, and Schurrs, disclosing a forward sandwich assay using the same, both §102(a) prior art, are likewise devoid of any suggestion that monoclonal antibodies can be used in a similar fashion.

### **3. The Oi/Herzenberg Work and the Frankel Article**

Clearly, the most pertinent items of prior art not cited by the examiner are the Oi/Herzenberg work, as described in section A, 3, *supra*, and the Frankel article. As stated in the discussion of Prior Invention of Another (section III, 2, *supra*), the Oi/Herzenberg work involved mapping epitopes on a known quantity of antigen. It was not concerned with and does not disclose using monoclonal antibodies of at least 10<sup>8</sup>liters/mole affinity. Oi and Herzenberg testified that they did not know the affinity of the antibodies used, and Ciotti testified that nowhere in that work is there mention of monoclonal antibody affinity of at least 10<sup>8</sup>liters/mole. On this basis, we conclude that the Oi/Herzenberg work is qualitatively different than the claimed invention; the former is directed to mapping epitopes on a known quantity of antigen and the latter to determining the "presence or concentration of an antigenic substance in a sample of fluid . . . ." We disagree with Monoclonal that these are "essentially the same thing." Furthermore, it is perfectly clear that this work in no way suggests using monoclonal antibodies of the affinity claimed in the '110 patent. It is because of these differences between the Oi/Herzenberg work and the claimed invention that the fact that an antigen was sandwiched between two monoclonal antibodies in the course of Oi's and Herzenberg's work is not sufficient basis to conclude that the claimed invention would have been obvious at the time it was made to a person of ordinary skill in the art.

Likewise, a conclusion that the invention would have been obvious cannot properly be reached when the Oi/Herzenberg work is

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considered in view of the Frankel article. Frankel teaches a method for rapid determination of affinity constants for monoclonal antibodies, some of which clearly have affinities of the order defined by the claims, but does not in any way suggest using two of those antibodies in a sandwich to assay an antigen by forming a ternary complex of labelled antibody, the antigenic substance, and a bound antibody wherein the presence of the antigenic substance is determined by measuring either the amount of labelled antibody bound to a solid carrier or the amount of unreacted labelled antibody. The mere existence of prior art disclosing how to measure the affinity of high affinity monoclonal antibodies is insufficient to support a holding of obviousness. Hybritech's claims define a *process* that *employs* monoclonal antibodies, and does not merely claim antibodies of high affinity. In view of the fact that the Oi/Herzenberg work is not directed to an assay as claimed and does not disclose antibodies of at least 10<sup>8</sup>liters/mole affinity, and further that Frankel fails to suggest using such antibodies in a sandwich assay, the Frankel article does not compensate for the substantial difference between the Oi/Herzenberg work and the claimed subject matter, and therefore those references in combination cannot support a holding of obviousness.



#### **4. Objective Evidence of Nonobviousness**

[4] In one part of its opinion the court found that "the commercial success of the kits *may* well be attributed to the business expertise and acumen of the plaintiff's personnel, together with its capital base and marketing abilities" (emphasis ours) and later that "[w]here commercial success is based on the sudden availability of starting materials, in this instance the availability of monoclonal antibodies as a result of the Kohler and Milstein discovery, business acumen, marketing ability, and capital sources, no causal relationship is proven." (Citation omitted.)

##### **i. Commercial Success: Hybritech's Diagnostic Kits Grabbed a Substantial Market Share**

The undisputed evidence is that Hybritech's diagnostic kits had a substantial market impact. The first diagnostic kit sales occurring in mid-1981, sales increased seven million dollars in just over one year, from \$6.9 million in 1983 to an estimated \$14.5 million in 1984; sales in 1980 were nonexistent. Competing with products from industry giants such as Abbott Labs, Hoffman LaRoche, Becton-Dickinson, and Baxter-Travenol, Hybritech's HCG kit became the market leader with roughly twenty-five percent of the market at the expense of market shares of the other companies. Its PAP kit ranks second only to a product sold by Dupont's New England Nuclear, surpassing products from Baxter-Travenol, Abbott, and others. Hybritech's other kits, indisputably embodying the invention claimed in the '110 patent, obtained similar substantial market positions.

Although the district court did not provide its insights into why commercial success was due to business acumen and not to the merits of the claimed invention, Monoclonal urges in support that it was due to Hybritech's spending disproportionate sums on marketing, 25-30% of income. The undisputed evidence was that expenditures of *mature* companies in this field are between 17 and 32%. Furthermore, the record shows that advertising makes those in the industry -- hospitals, doctors, and clinical laboratories -- aware of the diagnostic kits but does not make these potential users buy them; the products have to work, and there is no evidence that that is not the case here or that the success was not due to the merits of the claimed sandwich assays -- clearly contrary to the district court's finding.

The trial court's finding that the "sudden availability of monoclonals" was the reason for the commercial success of Hybritech's diagnostic kits (Finding 11) is unsupported by the record and clearly erroneous. Monoclonal admits that monoclonal antibodies were available in the United States in 1978, and the evidence clearly reflects that. Thus, at least *three years* passed between the time monoclonal antibodies were available in adequate supply and the time Hybritech began selling its kits. Especially in the fast-moving biotechnology field, as the evidence shows, that is anything but sudden availability.

##### **ii. Unexpected Advantages**

Hybritech points to the testimony of three witnesses skilled in the diagnostic field who state that, based on tests done in their laboratories as a result of real-world comparisons in the normal course of research, the diagnostic kits that embody the '110 invention unexpectedly solved longstanding problems. Dr. Hussa, the head of a large referral laboratory and a world-wide consultant, testified that until Hybritech introduced its kits, he and others were very skeptical and had almost exclusively used competitive assays with a radioactive tracer (RIAs). <sup>5</sup> In relation to an HCG Hybritech

kit, he testified that he had first thought that the Hybritech HCG kit would not give accurate results for low antigen concentrations because that condition is indicated in the Hybritech kit by a low radioactivity reading, a reading difficult to differentiate from control samples containing no antigen. He also stated that in the past, RIA kits falsely detected HCG in nonpregnant women, a condition which would indicate cancer and surgery. He stated that when he employed the Hybritech HCG kit in such instances it demonstrated, correctly and absent any difficulty interpreting the data, that no HCG was present.

Dr. Blethen, an M.D. holding a Ph.D. in biochemistry, testified that she did not think that the Hybritech HGH kit, for detecting growth hormone in children, would offer any advantage, but she determined that it detected HGH deficiencies in children where conventional RIAs failed to do so. She also stated that the kit does not give false positive readings as do conventional RIA kits, an opinion shared by Dr. Hussa. A third witness, Dr. Herschman, who holds a master's degree in chemistry, testified that he spent years working on the development of an assay that would determine the presence of TSH (thyroid stimulating hormone) with greater sensitivity. He succeeded but discovered that the Hybritech TSH kit had the same sensitivity, the test being performed in four hours rather than the three days his kit required.

Having considered the evidence of nonobviousness required by §103 and *Graham*, supra, we hold, as a matter of law, that the claimed subject matter of the '110 patent would not have been obvious to one of ordinary skill in the art at the time the invention was made and therefore reverse the court's judgment to the contrary. The large number of references, as a whole, relied upon by the district court to show obviousness, about twenty in number, skirt all around but do not as a whole suggest the claimed invention, which they must, to overcome the presumed validity, *Lindemann*, 730 F.2d at 1462, 221 USPQ at 488, *as a whole*. See 35 USC 103; *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir. 1984). Focusing on the obviousness of substitutions and differences instead of on the invention as a whole, as the district court did in frequently describing the claimed invention as the mere substitution of monoclonal for polyclonal antibodies in a sandwich assay, was a legally improper way to simplify the difficult determination of obviousness. See generally *Hodosh v. Block Drug Co*, 786 F.2d 1136, 229 USPQ 182 (Fed. Cir. 1986).<sup>6</sup>

With respect to the objective indicia of nonobviousness, while there is evidence that marketing and financing played a role in the success of Hybritech's kits, as they do with any product, it is clear to us on the entire record that the commercial success here was due to the merits of the claimed invention. It cannot be argued on this record that Hybritech's success would have been as great and as prolonged as admittedly it has been if that success were not due to the merits of the invention. The evidence is that these kits compete successfully with numerous others for the trust of persons who have to make fast, accurate, and safe diagnoses. This is not the kind of merchandise that can be sold by advertising hyperbole.

#### ***V. Enablement, Best Mode, and Definiteness Under §112***

The section 112 defense appears to have been an afterthought of both Monoclonal, who briefly but unsuccessfully attempts to defend this utterly baseless determination, and

of the district court which adopted the defense from Monoclonal's pretrial papers apparently without knowledge of the applicable law, to highlight, as it stated at trial, that it was part of its job to see that "whoever wins wins all the way or whoever loses loses all the way." Taken as a whole, the court's comments on §112 -- split into two parts, one from Monoclonal's pretrial brief and the other from the adopted pretrial

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findings and conclusions -- are internally inconsistent. The opinion states that the patent fails to disclose how (1) to make monoclonal antibodies; (2) to screen for proper monoclonal antibodies; and (3) to measure monoclonal antibody affinity and therefore the specification is nonenabling and does not satisfy the best mode requirement, and the claims are indefinite. We discuss each of these in turn.

### **1. Enablement**

Enablement is a legal determination of whether a patent enables one skilled in the art to make and use the claimed invention, *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 960, 220 USPQ 592, 599 (Fed. Cir. 1983), is not precluded even if some experimentation is necessary, although the amount of experimentation needed must not be unduly extensive, *Atlas Powder Co. v. E.I. Du Pont De Nemours & Co.*, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984), and is determined as of the filing date of the patent application, which was August 4, 1980. See *W.L. Gore and Associates v. Garlock, Inc.*, 721 F.2d 1540, 1556, 220 USPQ 303, 315 (Fed. Cir. 1983). Furthermore, a patent need not teach, and preferably omits, what is well known in the art. *Lindemann*, 730 F.2d at 1463, 221 USPQ at 489.

The record fully supports the '110 patent's statement that

The monoclonal antibodies used for the present invention are obtained by the [hybridoma] process discussed by Milstein and Kohler. . . . The details of this process are well known and not repeated here.

The district court itself stated that the "method for producing monoclonal antibodies in vitro was well known prior to the alleged invention of the '110 patent," and used the "sudden availability of monoclonal antibodies" produced by the Kohler and Milstein discovery to support, albeit erroneously, its finding of a lack of nexus between the merits of the claimed invention and its commercial success. The court then about-faced and held the '110 patent deficient because it fails to teach how to make monoclonal antibodies.

With respect to screening, the only permissible view of the evidence is that screening methods used to identify the necessary characteristics, including affinity, of the monoclonal antibodies used in the invention were known in the art and that the '110 patent contemplated one of those. At trial, Monoclonal's counsel stated "it is a procedure that was known in '78." In similar fashion, the district court held that the claimed subject matter would have been obvious in part because the "existence of monoclonal antibodies *having the affinity constants claimed in the patent was well known* prior to the alleged invention . . . ." [Emphasis ours.] Furthermore, there was not a shred of evidence that undue experimentation was required by those skilled in the art to practice the invention. We hold as a matter of law that the '110 patent disclosure is enabling.

### **2. Best Mode**

"The specification . . . shall set forth the best mode contemplated by the inventor of carrying out his invention." 35 USC 112. Because not complying with the best mode requirement amounts to concealing the preferred mode contemplated by the applicant at the time of filing, in order to find that the best mode requirement is not satisfied, it must be shown that the applicant knew of and concealed a better mode than he disclosed. *DeGeorge v. Bernier*, 768 F.2d 1318, 1324, 226 USPQ 758, 763 (Fed. Cir. 1985) (quoting with approval *In re Sherwood*, 613 F.2d 809, 204 USPQ 537 (CCPA 1980)). The only evidence even colorably relating to concealment is testimony by various Hybritech employees that sophisticated, competent people perform the screening and that the screening process is labor-intensive and time-consuming. It is not plausible that this evidence amounts to proof of concealment of a best mode for screening or producing monoclonal antibodies for use in the claimed '110 process, and therefore we are of the firm conviction that the district court's finding that the best mode requirement was not satisfied is clearly erroneous.

### 3. Indefiniteness

[5] The basis of the district court's holding that the claims are indefinite is that "they do not disclose how infringement may be avoided because antibody affinity cannot be estimated with any consistency." (Conclusion 6.) Even if the district court's finding in support of this holding -- that "there is no standard set of experimental conditions which are used to estimate affinities" -- is accurate, under the law pertaining to indefiniteness -- "if the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more," *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985) -- the claims clearly are definite. The evidence of record indisputably shows that calculating affinity was known in the art at the time of filing, and

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notwithstanding the fact that those calculations are not precise, or "standard," the claims, read in light of the specification, reasonably apprise those skilled in the art and are as precise as the subject matter permits. As a matter of law, no court can demand more.

### VI. Motions

Monoclonal's motion to strike Appendices A and B of Hybritech's reply brief as being beyond the page limit applicable to reply briefs is granted as to Appendix A but denied as to Appendix B, the latter having been helpful in culling the often non-supportive citations to the record by Monoclonal.

Hybritech's motion to supplement the record with a Monoclonal advertisement not considered at trial is denied. Any adverse impact that the disposition of these two motions has upon either party is more than outweighed by this court's patience with the seemingly endless flow of post-argument argumentative papers.

### VII. Conclusion

The judgment of the district court holding the patent in suit invalid is *reversed* in all respects, and the case is *remanded* for a determination of the issue of infringement which the court held was moot.

**REVERSED AND REMANDED**

## Footnotes

Footnote 1. With respect to obviousness, one portion of the district court's opinion apparently relies on all of the above listed references, (1)-(5), for the obviousness holding while a later portion entitled "CONCLUSIONS OF LAW" relies on only the Oi/Herzenberg and Frankel articles. Furthermore, the district court did not state that the LJCRF work was considered for purposes of §103, although we recognize that §102(g) prior art can be used for §103.

Footnote 2. A dose response curve is antigen concentration plotted against the signal produced by labelled antibody in an immunoassay. The signal increases with increasing antigen concentration in a successful assay but at some point decreases when the antigen concentration becomes too high.

Footnote 3. Although the district court failed expressly to find the level of ordinary skill in the art at the time the invention was made, it did make reference to "[p]eople working in immunology aware of the Kohler and Milstein discovery" which we deem an accurate finding for the purposes of that portion of the *Graham* factual inquiries.

Footnote 4. Finding 10, which states that the invention was contemporaneously developed and disclosed in at least five publications and patent applications not listed above *and dated well after the filing date of the '110 patent but before its issuance* is irrelevant for purposes of the hypothesis based on the three factual inquiries required by §103 as interpreted by *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966) because obviousness must be determined as of the time the invention was made.

Additionally, they are of little probative value in this case because they are dated December 1981 at the earliest, more than a year after the August 4, 1980, filing date here and roughly two years after conception occurred. Furthermore, simultaneous development may or may not be indicative of obviousness, the latter being the case here for the above reasons and because the other evidence of nonobviousness is adequate, such occurrences having been provided for in 35 USC 135. *Lindemann*, supra, 730 F.2d at 1460-61, 221 USPQ at 487; *Environmental Designs, Ltd. v. Union Oil Co. of California*, 713 F.2d 693, 698 n.7, 218 USPQ 865, 869 n.7 (Fed. Cir. 1983)

Footnote 5. Monoclonal's expert Blakemore testified that of 425 assays on the market in 1979 less than 1% were sandwich assays. Today, sandwich assays constitute the majority of all assays sold.

The record also shows that Blakemore, who testified extensively for Monoclonal that the claimed invention would have been obvious, never used monoclonal antibodies in sandwich assays at Cetus before 1980. Additionally, she did not even mention them in the Jeong patent, of which she was a coinventor, which issued January 13, 1981, long after the beginning of Hybritech's work in this area in 1979.

Footnote 6. It bears repeating that it is crucial that counsel set forth the law accurately. More particularly, it is the duty of counsel to impart to the judge that the obviousness question properly is whether the *claimed invention as a whole would have been* obvious to one of *ordinary skill in the art at the time the invention was made*, and that the district court must *expressly* make the three factual determinations required by *Graham* and consider objective evidence of obviousness *before* the legal conclusion of obviousness *vel non* is made. Submitting to the court language like "any differences . . . would have

been obvious," as was done here, violates the axiom that the question is not whether the differences would have been obvious but the claimed invention *as a whole*. Furthermore, arguing that "it would be obvious" rather than that it would *have been* obvious shifts the court's focus to the wrong period of time, namely to a time long after the invention was made, in which, more likely than not, the prior art and the level of ordinary skill in the art are more advanced. *See* 35 USC 103.

- End of Case -

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## **In re HOEKSEMA**

**(CCPA)**

**158 USPQ 596**

**Decided Aug. 8, 1968**

**No. 7778**

**U.S. Court of Customs and Patent Appeals**

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### **Headnotes**

#### **PATENTS**

**1. Rehearing and reopening—In general (§ 57.1)**

Court of Customs and Patent Appeals grants rehearing because of continuing importance of questions involved and strong suggestion of error in its earlier opinion.—  
In re Hoeksema (CCPA) 158 USPQ 596.

**2. Patentability—Composition of matter (§ 51.30)**

Process obviousness is relevant in deciding compound obviousness.—In re  
Hoeksema (CCPA) 158 USPQ 596.

**3. Patentability—Invention—In general (§ 51.501)**

In context of 35 U.S.C. 103, court is not permitted to fragment a claimed invention in applying that section; invention must be considered as a whole.—In re Hoeksema (CCPA) 158 USPQ 596.

**4. Patentability — Composition of matter (§ 51.30)**

Claimed compound is the invention as a whole (35 U.S.C. 103), but, so considered, unless there is some known or obvious way to make compound, invention is nothing more than a mental concept expressed in chemical terms and formulae on a paper; invention as a whole is claimed compound and a way to produce it; since there is no showing that claimed compound can exist because there is no showing of a known or obvious way to manufacture it, the invention as a whole is not obvious under section 103.—In re Hoeksema (CCPA) 158 USPQ 596.

**5. Patentability — Anticipation — In general (§ 51.201)****Patentability — Invention—In general (§ 51.501)**

Conditions for patentability, novelty and loss of right to patent, stated in 35 U.S.C. 102, may have relevance as to disclosure which must be found in prior art to find obviousness of invention under section 103; in determining that quantum of prior art disclosure which is necessary to declare applicant's invention "not novel" or "anticipated" within section 102, test is whether reference contains an enabling disclosure; this test applies to issues under section 103.—In re Hoeksema (CCPA) 158 USPQ 596.

**6. Patentability—Composition of matter (§ 51.30)**

If prior art fails to disclose or render obvious a method for making claimed compound, at time invention was made, it may not be legally concluded that compound itself is in possession of public; absence of known or obvious process for making claimed compounds overcomes presumption that compounds are obvious, based on close relationships between their structures and those of prior art compounds.—In re Hoeksema (CCPA) 158 USPQ 596.

**7. Pleading and practice in Patent Office—Rejections (§ 54.7)**

Patent Office having cited reference which rendered claimed compounds prima facie obvious, applicant sustained burden of going forward with contrary evidence by filing affidavit pointing out that reference does not disclose process for producing claimed compounds, thus overcoming Office's position as to reference's legal effect under 35 U.S.C. 103; thereupon, burden of going forward with proofs to support its position as to obviousness shifted to Office; Office's failure to produce such evidence requires that rejection be reversed.—In re Hoeksema (CCPA) 158 USPQ 596.

**Particular patents — 9-D-Psicofuranosylpurine**

Hoeksema, 9-D-Psicofuranosylpurine and 6-Substituted Derivatives, claim 1 of application allowed.—In re Hoeksema (CCPA) 158 USPQ 596.

**Case History and Disposition:**

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**Appeal from Board of Appeals of the Patent Office.**

Application for patent of Herman Hoeksema, Serial No. 30,770, filed May 23, 1960; Patent Office Group 120. From decision rejecting claim 1, applicant appeals. Affirmed at 154 USPQ 169 . On petition for rehearing. Reversed; Kirkpatrick, Judge, dissenting with opinion.



**Attorneys:**

**EARL C. SPAETH (EUGENE O. RETTER and GEORGE T. JOHANNESSEN of counsel) all of Kalamazoo, Mich., for appellant.**

**JOSEPH SCHIMMEL (JACK E. ARMORE of counsel) for Commissioner of Patents.**

**Judge:**

Before WORLEY, Chief Judge, RICH, SMITH, and ALMOND, Associate Judges, and KIRKPATRICK, Judge. \*

**Opinion Text****Opinion By:**

SMITH, Judge.

[1] In our prior consideration of this appeal, we affirmed the decision of the Patent Office Board of Appeals, which had affirmed the examiner's rejection of the sole remaining claim of appellant's application, <sup>1</sup> *In re Hoeksema*, 54 CCPA 1618, 379 F.2d 1007, 154 USPQ 169 (1967). Because of the continuing importance of the questions involved, and the strong suggestion of error in our earlier opinion, we granted appellant's petition for a rehearing under the provisions of Rule 7 of this court, 55 CCPA—, (October 5, 1967).

The parties filed new briefs, and the case was reargued on January 3, 1968. Upon reconsideration of our previous decision, we have concluded that our previous decision was erroneous and that a proper resolution of the issues requires that we *reverse* the decision of the board.

The facts are set forth in our original opinion. We shall assume familiarity with that statement of facts and shall here redevelop only those which we now believe were previously misapprehended or misapplied and require the present decision.

The sole claim on appeal is directed to a chemical compound and reads as follows:

1. An N-psicofuranoside having the formula:

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*Graphic material consisting of a chemical formula or diagram set at this point is not available. See text in hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

wherein A is selected from the class consisting of hydrogen, the group -XR wherein R is selected from the class consisting of hydrogen, lower-alkyl, and lower-aralkyl, and X is selected from the class consisting of oxygen and sulfur,

and the group

*Graphic material consisting of a chemical formula or diagram set at this point is not available. See text in hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

wherein R<sub>2</sub> is selected from the class consisting of hydrogen, lower-alkyl, lower-aralkyl, and lower-aryl, and R<sub>3</sub> is selected from the class consisting of lower-alkyl, lower-aralkyl, and lower-aryl, and R<sub>4</sub> is selected from the class consisting of hydrogen, a hydrocarbon carboxylic acid acyl radical containing from two to twelve carbon atoms, inclusive, and a halo-, hydroxy-, lower-alkoxy-, amino-, cyano-, thiocyno-, and nitro-substituted hydrocarbon carboxylic acid acyl radical containing from two to twelve carbon atoms, inclusive.

That claim stands rejected under 35 U.S.C. 103 as unpatentable over prior art, on this record limited solely to the De Boer et al. patent <sup>2</sup> (De Boer) which discloses a compound with the structural formula:

*Graphic material consisting of a chemical formula or diagram set at this point is not available. See text in hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

As we noted in our original opinion, the controversy here is limited to the substituent A at the 6-position of the purine ring system. Although a compound having De Boer's structure is not included in the appealed claim since A in the claim cannot be an unsubstituted or primary amino,

*Graphic material consisting of a chemical formula or diagram set at this point is not available. See text in hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*  
, the basic structure of the De Boer compound is similar to the structure of appellant's alkylamino and dialkylamino compounds. <sup>3</sup>

Despite this close structural similarity between the De Boer amino compound and the alkylamino and dialkylamino compounds included in the appealed claim, appellant chose not to submit a showing of unexpected properties in his claimed compounds. <sup>4</sup> Appellant asserted that his compounds were unobvious and patentable without such a showing. He urged that De Boer does not teach one of ordinary skill in the art how to make appellant's claimed compounds, and the examiner did not cite any other reference telling how they might be made. Therefore, in appellant's view, his claimed compounds are not in possession of the public, *In re Brown*, 51 CCPA 1254, 329 F.2d 1066, 141 USPQ 245 (1964). <sup>5</sup>

In support of his position, appellant submitted an affidavit by Dr. Paul F. Wiley relating to the unavailability to the public of processes for preparing appellant's alkylamino and dialkylamino compounds. <sup>6</sup> Dr. Wiley's qualifications

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and competence as an expert to state facts and opinion in this area of chemistry were not challenged.

Regarding the Wiley affidavit, the examiner stated, in his Answer:

The affidavit \* \* \* does not appear to be pertinent to the claim now on appeal because it is directed to the processes by which the De Boer et al. and appellant's compounds are prepared, and shows nothing unobvious for the

instantly claimed compound.

Concerning the Wiley affidavit, the board cited a statement of this court in *In re Riden*, 50 CCPA 1411, 318 F.2d 761, 138 USPQ 112 (1963), to the effect that "the method of making the compounds is a relevant fact to be considered in the question of obviousness of the compounds," 50 CCPA at 1415, 318 F.2d at 764, 138 USPQ at 114-115. But the board continued:

\* \* \* This may be so but it is only one factor and, in our opinion, should never be the overriding one which appellant is here, in effect, urging.

Appellant states the first of two central questions to be decided in this rehearing as follows:

1) Appellant will admit his compounds are obvious and unpatentable *if* an obvious process is available to make them. Does it follow then that appellant's compounds are unobvious and patentable if an obvious process is *not* available to make them?

[2] Within this context, appellant simplifies that question to: Is process obviousness relevant in deciding compound obviousness? <sup>7</sup>

The solicitor responds to the latter characterization of the question in the affirmative, pointing out that the first question bears on the principle implicit in *In re Brown*, *supra*, that claimed compounds not distinguished in their properties over closely related prior art compounds are unpatentable thereover where the claimed compounds would be "in possession of the public" in that a process for preparing them would be obvious to those of ordinary skill in the art.

In addition, the solicitor now refers to our prior opinion in which we noted that the facts in this case are closely analogous to those of *In re Riden*, *supra*, where we stated that the fact that the method of making the claimed compound is relevant, 54 CCPA at—, 379 F.2d at 1010, 154 USPQ at 172.

A recurring problem of analysis which confronted us as we prepared our previous opinion, and which still confronts us after the rehearing, has its genesis in a proper understanding of the issue as framed by appellant. In effect, appellant agrees that since the claimed product is a homolog of a known compound, it would be *prima facie* "obvious" under 35 U.S.C. 103. But this agreement is conditioned on the proviso that there is in the prior art an "obvious" process by which to make that compound.

[3] In the context of section 103, we are not permitted to fragment a claimed invention in applying that section. The clear mandate of the statute which governs our analysis requires that

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we consider the *invention as a whole* in making the determination.

[4] Thus, as we apply the statute to the present invention, we must ask first, what is the invention as a whole? Necessarily, by elementary patent law principles, it is the claimed compound, but, so considered, unless there is some known or obvious way to make the compound, the invention is nothing more than a mental concept expressed in chemical terms and formulae on a paper.

We are certain, however, that the invention as a whole is the claimed compound *and* a way to produce it, wherefore appellant's argument has substance. There has been no showing by the Patent Office in this record that the claimed compound can exist because

there is no showing of a known or obvious way to manufacture it; hence, it seems to us that the "invention as a whole," which section 103 demands that we consider, is not obvious from the prior art of record.

While there are valid reasons based in public policy as to why this defect in the prior art precludes a finding of obviousness under section 103, *In re Brown*, supra, its immediate significance in the present inquiry is that it poses yet *another difference* between the claimed invention and the prior art which *must* be considered in the context of section 103. So considered, we think the differences between appellant's *invention as a whole* and the prior art are such that the claimed invention would not be obvious within the contemplation of 35 U.S.C. 103.

[5] While 35 U.S.C. 102 is not *directly* involved in the issue on review, the conditions for patentability, novelty and loss of right to patent, there stated, may have relevance as to the disclosure which must be found in the prior art to find obviousness of an invention under section 103. In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention "not novel" or "anticipated" within section 102, the stated test is whether a reference contains an "enabling disclosure," in the present context, a process by which the claimed compound could be made. In *In re LeGrice*, 49 CCPA 1124, 301 F.2d 929, 133 USPQ 365 (1962), we observed that the resolution of this issue required us to determine whether, *as a matter of law*, a reference without such a disclosure constituted a statutory time bar to an applicant's right to a patent. There, the issue was founded on 35 U.S.C. 102(b), not 103, but our conclusions have a certain pertinence here. We concluded, *id.* at 1134, 301 F.2d at 936, 133 USPQ at 372:

We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention*. \* \* \*

In *In re Brown*, supra, this court discussed *In re Von Bramer*, 29 CCPA 1018, 127 F.2d 149, 53 USPQ 345 (1942), commenting that that opinion should not be construed to encompass what had come to be called the "Von Bramer doctrine." There we stated, 51 CCPA at 1257, 329 F.2d at 1009, 141 USPQ at 247:

\* \* \* This doctrine, which appears to have resulted from *In re Von Bramer et al.*, supra, seems over a period of years to have been tailored in some quarters to a principle which defeats the novelty of a chemical compound on the basis of a mere printed conception or a mere printed contemplation of a chemical "compound" *irrespective of the fact that so-called "compound" described in the reference is not in existence or that there is no process shown in the reference for preparing the compound, or that there is no process known to a person having ordinary skill in the relevant art for preparing the compound*. In other words, a mere formula or a mere sequence of letters which constitute the designation of a "compound," is considered adequate to show that a compound in an application before the Patent Office, which compound is designated by the same formula or the same sequence of letters, is old. We do not think that the *Von Bramer* case should be so construed. [Emphasis added.]

To the extent that anyone may draw an inference from the *Von Bramer* case that the *mere* printed conception or the *mere* printed contemplation which

constitutes the designation of a "compound" is sufficient to show that such a compound is old, regardless of whether the compound is involved in a 35 U.S.C. 102 or 35 U.S.C. 103 rejection, we totally disagree. \* \* \* [Footnotes omitted.]

We concluded, relying on *In re Le Grice*, supra, and *E. I. du Pont de Nemours & Co. v. Ladd*, 328 F.2d 547, 140 USPQ 297 (D.C. Cir. 1964), that the "true test of any prior art relied on to show or suggest that a chemical compound is old, is whether the prior

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art is such as to place the disclosed 'compound' in the *possession of the public*. " 51 CCPA at 1259, 329 F.2d at 1011, 141 USPQ at 249.

While *In re Le Grice* was bottomed on an issue arising under 35 U.S.C. 102 where the reference was a "printed publication," that test, in our view, is also properly applicable to issues arising under 35 U.S.C. 103. See *In re Brown*, supra (pertinent portion quoted above); *Deutsche Gold-Und Silber-Scheideanstalt v. Commissioner*, 251 F.Supp. 624, 629-630, 148 USPQ 412, 416 (D.D.C. 1966), affirmed, \_\_F.2d\_\_, 157 USPQ 549 (D.C. Cir. 1968).

[6] Thus, upon careful reconsideration it is our view that if the prior art of record fails to disclose or render obvious a method for making a claimed compound, at the time the invention was made, it may not be legally concluded that the compound itself is in the possession of the public.<sup>8</sup> In this context, we say that the absence of a known or obvious process for making the claimed compounds overcomes a presumption that the compounds are obvious, based on close relationships between their structures and those of prior art compounds.

The second aspect of the questions presented by this rehearing involves the issue of whether the burden is on the Patent Office to provide the evidence on which to predicate process obviousness.

35 U.S.C. 101 states, in its preamble, that an applicant is *entitled* to a patent *unless* certain patent-defeating provisions are met. The substantive patent-defeating provisions are encompassed in 35 U.S.C. 100-103.

[7] As we have stated, the Patent Office search resulted in citation of the De Boer reference which, under the prevailing law, rendered appellant's claimed compounds *prima facie* obvious. In other words, its citation shifted to appellant the burden of going forward with contrary evidence. Appellant filed the affidavit of Dr. Wiley which points out as a fact that De Boer—the only reference being relied on—does not disclose a process for producing the different compounds here claimed.

We think that portion of the Wiley affidavit set forth, supra note 6, states facts which were legally sufficient to overcome the position of the Patent Office as to the legal effect under section 103 of the De Boer reference.<sup>9</sup> Appellant's responsibility to overcome this reference as a "patent-defeating" reference under section 103 at that point in the prosecution was only to overcome De Boer as a reference pertinent to the issue of obviousness under section 103.

We think the Wiley affidavit is clearly sufficient for this purpose. The affidavit points out that there is no indication in the De Boer patent that the fermentation process used to produce De Boer's compounds could be used to produce appellant's compounds. Since we are of the view that the method for making the compounds is an integral part of the "invention as a whole" which we must consider under section 103, we conclude that the

burden of going forward with proofs to support its position as to obviousness of the claimed invention shifted to the Patent Office upon appellant's filing of the Wiley affidavit.

The failure of the Patent Office to produce such evidence requires that the decision of the board be *reversed*.

WORLEY, Chief Judge, did not participate.

### Footnotes

Footnote 1. Claim 1 in Serial No. 30,770, filed May 23, 1960, for "9-D-Psicofuranosylpurine and 6-Substituted Derivatives." Claims 2 and 11-25 stand allowed.

Footnote 2. Patent No. 3,094,460, issued June 18, 1963 on an application filed January 20, 1959.

Footnote 3. Appellant, in effect, admits that there is such a "structural similarity" between his claimed compounds and the prior art compounds as to raise an "inference of fact" that they are not patentable within the meaning of 35 U.S.C. 103. See *In re Papesch*, 50 CCPA 1084, 315 F.2d 381, 137 USPQ 43 (1963); *In re Victor Mills*, 47 CCPA 1185, 281 F.2d 218, 126 USPQ 513 (1960).

Footnote 4. Such a showing often has been treated by this court as overcoming a case of "prima facie obviousness" or the "inference of fact" that the compounds are obvious. See, e.g., *In re Papesch*, supra note 3 and cases cited therein.

Footnote 5. For the applicability of *In re Brown*, supra, to other factual contexts, see *In re Bird*, 52 CCPA 1290, 1294, 344 F.2d 979, 982, 145 USPQ 418, 420 (1965); *In re Sheppard*, 52 CCPA 859, 864, 339 F.2d 238, 242, 144 USPQ 42, 45 (1964); *Dix-Seal Corp. v. New Haven Trap Rock Co.*, 236 F.Supp. 914, 921, 144 USPQ 57, 64 (D.C. Conn. 1964).

Footnote 6. After setting forth his qualifications and stating that he had read and understood both appellant's application and the prior art patent, Dr. Wiley stated:

THAT, 6-amino-9-D-psicofuranosylpurine is a systematic name for "psicofuranine" which is disclosed in column 6, lines 46-62 of the aforesaid patent;

THAT, according to the aforesaid patent, 6-amino-9-D-psicofuranosylpurine is produced by a fermentation process involving the action of a specific micro-organism, *S. hygroscopicus* var. *decoyinine*, in certain aqueous nutrient media;

THAT, *there is no indication in the aforesaid patent [De Boer] that the aforesaid fermentation process could be used to produce 6-lower-alkylamino-9-D-psicofuranosylpurines, 6-di-lower-alkylamino-9-D-psicofuranosylpurines, or other 6-substituted-amino-9-D-psicofuranosylpurines;*

THAT, he does not believe the aforesaid fermentation process could be adapted to the production of the aforesaid 6-lower-alkylamino-9-D-psicofuranosylpurines, 6-di-lower-alkylamino-9-D-psicofuranosylpurines, or other 6-substituted-amino-9-D-psicofuranosylpurines;

THAT, *the aforesaid 6-amino-9-psicofuranosylpurine could not be transformed by direct chemical substitution of the 6-amino group to a 6-lower-alkylamino-9-D-psicofuranosylpurine, a 6-di-lower alkylamino-9-D-*

psicofuranosylpurine, or other 6-substituted-amino-9-D-psicofuranosylpurines, *and that such transformations could be carried out only by a complex multi-step procedure such as that described in the aforesaid patent application Serial No. 30,770.* [Emphasis added.]

Footnote 7. To this extent, appellant has misstated his argument. That process obviousness is relevant in this context is clear from *In re Riden*, supra. See also *In re Chapman*, 53 CCPA 978, 357 F.2d 418, 148 USPQ 711 (1966); *In re Burt*, 53 CCPA 929, 356 F.2d 115, 148 USPQ 548 (1966); *In re Schechter*, 40 CCPA 1009, 205 F.2d 185, 98 USPQ 144 (1963).

We think appellant really means to say that the question is whether a claimed compound may be said to be legally obvious when no process for making that compound is shown in the prior art relied upon to establish legal obviousness under section 103.

Footnote 8. In *Phillips Petroleum v. Ladd*, 219 F.Supp. 366, 138 USPQ 421 (D.D.C. 1963), in considering a rejection arising under 35 U.S.C. 102, the District Court agreed with this court that the mere naked statement of the invention does not put anyone in possession of the invention. That court was careful to note that no process had been shown in the reference for preparing the compound and that no process was known to one of ordinary skill in the art for preparing the compound.

In *Ex parte Wall*, 156 USPQ 95 (P.O. Bd. App. 1964), the board considered a rejection under 35 U.S.C. 102 of a claim reading "Perfluorostyrene." In reversing the examiner, the board commented that the examiner did not contend that the reference disclosed how perfluorostyrene is made, nor did he point to any extraneous evidence which would indicate that those skilled in the art knew how to make that compound.

Footnote 9. We think this approach to be eminently fair to all parties and in accord with the opinion of the Supreme Court in *Graham*, in its requiring that all of the pertinent evidence be considered while yet leaving the primary responsibility for sifting out unpatentable material with the Patent Office, *Graham v. John Deere Co.*, 383 U.S. 1 at 18, 148 USPQ at 467.

It would be practically impossible for an applicant to show that all known processes are incapable of producing the claimed compound.

### **Dissenting Opinion Text**

#### **Dissent By:**

KIRKPATRICK, Judge, dissenting.

I am unable to agree with the result reached by the majority. The reasons for my dissent appear in the overruled opinion *In re Hoeksema*, 54 CCPA 1618, 379 F.2d 1007, 154 USPQ 169 (1967).

Footnote \* Senior District Judge, Eastern District of Pennsylvania, sitting by designation.

- End of Case -

the *Graham* factual inquiries. It should be noted that the Supreme Court's application of the *Graham* test to the fact circumstances in *Ag Pro* was somewhat stringent, as it was in *Black Rock*. Note *Republic Industries, Inc. v. Schlage Lock Co.*, 592 F.2d 963, 200 USPQ 769 (7th Cir. 1979). The Court of Appeals for the Federal Circuit stated in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1540, 218 USPQ 871, 880 (Fed. Cir. 1983) that

A requirement for "synergism" or a "synergistic effect" is nowhere found in the statute, 35 U.S.C. When present, for example in a chemical case, synergism may point toward nonobviousness, but its absence has no place in evaluating the evidence on obviousness. The more objective findings suggested in *Graham*, supra, are drawn from the language of the statute and are fully adequate guides for evaluating the evidence relating to compliance with 35 U.S.C. § 103. *Bowser Inc. v. United States*, 388 F.2d 346, 156 USPQ 406 (Cl. Ct. 1967).

### BASIC CONSIDERATIONS WHICH APPLY TO OBVIOUSNESS REJECTIONS

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole;

(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

(D) Reasonable expectation of success is the standard with which obviousness is determined.

*Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

### OBJECTIVE EVIDENCE MUST BE CONSIDERED

Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence. The weight to be accorded to the evidence depends on the individual

factual circumstances of each case. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987). The ultimate determination on patentability is made on the entire record. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

See MPEP § 716- § 716.06 for a discussion of objective evidence and its role in the final legal determination of whether a claimed invention would have been obvious under 35 U.S.C. 103.

## 2141.01 Scope and Content of the Prior Art

### I. PRIOR ART AVAILABLE UNDER 35 U.S.C. 102 IS AVAILABLE UNDER 35 U.S.C. 103

"Before answering *Graham's* 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987). Subject matter that is prior art under 35 U.S.C. 102 can be used to support a rejection under section 103. *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981) ("it appears to us that the commentator [of 35 U.S.C.A.] and the [congressional] committee viewed section 103 as including all of the various bars to a patent as set forth in section 102.").

A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date. For instance, an obviousness rejection over a U.S. patent which was issued more than 1 year before the filing date of the application is said to be a statutory bar just as if it anticipated the claims under 35 U.S.C. 102(b). Analogously, an obviousness rejection based on a publication which would be applied under 102(a) if it anticipated the claims can be overcome by swearing behind the publication date of the reference by filing an affidavit or declaration under 37 CFR 1.131.

For an overview of what constitutes prior art under 35 U.S.C. 102, see MPEP § 901 - § 901.06(d) and § 2121 - § 2129.



## II. SUBSTANTIVE CONTENT OF THE PRIOR ART

See MPEP § 2121 - § 2129 for case law relating to the substantive content of the prior art (e.g., availability of inoperative devices, extent to which prior art must be enabling, broad disclosure rather than preferred embodiments, admissions, etc.).

## III. CONTENT OF THE PRIOR ART IS DETERMINED AT THE TIME THE INVENTION WAS MADE TO AVOID HINDSIGHT

The requirement "at the time the invention was made" is to avoid impermissible hindsight. See MPEP § 2145, paragraph X.A. for a discussion of rebutting applicants' arguments that a rejection is based on hindsight.

"It is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

## IV. 35 U.S.C. 103(c) — EVIDENCE REQUIRED TO SHOW CONDITIONS OF 35 U.S.C. 103 APPLY

An applicant who wants to avail himself or herself of the benefits of 35 U.S.C. 103(c) has the burden of establishing that subject matter which qualifies as prior art under subsection (e), (f) or (g) of section 102 and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. *Ex parte Yoshino*, 227 USPQ 52 (Bd. Pat. App. & Inter. 1985). Note that for applications filed prior to November 29, 1999, 35 U.S.C. 103(c) is limited on its face to subject matter developed by another person which qualifies as prior art only under subsection (f) or (g) of section 102. See MPEP § 706.02(l)(1). See also *In re Bartfeld*, 925 F.2d 1450, 1453-54, 17 USPQ2d 1885, 1888 (Fed. Cir. 1991) (Applicant attempted to overcome a 35 U.S.C. 102(e)/103 rejection

with a terminal disclaimer by alleging that the public policy intent of 35 U.S.C. 103(c) was to prohibit the use of "secret" prior art in obviousness determinations. The court rejected this argument, holding "We may not disregard the unambiguous exclusion of § 102(e) from the statute's purview.").

See MPEP § 706.02(l)(2) for the requirements which must be met to establish common ownership.

## 2141.01(a) Analogous and Nonanalogous Art

### TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT MUST BE ANALOGOUS PRIOR ART

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); and *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

### PTO CLASSIFICATION IS SOME EVIDENCE OF ANALOGY, BUT SIMILARITIES AND DIFFERENCES IN STRUCTURE AND FUNCTION CARRY MORE WEIGHT

While Patent Office classification of references and the cross-references in the official search notes are some evidence of "nonanalogy" or "analogy" respectively, the court has found "the similarities and differences in structure and function of the inventions to carry far greater weight." *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) (The structural similarities and functional overlap between the structural gratings shown by one reference and the

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**In re WESSLAU**  
**(CCPA)**  
**147 USPQ 391**  
**Decided Nov. 26, 1965**  
**Appl. No. 7447**  
**U.S. Court of Customs and Patent Appeals**

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**Headnotes**

**PATENTS**

**1. Patentability--Composition of matter (§ 51.30)**

Claims to process of polymerizing ethylene are not rejected on theory that applicant's catalyst system can be met merely by substitution of groups from two prior patents on the corresponding components of a third prior system since no one of the references suggests such a substitution, quite apart from the result which would be obtained thereby; such piecemeal reconstruction of prior art patents in light of applicant's disclosure is contrary to 35 U.S.C. 103.

**2. Patentability--Invention--In general (§ 51.501)**

Question in cases within ambit of 35 U.S.C. 103 is whether subject matter as a whole would have been obvious to one of ordinary skill in the art following teachings of prior art at time invention was made; it is impermissible within framework of section 103 to choose from any one reference only so much of it as will support a given position, to exclusion of other parts necessary to full appreciation of what reference fairly suggests to one of ordinary skill in the art.

**Particular patents--Polyethylene**

Wesslau, Process for the Production of Polyethylene with Narrow Distribution of the Molecular Weight, claims 35 to 43 of application allowed.

**Case History and Disposition:**

**Appeal from Board of Appeals of the Patent Office.**

**Application for patent of Hermann Wesslau, Serial No. 753,872, filed Aug. 8, 1959; Patent Office Group 140. From decision rejecting claims 35 to 43, applicant appeals. Reversed.**

**Attorneys:**

**ARNOLD SPRUNG, New York, N.Y., and ARNOLD B. CHRISTEN, Washington, D. C., for appellant.**

**CLARENCE W. MOORE (FRED W. SHERLING of counsel) for Commissioner of Patents.**

**Judge:**

**Before WORLEY, Chief Judge, and RICH, MARTIN, SMITH, and ALMOND, Associate Judges.**

**Opinion Text****Opinion By:**

**ALMOND, Judge.**

This appeal is from the decision of the Board of Appeals affirming the rejection of claims 35-43 <sup>1</sup> in appellant's application <sup>2</sup> entitled "Process for the Production of Polyethylene With Narrow Distribution of the Molecular Weight." No claims have been allowed.

The invention relates to a process of polymerizing ethylene utilizing a Ziegler-type catalyst system to produce solid polyethylene. Both appellant and the Patent Office have treated the appealed process claims as standing or falling together, and we will do the same. Claim 35, from which the remaining claims depend, is illustrative and reads as follows:

35. In the process of polymerizing ethylene to a solid polymer having a high molecular weight and a narrow molecular weight distribution range, the improvement which comprises polymerizing ethylene in the presence of a polymerization catalyst con

sisting essentially of a mixture of titanium trichloride, at least one compound of tetravalent titanium  $Ti(R)_4$  and at least one organic aluminum compound soluble in a liquid hydrocarbon and having the general formula  $R'Al(R)_2$  in which  $R'$  is alkyl and  $R$  is selected from the group consisting of halogen, alkoxy and aroxy radicals, wherein between said tetravalent titanium compound and said organic aluminum compound there is present in said mixture at least one halogen atom

and at least one member selected from the group consisting of alkoxy and aroxy radicals.

According to appellant's disclosure, polyethylene of high molecular weight may be produced by what has become known in the art as the Ziegler polymerization process. Analysis of the polyethylene so produced has revealed that although the *average* molecular weight of the polymer is high, a fairly large proportion of the individual polymer chains have a relatively low molecular weight. These low molecular weight fractions are particularly unfavorable for such properties as impact bending strength, rubbing, and fatigue. Appellant has discovered that the proportion of the lower molecular weight chains can be reduced, thereby narrowing the molecular weight distribution, by employing a three-component catalyst system in which either the  $Ti(R)_4$  or  $R'Al(R)_2$  contains an alkoxide or aroxide moiety.

The references relied on are:

Anderson 2,862,917 December 2, 1958

Muehlbauer 2,905,661 September 22, 1959

Ruhrchemie (Belgian) 553,694 June 24, 1957

The Ruhrchemie patent relates to a process for producing polyethylene of a desired molecular weight employing certain specified catalyst systems. The pertinent portion of the patent specification reads as follows:

\*\*\* when high molecular weight [polyethylene] products are to be obtained \*\*\*, the employed mixtures consist of aluminum alkyl compounds and/or halides of aluminum alkyl with quantities of titanium trichloride of at least 0.01 mole \*\*\* and quantities of titanium tetrachloride lower than 0.01 mole \*\*\*; on the other hand, when materials having low molecular weight are to be obtained the employed mixtures consist of aluminum alkyl and/or halide of aluminum alkyl with more than 0.1 mole \*\*\* of titanium tetrachloride per mole of aluminum alkyl and/or halide of aluminum alkyl, and with titanium trichloride at the rate of at least 0.1 mole, preferably 0.3-1 mole approximately per mole of aluminum alkyl and/or halide of aluminum alkyl.

The Anderson patent relates to a process of polymerizing ethylene whereby control over the weight average molecular weight of the polymer and the *molecular weight distribution* of the polymer is achieved by adhering to process conditions which insure the solubility of the ethylene during polymerization. The process employs coordination catalysts of titanium:

\*\*\* obtained by admixing a trivalent or tetravalent titanium compound of the class consisting of titanium salts and titanium alkoxides with a compound having at least one metal-to-hydrocarbon bond, such as metal alkyls, suitable compounds being lithium aluminum alkyls, aluminum alkyls, Grignard reagents, alkyl aluminum halides, tin alkyls, etc. \*\*\*

Anderson further states:

\*\*\* the steady state compliance [an indicia of molecular weight distribution] will vary from 3 to 7 when the critical conditions of the process of the present invention are maintained and will rise to a range of 12 to 28 when the polymerization is carried out at conditions other than required by the process of the present invention. \*\*\*

Muehlbauer relates to a process for producing high molecular weight polyolefins

employing a two-component catalyst system consisting of certain metal halides and a compound of the formula  $\text{XAlR(OR')}$ , where X is halogen, and R and R' are the same or different alkyl, cycloalkyl, or aryl radicals. Titanium trichloride and titanium tetrachloride are specifically disclosed as suitable metal halides.

The sole issue in this case is obviousness under 35 U.S.C. 103.

Appellant's principal contention is that:

\* \* \* since none of the reference[s] either singly or in combination teach a control of the molecular weight distribution range by specific selection of catalyst components, or even that the nature or composition of the catalyst could have an effect on this molecular weight distribution range, the subject matter of the invention as a whole could not possibly be obvious from the references. \* \* \*

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We agree. Appellant's specification contains ten examples in which various three-component catalyst systems were utilized in the polymerization of ethylene. The systems set forth in three of these examples consisted of (1) titanium trichloride, (2) titanium tetrachloride, and (3) diethyl aluminum monochloride in various molar ratios. These fall within the catalyst systems disclosed by Ruhrchemie. The U value, which according to appellant's specification is a measure of the molecular weight distribution, ranges from 6.3 to 12.8 for such catalysts. In the remaining seven examples, catalyst systems covered only by the appealed claims were employed, with the nonuniformity value  $U^3$  for the resultant polyethylene ranging from 2.6 to 3.9. We believe this to be a convincing demonstration that the alkoxide or aroxide moiety, when present in the catalyst systems of the appealed claims, possesses the property of conferring a significant degree of control over the ultimate molecular weight distribution of polyethylene. This property is neither taught nor suggested by the prior art.

The reasoning of the examiner and the board appears to be as follows: Ruhrchemie discloses a titanium trichloride - titanium tetrachloride - mono - ethyl aluminum dichloride system. This differs from appellant's system only in the latter's use of an alkoxide or aroxide group on either the tetravalent titanium or aluminum component or both. Since Anderson shows a tetravalent titanium compound containing an alkoxide group and Muehlbauer shows an aluminum compound containing an alkoxide group, appellant's catalyst system can be met merely by substitution of such alkoxide groups on the corresponding components of the Ruhrchemie system.

[1] The fallacy of this reasoning is that no one of the references *suggests* such a substitution, quite apart from the result which would be obtained thereby. Such piecemeal reconstruction of the prior art patents in the light of appellant's disclosure is contrary to the requirements of 35 U.S.C. 103. In *re Rothermel*, 47 CCPA 866, 276 F.2d 393, 125 USPQ 328.

[2] The ever present question in cases within the ambit of 35 U.S.C. 103 is whether the subject matter as a whole would have been obvious to one of ordinary skill in the art following the *teachings* of the prior art at the time the invention was made. It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of

ordinary skill in the art. The Anderson patent is the only reference before us which recognizes the desirability of producing polyethylene with a narrow molecular weight distribution range. Were one to follow the teachings of that patent in its entirety, he would be led to believe that control over the molecular weight distribution of polyethylene was gained independently of the catalyst system, a belief untenable in light of appellant's disclosure.

Both the board and the solicitor apparently assert the position that it is incumbent upon appellant to show that his results are outstanding as compared with the results accomplished by Anderson and Muehlbauer. If this is construed as requiring appellant to show unexpected results accruing from his claimed process, we think he has met the requirement. We perceive no teaching in the prior art of record suggesting that an alkoxide or aroxide moiety in a Ziegler-type catalytic system would produce the results obtained by appellant's process.

The decision of the board is *reversed*.

### Footnotes

Footnote 1. Appellant withdrew the appeal with respect to the only product claim 44, which was drawn to a polyethylene having a narrow molecular weight distribution characterized by a nonuniformity value U of magnitude between 2 and 4.

Footnote 2. Serial No. 753,872, filed August 8, 1958.

Footnote 3. Appellant's specification contains the following description of the nonuniformity value U:

\* \* \* the so-called non-uniformity is used for characterising the range of distribution of the molecular weights. According to G. V. Schulz in H. A. Stuart's *Die Physik der Hochpolymeren*, 2nd vol., the macromolecule in solutions is given on page 754 as:

*Graphic material consisting of a complex mathematical formula set at this point is not available. See text in hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

$\bar{M}_w$  and  $\bar{M}_n$  can be calculated from the molecular weight distribution by current methods (G. V. Schulz and M. Marx: *Makromolekulare Chemie* XIV (1954), pages 53-64).

- End of Case -

**FULL TEXT OF CASES (USPQ2D)**

All Other Cases

**In re Oetiker (CA FC) 24 USPQ2d 1443 In re Oetiker**

U.S. Court of Appeals Federal Circuit  
24 USPQ2d 1443

**Decided October 13, 1992****No. 91-1026****Headnotes****PATENTS****1. Practice and procedure in Patent and Trademark Office -- Prosecution -- In general (§ 110.0901)****Patentability/Validity -- Obviousness -- In general (§ 115.0901)**

"Prima facie" case is procedural tool of patent examination which allocates burdens of going forward as between examiner and applicant; examiner bears initial burden, on review of prior art or on any other ground, of presenting prima facie case of unpatentability, and if that burden is met, burden of coming forward with evidence or argument shifts to applicant, and after applicant submits such evidence in response, patentability is determined on totality of record, by preponderance of evidence with due consideration to persuasiveness of argument.

**2. Practice and procedure in Patent and Trademark Office -- Board of Patent Appeals and Interferences -- In general (§ 110.1101)**

Board of Patent Appeals and Interferences, in reviewing examiner's decision on appeal, must necessarily weigh all evidence and argument, and board's observation that examiner made prima facie case of unpatentability is not improper, as long as ultimate

determination of patentability is made on entire record.

**3. Practice and procedure in Patent and Trademark Office -- Prosecution -- In general (§ 110.0901)**

**Patentability/Validity -- Obviousness -- In general (§ 115.0901)**

Concept of "prima facie" case of obviousness, which places initial burden on examiner, is of broad applicability and is not limited to chemical practice; that prima facie case may be established, or rebutted, by different forms of evidence in various technologies does not restrict concept to any particular field of technology.

**4. Patentability/Validity -- Obviousness -- Relevant prior art -- In general (§ 115.0903.01)**

**Patentability/Validity -- Obviousness -- Combining references (§ 115.0905)**

Prior art reference, in order to be relied upon as basis for rejecting applicant's invention, must either be in field of applicant's endeavor or, if not, be reasonably pertinent to particular problem with which inventor was concerned; combination of elements from non-analogous sources, in manner that reconstructs applicant's invention only with benefit of hindsight, is insufficient to present prima facie case of obviousness.

**5. Patentability/Validity -- Obviousness -- In general (§ 115.0901)**

Simplicity of invention is not itself inimical to patentability.

**Case History and Disposition:**

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**Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.**

**Application for patent, no. 06/942,694, filed by Hans Oetiker. From decision holding claims unpatentable, applicant appeals. Reversed; Nies, C.J., and Plager, J., concurring in separate opinions.**

**Attorneys:**

**Paul M. Craig, Jr., Washington, D.C., for appellant.**

**John W. Dewhirst (Fred E. McKelvey, solicitor and Robert D.**



**Edmonds, associate solicitor, with him on brief), for appellee.**

**Judge:**

**Before Nies, chief judge, and Newman and Plager, circuit judges.**

### **Opinion Text**

**Opinion By:**

**Newman, J.**

Hans Oetiker appeals the decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences, holding unpatentable claims 1-14 and 6-21, all of the claims in patent application No. 06/942,694. 1 Oetiker appeals on procedural and substantive grounds.

### **I PROCEDURE Background**

All of the claims were finally rejected for obviousness in terms of 35 U.S.C. Section 103. The

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Board, upholding the rejection, stated that "the examiner has . . . established a *prima facie* case of obviousness . . . which is unrebutted by any objective evidence of nonobviousness". Oetiker stated that this Board holding was the first rejection of his claims for being "*prima facie* obvious", and filed rebuttal evidence with a petition for reconsideration. The Board declined to consider the new evidence or change its decision. Oetiker states that a holding of *prima facie* obviousness means, in patent examination, that the claimed invention is subject to a rebuttable presumption of obviousness; that is, if the applicant can provide evidence or argument in support of unobviousness, such evidence and argument will be considered, and the question of patentability will be redetermined on the entire record. Oetiker states that a rejection made in the words "*prima facie* obvious" is understood by patent examiners and practitioners as an invitation to provide such rebuttal evidence.

Thus Oetiker argues that a holding by the Board of *prima facie* obviousness is a new ground of rejection, for during prosecution the examiner did not reject the claims in these words. Treating it as such, Oetiker offered affidavit evidence not previously filed, and requested reconsideration on the basis of this new evidence, or remand to the examiner for this purpose, in accordance with 37 C.F.R. Section 1.196(b):

Section 1.196(b) . . . When the Board . . . makes a new rejection of an appealed claim, the appellant may exercise either of the following two options . . . :

- (1) The appellant may submit . . . a showing of facts . . . and have the matter reconsidered by the examiner in which event the application will be remanded to the examiner. . . .
- (2) The appellant may have the case reconsidered under Section 1.197(b) by the Board . . . upon the same record.

The Board on reconsideration granted neither of the options of Section 1.196(b), stating that it had not made a new rejection.

At argument before this court the Commissioner's counsel suggested that Oetiker could refile his patent application, pay a new fee, and obtain review of this new evidence in a new examination. Oetiker states that he was entitled to a complete examination, and did not get it.

### Discussion

[1] The *prima facie* case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant. *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir. 1990). The term " *prima facie* case" refers only to the initial examination step. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.

After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument. See *In re Spada*, *supra*; *In re Corkill*, 771 F.2d 1496, 1500, 226 USPQ 1005, 1008 (Fed. Cir. 1985); *In re Caveny*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985); *In re Johnson*, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984).

If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. See *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985); *In re Rinehart*, *supra*.

[2] In reviewing the examiner's decision on appeal, the Board must necessarily weigh all of the evidence and argument. An observation by the Board that the examiner made a *prima facie* case is not improper, as long as the ultimate determination of patentability is made on the entire record. *In re Piasecki*, 745 F.2d at 1472, 223 USPQ at 788; *In re Rinehart*, 531 F.2d at 1052, 189 USPQ at 147.

The record here reveals that the application was fully prosecuted. References were cited and applied by the examiner, the applicant responded with argument, and the examiner then issued a final rejection, stating why he was not persuaded by the applicant's argument. On review the Board stated that its decision was reached "after careful consideration of the appealed claims, the evidence of obviousness relied upon by the examiner and the arguments advanced by the appellant and the examiner". The Board explained why it was unpersuaded by Oetiker's arguments on appeal. We discern no irregularity in the procedure. The Board, in explaining that the examiner's rejections constituted a *prima facie* case of obviousness, did not make a new rejection.

[3] Oetiker also argues that the concept of a " *prima facie* case of obviousness" has no role outside of the chemical arts. Oetiker

refers to the origins of this term in the chemical practice, where properties may not be apparent from chemical structure. Oetiker distinguishes mechanical inventions, where the properties and workings of a mechanical device are apparent in the drawing of the

structure. We think that the PTO is correct in treating the concept of the *prima facie* case as of broad applicability, for it places the initial burden on the examiner, the appropriate procedure whatever the technological class of invention. That a *prima facie* case may be established, or rebutted, by different forms of evidence in various technologies does not restrict the concept to any particular field of technology. " [T]he requirement of unobviousness in the case of chemical inventions is the same as for other types of inventions". *In re Johnson*, 747 F.2d at 1460, 223 USPQ at 1263. This procedural tool is recognized in fields outside of the chemical arts. *E.g., In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985); *In re McCarthy*, 763 F.2d 411, 226 USPQ 99 (Fed. Cir. 1985); *In re De Blauwe*, 736 F.2d 699, 222 USPQ 191 (Fed. Cir. 1984).

The Board's usage of the term *prima facie* was imprecise for, as discussed *supra*, the term "*prima facie* obvious" relates to the burden on the examiner at the initial stage of the examination, while the conclusion of obviousness *vel non* is based on the preponderance of evidence and argument in the record. However, it was clear that the Board did not make a new rejection. Therefore the Board did not err in declining to consider at that stage the proffered evidence of commercial success.

## II THE MERITS

Oetiker's invention is an improvement in a "stepless, earless" metal clamp, a hose clamp that was generally described in an earlier '004 patent of Oetiker, but that differs in the presence of a feature that is described as a preassembly "hook". This "hook" serves both to maintain the preassembly condition of the clamp and to be disengaged automatically when the clamp is tightened.

The cited references were Oetiker's earlier-granted '004 patent, combined with a certain Lauro '400 patent. Lauro describes a plastic hook and eye fastener for use in garments, in which "unitary tabs of sewing needle puncturable plastic material . . . are affixable to clothing and the like by sewing". Oetiker argues that there is no suggestion or motivation to the artisan to combine the teachings of the cited references, and that Lauro is nonanalogous art. Oetiker concludes that these references were improperly combined; that a person of ordinary skill, seeking to solve the problem facing Oetiker, would not look to the garment art for the solution. Oetiker also argues that even if combined the references do not render the claimed combination obvious.

The examiner stated that "since garments commonly use hooks for securement", a person faced with the problem of unreliable maintenance of the pre-assembly configuration of an assembly line metal hose clamp would look to the garment industry art. The examiner explained further by stating that "Appellant's device as disclosed could be utilized as part of a garment". The Board did not repeat or support the examiner's argument, or discuss its relevance. Indeed, the argument is not supportable. However, the Board held that the Lauro reference, although not "within the appellant's specific field of endeavor" is nonetheless "analogous art" because it relates to a hooking problem, as does Oetiker's invention.

The Board apparently reasoned that all hooking problems are analogous. At least, that is the argument now pressed by the Commissioner. The Commissioner states in his brief on appeal that "A disengageable catch, such as that used by Oetiker, is a common everyday mechanical concept that is variously employed in door latches and electrical and other switches, as well as in the hook and eye apparatus disclosed by Lauro". No such

references were cited, however. While this court may take judicial notice of common everyday mechanical concepts in appropriate circumstances, the Commissioner did not explain why a "catch" of unstated structure in an electrical switch, for example, is such a concept and would have made Oetiker's invention obvious. Indeed, the Commissioner did not respond to Oetiker's argument that the cited references provide no teaching or suggestion that Lauro's molded hook and eye fastener, even if combined with Oetiker's '004 clamp, would achieve Oetiker's purpose.

[4] In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *See In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986). Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably

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be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) -- in other words, common sense -- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147, 227 USPQ 543, 551 (Fed. Cir. 1985).

[5] Oetiker's invention is simple. Simplicity is not inimical to patentability. *See Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 279, 60 USPQ 386, 388 (1944) (simplicity of itself does not negative invention); *Panduit Corp. v. Dennison Mfg Co.*, 810 F.2d 1561, 1572, 1 USPQ2d 1593, 1600 (Fed. Cir.) (the patent system is not foreclosed to those who make simple inventions), *cert. denied*, 481 U.S. 1052 (1987). We conclude that the references on which the Board relied were improperly combined. Accordingly, the Board erred in holding the claims unpatentable under section 103. The rejection of claims 1-4 and 16-21 is *REVERSED*.

### Footnotes

Footnote 1. *Ex parte Oetiker*, No. 89-2230 (Bd. Pat App. & Interf. May 31, 1990; on

reconsideration, August 23, 1990).

### Concurring Opinion Text

Concur By:

Nies, C.J., concurring.

I agree with the panel decision and write only to express my understanding of the language that there must be some teaching, reason, suggestion, or motivation found "in the prior art" or "in the prior art references" to make a combination to render an invention obvious within the meaning of 35 U.S.C. Section 103 (1988). Similar language appears in a number of opinions and if taken literally would mean that an invention cannot be held to have been obvious unless something specific in a prior art reference would lead an inventor to combine the teachings therein with another piece of prior art.

This restrictive understanding of the concept of obviousness is clearly wrong. Other statements in opinions express the idea more generally. We have stated, for example, that the test is: "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention," *In re Gorman*, 933 F.2d at 986, 18 USPQ2d at 1888, and "what the combined teachings . . . would have suggested to one of ordinary skill in the art," *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). We have also stated that "the prior art as a whole must suggest the desirability . . . of making the combination." *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

I believe that it would better reflect the concept of obviousness to speak in terms of "from the prior art" rather than simply "in the prior art." The word "from" expresses the idea of the statute that we must look at the obviousness issue through the eyes of one of ordinary skill in the art and what one would be presumed to know with that background. What would be obvious to one of skill in the art is a different question from what would be obvious to a layman. An artisan is likely to extract more than a layman from reading a reference.

In any event, variance in the language used in opinions does not change the nature of the statutory inquiry. Under section 103, subject matter is unpatentable if it "would have been obvious . . . to a person having

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ordinary skill in the art." While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination. *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988). Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same or similar problem which it addresses. *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA

1979). *See, also, EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 906-07, 225 USPQ 20, 25 (Fed. Cir.), *cert. denied*, 474 U.S. 843 (1985); *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). *See also, Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) ("To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.").

In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference.

### Footnotes

Footnote 1. *See, e.g., Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569, 19 USPQ2d 1241, 1246 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 989, 18 USPQ2d 1885, (Fed. Cir. 1991); *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, (Fed. Cir. 1990); *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988); *In re Stencel*, 828 F.2d 751, 755, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *In re Grabiak*, 769 F.2d 729, 732, 226 USPQ 870, 872 (Fed. Cir. 1985).

### Concurring Opinion Text

**Concur By:**

**Plager, J., concurring.**

I join in the carefully-reasoned and well-written opinion of Judge Newman. With regard to Part I dealing with the PTO procedure, her explanation of the meaning and application of the 'prima facie case' concept should help clarify an area that remains marked by a lack of clarity. The need for that discussion, however, illustrates the pitfalls of the 'prima facie' practice of the PTO, and the difficulties created by this particular legalistically convoluted concept.

An applicant for a patent is entitled to the patent unless the application fails to meet the requirements established by law. It is the Commissioner's duty (acting through the examining officials) to determine that all requirements of the Patent Act are met. The burden is on the Commissioner to establish that the applicant is not entitled under the law to a patent. *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). In rejecting an application, factual determinations by the PTO must be based on a preponderance of the evidence, and legal conclusions must be correct. *In re Caveney*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985).

The process of patent examination is an interactive one. *See generally*, Chisum, *Patents*, Section 11.03 *et seq.* (1992). The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection

harbored by the examiner. The 'prima facie case' notion, the exact origin of which appears obscure ( *see In re Piasecki*, 745 F.2d 1468, 1472, 233 USPQ 785, 788 (Fed. Cir. 1984)), seemingly was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument. To that extent the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness.

But the ultimate decision that must be made by the PTO in the examination process, and by this court on appeal, is not whether a prima facie case for rejection was made; the only question is whether, on the whole record, the applicant has met the statutory requirements for obtaining a patent. When a final rejection is described in terms of whether a prima facie case was made, that intermediate issue diverts attention from what should be the question to be decided.

Specifically, when obviousness is at issue, the examiner has the burden of persuasion and therefore the initial burden of production. Satisfying the burden of production, and thus initially the burden of persuasion, constitutes the so-called prima facie showing. Once that burden is met, the applicant has the burden of production to demonstrate that the examiner's preliminary determination is not correct. The examiner, and if later involved, the Board, retain the ultimate burden of persuasion on the issue.

If, as a matter of law, the issue is in equipoise, the applicant is entitled to the patent. Thus on appeal to this court as in the PTO, the applicant does not bear the ultimate burden of persuasion on the issue. In the end there is no reason there or here to argue over whether a 'prima facie' case was made out. The only determinative issue is whether the record as a whole supports the legal conclusion that the invention would have been obvious.

- End of Case -

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**In re ELLIS**  
**(CCPA)**  
**177 USPQ 526**  
**Decided Apr. 26, 1973**  
**No. 8860**  
**U.S. Court of Customs and Patent Appeals**

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**Headnotes**

**PATENTS**

**1. Patentability — New use or function — Analogous art (§ 51.553)**

**Patentability — New use or function — Nonanalogous art (§ 51.557)**

While diverse Patent Office classification of references is some evidence of nonanalogy and while cross-reference in official search notes is some evidence of analogy, similarities and differences in structure and function of inventions disclosed in references carry greater weight.

**Particular patents—Grating**

Ellis, Floor Grating, claims 1 to 5 of application refused.

**Case History and Disposition:**

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**Appeal from Board of Appeals of the Patent Office.**

Application for patent of William L. Ellis, Serial No. 618,203, filed Feb. 23, 1967; Patent Office Group 356. From decision rejecting claims 1 to 5, applicant appeals. Affirmed.

**Attorneys:**

**FRANCIS D. THOMAS, JR., Washington, D.C., for appellant.**



**S. WM. COCHRAN (JOHN W. DEWHIRST of counsel) for  
Commissioner of Patents.**

**Judge:**

Before MARKEY, Chief Judge, RICH, BALDWIN, and LANE, Associate Judges,  
and WATSON, Judge, United States Customs Court, sitting by designation.

**Opinion Text**

**Opinion By:**

**BALDWIN, Judge.**

This appeal is from the decision of the Patent Office Board of Appeals, sustaining the examiner's rejection of claims 1-5, all the claims in appellant's application. <sup>1</sup>

**The Invention**

The claimed invention relates to floor gratings, and can be sufficiently understood from a reading of claim 1 with reference to appellant's Figure 3:

*Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

1. A floor grating, comprising: a plurality of main support members [12], a plurality of secondary support bars [16] supported by said members and extending in fixed parallel spaced relation therebetween,

a plurality of closely spaced wire rod members [18] secured to said secondary load bearing support bars and extended in parallel relation transversely thereacross for providing a walking surface thereover,

said secondary load bearing support bars being sufficiently deep and closely spaced to support said wire rod members for pedestrian traffic without undue flexing therebetween,

and said wire rod members being spaced in the order of  $\frac{1}{4}$  inch or less apart and having an exposed upper surface area more than one-half the open spacing therebetween for providing a substantially contiguous walking surface for pedestrian traffic thereover and the passage of snow and dirt therethrough.

Claim 2 requires that the wire rod members be tapered, to more readily pass dirt and debris. Claims 3-5 differ from claim 2 in respects unnecessary to describe in detail here.

**The Rejection**

The claims were rejected under 35 U.S.C. 103 as being unpatentable over a patent to Schulz <sup>2</sup> in view of a patent to Trixner. <sup>3</sup> Schulz deals with structural gratings which may be used for ceilings, walls, flooring for bridges, etc. While most of Schulz's gratings are filled with concrete in use, Schulz discloses an alternate opening grating not filled with concrete in Figure 8, page 527.

Trixner deals with non-clogging shoe scrapers. The application states:

*Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

The scraper is advantageously constructed so that the gaps cannot be clogged and the individual cleaning elements can be easily removed and replaced, which greatly facilitates cleaning after extensive use and removal of worn individual scraper elements. According to the invention this result is obtained by detachably inserting the channel-shaped rods which receive the rubber elements in corresponding slots in the flat perpendicular rods, and by providing the scraper elements, made of rubber or the like, with a cross section which is tapered from the surface downward.

One embodiment of the scraper is shown in Figure 3:

*Tabular, graphic, or textual material set at this point is not available. Please consult hard copy or call BNA PLUS at 1-800-452-7773 or 202-452-4323.*

The examiner considered that it would have been obvious to closely space the wire rod members of Schulz in view of the Trixner patent. The board affirmed, stating:

It is a matter of notorious knowledge that floor gratings are made with their bars sufficiently close to permit easy walking thereon, such as not to permit woman's narrow heels to be caught therein. In our opinion, the expedient of placing the cross-bars in Fig. 8 of Schulz in close proximity to each other would have been an obvious variant even on the part of persons with less than ordinary skill in the art, particularly in view of Trixner where similar cross members 5 are spaced much closer. The precise spacing is deemed an obvious variant in degree.

\* \* \*

### Opinion

Appellant contends that the two references should not be combined because they are from non-analogous arts. Appellant contends that the Patent Office classification of Schulz's patent was in "Roads and Pavements," that the classification of Trixner's patent was under "Brushing, Scrubbing and General Cleaning," and that the skilled in the art "would not expect to find grid or grating structures which are installed in floors under the art 'Brushing, Scrubbing and General Cleaning.'" To this the Solicitor responds:

[A]ppellant is in error in his belief (Br-3) that Schulz is classified in the "Roads and Pavements" art. On the contrary, Schulz is classified with the "Static Structures" art (Class 52), in an area providing for structures having exposed surfaces for increasing friction or reducing wear caused by pedestrian traffic. Also of significance is the fact that the official search notes for this area of Class.52 direct the searcher to Class 15-238, where Trixner is classified, for related art. \* \*

[1] While we find the diverse Patent Office classification of the references to be *some* evidence of "non-analogy," and likewise find the cross-reference in the official search notes to be *some* evidence of "analogy," we consider the similarities and differences in structure and function of the inventions disclosed in the references to carry far greater weight. Cf. *In re Heldt*, 58 CCPA 701, 706-07, 433 F.2d 808, 812, 167 USPQ 676, 679 (1970). Here the structural similarities and the functional overlap between pedestrian gratings and shoe scrapers of type shown by Trixner are readily apparent. We conclude

that, at the very least, the arts to which the Schulz and Trixner patents belong are *reasonably pertinent* to the art with which appellant's invention deals. See *In re Antle*, 58 CCPA 1382, 1387, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (1971).

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We have carefully considered appellant's other arguments. However, we are convinced on the record before us that it would have been obvious for one skilled in the art to arrange the wire rod members of Schulz in closer proximity, as shown by Trixner's scraper rods, should it be desired to avoid the catching of women's heels in pedestrian gratings. Accordingly, the decision of the board is *affirmed*.

### Footnotes

Footnote 1. Serial No. 618,203, filed February 23, 1967.

Footnote 2. U. S. Patent No. 2,031,007, issued February 18, 1936.

Footnote 3. Austrian Patent No. 175,037, published May 26, 1953.

- End of Case -

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**Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.****(CA FC)****230 USPQ 416****Decided July 14, 1986****No. 85-2578****U.S. Court of Appeals Federal Circuit**

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**Headnotes****PATENTS****1. Patentability -- Invention -- In general (§ 51.501)**

Federal district court erred by holding laser-marked contact lens patent to be invalid, in view of court's failure to grant patent its statutory presumption of validity, its over-reliance upon inventor's alleged opinion as to non-obviousness, its misuse of such opinion as substitute for determining level of skill of hypothetical person of ordinary skill, its use of improper hindsight analysis, its failure to consider prior art reference in its entirety, and its erroneous reliance upon irrelevant experiments.

**2. Infringement -- Tests of -- Comparison with claim (§ 39.803)**

Federal district court erred in its finding of non-infringement of contact lens patent, since court, in considering whether accused lenses were "smooth" like patented lenses, did not construe meaning of term "smooth" by resorting to specification, but instead distorted patent's claims by assessing smoothness according to approach that exceeded level of smoothness required in claim.

**Particular patents -- Contact Lenses**

4,194,814, Fischer, McCandless, and Hager, Transparent Ophthalmic Lens Having Engraved Surface Indicia, holding of invalidity and non-infringement vacated.

**Case History and Disposition:**

**Appeal from District Court for the Northern District of California, Aguilar, J.; 226 USPQ 780 .**

**Action by Bausch & Lomb, Inc., against Barnes-Hind/Hydrocurve, Inc., and Barnes-Hind International, Inc., for patent infringement, in which defendants counterclaim for declaration of patent invalidity and non-infringement. From judgment for defendants, plaintiff appeals. Vacated and remanded.**

**Attorneys:**

**Laurence H. Pretty, and Pretty, Schroeder, Brueggemann & Clark, both of Los Angeles, Calif. (Craig S. Summers, Bernard D. Bogdin, and Howard S. Robbins, all of Rochester, N.Y., on the brief) for appellant.**

**John M. Calimafde, and Hopgood, Calimafde, Kalil, Blaustein & Judlowe, both of New York, N.Y. (Eugene J. Kalil, Dennis J. Mondolino, and Gilbert W. Rudman, all of Tuckahoe, N.Y., on the brief) for appellees.**

**Judge:**

**Before Markey, Chief Judge, Friedman, Circuit Judge, and Nichols, Senior Circuit Judge.**

**Opinion Text**

**Opinion By:**

**Nichols, Senior Circuit Judge.**

**Appellant Bausch & Lomb, Inc. filed suit in the United States District Court for the North**

**ern District of California, alleging that appellee Barnes-Hind/Hydrocurve, Inc. and Barnes-Hind International, Inc. (hereinafter Barnes-Hind) infringed patent No. 4,194,814 ('814 patent) in the manufacture and sale of its laser-marked contact lens. Barnes-Hind denied infringement and counterclaimed that the '814 patent was invalid, void, and unenforceable. In No. C-83-20283-RPA, Judge Aguilar found the patent invalid for obviousness and not infringed. We vacate and remand.**

**Appellee Barnes-Hind relied to a large extent on deposition testimony which was never introduced into evidence. Because this testimony was not in evidence, it would have been improper for us to consider it and, therefore, we did not. This eliminated much of Barnes-Hind's arguments on appeal.**

## ***Background***

### **1. The Technology**

Vision correcting contact lenses have become familiar; hard contact lenses were introduced in the early 1950's and soft lenses in 1971. Toric contact lenses, which correct for the eye condition known as astigmatism, have a similar history of usage: hard lenses from the early 1950's and soft from the first half of the 1970's. Toric lenses differ from standard contact lenses in having a prism base, *i.e.*, one edge portion of the lens is thicker. Proper prescription and fitting of toric lenses on the cornea of the eye requires alignment of a central lens axis with this prism base. Markings on the contact lens surface greatly facilitate the fitting process.

Inks and other substances have been used since the early 1950's, however, those marking procedures suffer several disadvantages: difficulty of accurate application with possible FDA disapproval; possibility of dissolution, blurring, and allergic reactions. Mechanical marking, as with a sharp scribing tool or an abrading tool such as a dental bur, is also available, but not without its problems: inaccurate and inconsistent positioning of the mark, lens damage, inadequate visibility, and the expense and time involved.

### **2. The Patent**

The '814 patent, entitled Transparent Ophthalmic Lens having Engraved Surface Indicia, discloses an engraved contact lens and provides a method of engraving using a source of high intensity electro-magnetic energy, such as a laser. The mark, not as deep as the lens is thick, is surrounded by a smooth surface of unsublimated or unaffected polymer material with the result that edges of the markings do not inflame or irritate the eyelid of the lens wearer.

The claims in suit are 1, 2, and 7. Claim 1 provides:

An ophthalmic lens adapted to be placed in direct contact with eye tissue formed of a transparent cross-linked polymer material, said lens being characterized by identifying indicia engraved in a surface thereof by subjecting said lens to a beam of radiation emerging from a laser having an intensity and wavelength at least sufficient to sublimate said polymer and form depressions in said lens surface to a depth less than the thickness of said lens, said lens having a smooth surface of unsublimated polymer material surrounding said depressions, and by varying in a predetermined manner the point at which said laser beam impinges upon said lens surfaces to engrave said identifying indicia in said lens surface.

Claim 2 depends from claim 1 with the limitation that the lens is formed by a cross-linked hydrophilic (water loving) polymer. Claim 7, a product claim, is similar to claim 1 but defines the depressions as relieved zones.

### **3. The Dispute**

In February 1976, Mr. Donald Hager, then production manager at the Milton Roy Company, a manufacturer of soft contact lenses which was purchased by appellant Bausch & Lomb in 1979, sent to Carco, Inc., a distributor of laser equipment, six soft contact lenses for laser marking. At least two lenses were successfully marked. Around September 1976, Dr. David Fisher and Mr. James A. McCandless, also of Milton Roy Company, met with Mr. Hager to debrief him on the work. Soon thereafter, Mr. Hager resigned.

Dr. Fisher and Mr. McCandless continued to work on the lens-marking system, and in

November 1977 filed an application for the patent in suit, listing themselves and Mr. Hager as inventors. Mr. Hager declined to execute the patent application, being at that time the employee of another lens manufacturing company, Sauflon International, Inc. and saying that he had not "invented anything in connection with laser marking of contact lens." He further said that he could not execute documents, under oath or otherwise, that represent the contrary. The patent and Trademark Office (PTO) initially, and on a second occasion, rejected all the claims as obvious over two prior art U.S. patents to Brucker (No. 3,833,786) (teaching the use of a laser to fenestrate, i.e., make holes, in contact lens to allow circulation of fluid through the lens) and to Caddell (No. 3,549,733) (disclosing the use of a laser to remove plastic from the surface of a printing plate to form a pattern). The PTO later issued the patent in 1980 as limited to a transparent cross-linked polymer having a smooth surface around the mark. Mr. Hager

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did sign as inventor in 1982. Meanwhile, Milton Roy commenced manufacture and marketing of laser-marked soft contact lenses in 1978.

Barnes-Hind's predecessor, Continuous Curve, Inc., introduced under the trademark HYDROCURVE a line of soft toric lenses around 1975-76 that were marked with an indentation by a bur. In 1981, Barnes-Hind offered a soft toric lens marked by a laser.

Bausch & Lomb filed suit, contending that certain laser-marked contact lenses manufactured and sold by Barnes-Hind infringe claims 1, 2, and 7 of the '814 patent. Barnes-Hind denied infringement and counterclaimed that the patent was invalid, void, and unenforceable. The parties narrowed the issue of infringement to whether the marks on the HYDROCURVE lenses are surrounded by a smooth surface of unsublimated polymer material with respect to claims 1 and 2 or a smooth and unaffected surface for claim 7.

#### **4. The District Court Proceedings**

The district court determined that Barnes-Hind "proved by clear and convincing evidence that the patent in suit (4,194,814) and each of its claims is invalid and therefore void." It concluded that the differences between the claims and the prior art would have been obvious, finding that "the fact that the claimed subject matter of the patent in suit was obvious to Mr. Hager is most indicative of the obviousness of the invention," and that "Dr. Brucker's experiments in laser marking contact lenses are further evidence in support of this court's finding of obviousness." The court further concluded that scanning electron microscope (SEM) photographs, showing "that the surface of these lenses surrounding the laser mark are not 'smooth and unsublimated' or 'unaffected' as those terms were defined by plaintiff [appellant] during the processing of the patent in suit," demonstrated lack of infringement in any case. Bausch & Lomb appealed.

#### **Opinion**

The judgment is premised on several legal errors: (1) disregard of the presumption of validity established by 35 U.S.C. § 282; (2) absence of the factual findings on the four inquiries mandated by *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966); and (3) improper claim construction leading to the conclusion of noninfringement. We vacate the court's opinion and remand for a determination consistent with this opinion.

## 1. Presumption of Validity

A patent shall be presumed valid, and each claim shall be presumed valid independently of the validity of other claims. 35 U.S.C. § 282. The burden is on the party asserting invalidity to prove it with facts supported by clear and convincing evidence. *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 872, 228 USPQ 90, 97 (Fed. Cir. 1985); *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984).

The record contains no reference to this statutory presumption of validity, nor does it appear that the district court considered separately the validity of the three claims at issue. By merely holding that "defendants have proved by clear and convincing evidence that the patent in suit (4,194,814) and each of its claims is invalid and therefore void," the district court improperly denied the '814 patent its statutory presumption of validity as to each claim.

The district court thought the examiner had been misled. Barnes-Hind argued and argues here that Bausch & Lomb (or rather its later acquired company Milton Roy) misled the examiner during prosecution. Appellees assert that "if the examiner had been correctly and forthrightly informed of Hager's and McCandless' opinions, the chemistry of the Brucker lens, and the teaching of the Caddell patent, he would not have issued the patent." The record, however, does not support this assertion.

The examiner did know of Hager's temporary refusal to execute the application during prosecution and, as discussed more fully *infra*, a determination of nonobviousness is based, *inter alia*, on the opinion of a hypothetical person of ordinary skill in the art, not on the inventors' opinion. The weight to be attached to Hager's refusal cannot be exaggerated as the court below has done without clear error in view of Hager's self interest as an employee of a competitor and his later change of position. Instances of inventors refusing even to cooperate in obtaining issuance of a patent to be owned by an assignee are common and machinery is provided in 37 C.F.R. § 1.47 to deal with them. Section 1.47 provides that either a joint inventor or a proper assignee may file the application without the consent or signature of the inventor, just so the oath or declaration is accompanied by a petition including proof of pertinent facts. It is clear, therefore, that the PTO does not allow the inventor to erect that type of obstacle to obtaining patent protection. Such forethought is necessary, as otherwise an inventor's changed self interest might nullify a proper assignment. The district court's heavy reliance on Mr. Hager's assertions, if persisted in, would allow a co-inventor another chance at sabotage if the first effort has failed.

Finally, the examiner, who with the deference we owe governmental officials we assume has some expertise in interpreting the refer

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ences and some familiarity with the level of skill in the art, *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359, 220 USPQ 763, 770 (Fed. Cir.), *cert. denied*, \_\_\_ U.S. \_\_\_, 105 S.Ct. 95, 224 USPQ 520 (1984), did have the Brucker and Caddell patents before him. Barnes-Hind's "misleading the examiner" contention is insufficiently supported to overcome the presumption of validity.

As a final matter, we recognize, as the district court did not, that when the prior art before the court is the same as that before the PTO, the burden on the party asserting invalidity is more difficult to meet. *American Hoist*, 725 F.2d at 1359, 220 USPQ at 770.



## 2. *Graham Findings*

Obviousness under 35 U.S.C. § 103 is a question of law based on the underlying factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966): (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) objective evidence of secondary considerations. See, e.g., *Loctite*, 781 F.2d at 872, 228 USPQ at 97-98.

The *Loctite* court further stated:

In patent cases, the need for express *Graham* findings takes on an especially significant role because of an occasional tendency of district courts to depart from the *Graham* test, and from the statutory standard of obviousness that it helps determine, to the tempting but forbidden zone of hindsight. Thus we must be convinced from the opinion that the district court actually applied *Graham* and must be presented with enough express and necessarily implied findings to know the basis of the trial court's opinion.

*Id.*, 228 USPQ at 98.

Here, as in *Loctite* and in *Jones*, we are not convinced that the district court applied the *Graham* findings. Instead, it found Mr. Hager's opinion that the subject matter was obvious "most indicative of the obviousness of the invention." This was legal error.

Unlike the district court, we have the benefit of the very clear exposition of the law in *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 454, 227 USPQ 293, 297-98 (Fed. Cir. 1985):

The issue of obviousness is determined entirely with reference to a *hypothetical* "person having ordinary skill in the art." It is only that hypothetical person who is presumed to be aware of all the pertinent art. The actual inventor's skill is irrelevant to this inquiry, and this is for a very important reason. The statutory emphasis is on a person of *ordinary* skill. Inventors, as a class, according to the concepts underlying the Constitution and the statutes that have created the patent system, possess something -- call it what you will -- which sets them apart from the workers of *ordinary* skill, and one should not go about determining obviousness under § 103 by inquiring into what *patentees* (i.e., inventors) would have known or would likely have done, faced with the revelation of references. [Emphasis in original.]

[1] In this regard then, the district court erred at least three times: it relied too heavily on the alleged opinion of one who was an inventor and patentee, and misused that opinion as a substitute for determining the level of skill of the hypothetical person of ordinary skill and what that person would have been able to do when in possession of the prior art, the scope and contents of which the court should also have determined.

The court also engaged in improper hindsight analysis to conclude the '814 patent would have been obvious. The court essentially adopted Barnes-Hind's argument that "the concept of forming ridgeless depressions having smooth rounded edges using a laser beam to vaporize the material is explicitly disclosed in the Caddell patent. *This is exactly the same process claimed in the patent-in-suit and practiced by the plaintiff.*"

Barnes-Hind selected a single line out of the Caddell specification to support the above assertion: "one way in which this [forming ridgeless depressions] can be achieved is to use a laser with high enough intensity to vaporize the plate material without melting

it." Col. 5, lines 53-54. This statement, however, was improperly taken out of context. As the former Court of Customs and Patent Appeals held:

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.

*In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); *see also In re Mercer*, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778 (CCPA 1975).

A full appreciation of Caddell's statement requires consideration of the immediately following sentences in the same paragraph and the paragraph after that. Viewed in that context, it is apparent that Caddell's ideal printing plate would have no ridges around the depression. The use of a high intensity laser is offered as a possible means to achieve the goal but is limited by several disadvantages. To overcome these disadvantages, Caddell suggests the use of a special class of polymer that forms ridgeless depressions. A complete read

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ing demonstrates quite clearly that Caddell is setting up a strawman and pointing out its disadvantages to highlight the advantages of Caddell's invention, that special class of polymers. The district court improperly viewed an isolated line in Caddell in light of the teaching of the '814 patent to hold for obviousness. This is improper hindsight analysis.

The district court also failed to consider the Caddell reference in its entirety and thereby ignored those portions of the reference that argued against obviousness. *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, \_\_\_ U.S. \_\_\_, 105 S. Ct. 172 (1984). Caddell compared the ridge formation of his special class of polymers against, *inter alia*, Lucite, a copolymer composed of ethyl acrylate with methylmethacrylate -- very similar to the chemical referred to in the '814 patent -- and found that *only* his special class formed depressions without ridges. Thus, Caddell actually taught away from laser etching of soft contact lenses.

As further evidence of obviousness, the district court relied on Dr. Brucker's experiments in laser marking contact lenses. This too was error, in this case clearly erroneous factual error. The record does not support, indeed it contradicts, the supposition that Dr. Brucker had engaged in laser marking of soft contact lenses at the time of the present invention. On page 385 of the Appendix, in reply to Mr. Calimafde's question "when did Continuous Curve begin to experiment with laser marking of soft contact lenses?", Dr. Brucker replied "I believe it was in '79 -- '79, '80, somewhere in that area." The filing date of the '814 patent was November 10, 1977. Brucker's 3,833,786 patent for a method of fenestrating (putting windows in) contact lenses applies according to its claims to such lenses, both soft and hard. However, the record reflects that the need for such fenestration was as a mode of escape for fluid accumulating between the lens and the eye. Such a need does not exist respecting the soft lenses, the principal subject of the claims in suit, of which claim 2 is expressly limited to soft lenses. They, being hydrophilic, absorb the fluid.

In sum, the district court improperly determined the '814 patent was obvious: it failed to make the Graham inquiries, it improperly focused on what was obvious to the inventor,

it engaged in hindsight analysis, and it considered evidence that was not prior art. This court, as an appellate court, may not make the required Graham factual findings, and must therefore remand that determination to the district court. The district court should not ignore the four-part analysis the authorities require.

**a. The scope and content of prior art**

To determine whether a reference is within the scope and content of the prior art, first determine if the reference is within the field of the inventor's endeavor. If it is not, then next consider whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Richard M. Deminski*, 230 USPQ 313, 315, No. 85-2267, slip op. at 9 (Fed. Cir. July 8, 1986); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983). *Orthopedic Equipment Co., Inc. v. United States*, 702 F.2d 1005, 1008-11, 217 USPQ 193, 196-97 (Fed. Cir. 1983) focused on the claims in suit, the art the PTO applied to the claims, and the nature of the problem confronting the inventor. Further, the art must have existed as of the date of invention, presumed to be the filing date of the application until an earlier date is proved.

**b. The differences between the claimed invention and the prior art**

The court must view the claimed invention as a whole. See, e.g., *Jones*, 727 F.2d at 1527-28, 220 USPQ at 1024. We add, as a cautionary note, that the district court appeared to distill the invention down to a "gist" or "core," a superficial mode of analysis that disregards elements of the whole. It disregarded express claim limitations that the product be an ophthalmic lens formed of a transparent, cross-linked polymer and that the laser marks be surrounded by a smooth surface of unsublimated polymer. See also, *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984).

**c. Level of ordinary skill in the art**

In *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 697, 218 USPQ 865, 868-69 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984), the court listed six factors relevant to a determination of the level of ordinary skill: educational level of the inventor, type of problems encountered in the art, prior art solutions, rapidity of innovation, sophistication of technology, and educational level of active workers in the field. As to educational level of the inventor, see *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 227 USPQ 293 (Fed. Cir. 1985); *Orthopedic Equipment Co. v. All Orthopedic Appliances*, 707 F.2d 1376, 1382, 217 USPQ 1281, 1285 (Fed. Cir. 1983) ("Although the educational level of the inventor may be a factor in determining the level of ordinary skill in the art, it is by no means conclusive.")

**d. Objective indicia of obviousness**

Such "secondary considerations," when present, must always be considered. *Stratoflex*, 713 F.2d at 1538, 218 USPQ at 878-79. See also *Cable Electric Products, Inc. v. Genmark*,

*Inc.*, 770 F.2d 1015, 1026-28, 226 USPQ 881, 887-88 (Fed. Cir. 1985). Such evidence includes commercial success, long felt but unresolved needs, and failed attempts. *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 895-96, 221 USPQ 669, 675 (Fed.

Cir.), *cert. denied*, \_\_\_ U.S. \_\_\_, 105 S.Ct. 187, 225 USPQ 792 (1984).

We shall vacate the trial court's opinion and remand for an obviousness determination consistent with this opinion.

### **3. Infringement**

The parties narrowed the infringement issue for trial to the question whether the surface of Barnes-Hind lenses surrounding the laser mark is "smooth and unsublimated" or "unaffected." The district court concluded that "the laser-engraved depressions in the surface of the HYDROCURVE II lenses have been examined by scanning electron microscope. These photographs show that the surface of these lenses surrounding the laser mark are not 'smooth and unsublimated' or 'unaffected' as those terms were defined by plaintiff during the prosecution of the patent in suit." Appellant Bausch & Lomb argues on appeal that the trial court's approach of assessing smoothness at the very high levels of magnification obtainable by a SEM exceeds the level of smoothness required in the claims. We agree.

Because the first step in determining infringement is claim construction, improper claim construction can distort the entire infringement analysis. *Moeller v. Lonetics, Inc.*, 229 USPQ 992, 994, No. 85-2646, slip op. at 7 (Fed. Cir. June 4, 1985). Such a distortion occurred below.

Disputed issues such as the meaning of the term "smooth," should be construed by resort to extrinsic evidence such as the specification, other claims, and the prosecution history. Here, resort to the specification clearly demonstrates that "smooth" meant that "the edges of the craters neither inflame nor irritate the eyelid of the lens wearer \* \* \*." The markings provided on the lens surface in accordance with this invention \* \* \* are not perceived by the lens wearer \* \* \*." The prosecution history supports this construction. A reading of the amendment and its accompanying remarks demonstrates that smooth means the absence of a ridge that "would scratch either the eye or eyelid and would lead to infection." There is no indication that smooth means absolutely ridge-free. (This review of the prosecution history also leads us to disagree with Barnes-Hind's final argument that the prosecution history estops Bausch & Lomb from asserting infringement against the allegedly ridged HYDROCURVE lens.) Testimony from Dr. Mandell, Bausch & Lomb's expert in the field of contact lenses, indicates that to a person of ordinary skill in the art, smooth would mean an absence of "roughness or significant elevation" so that a wearer "would not feel it with the [eye]lid." Further, there is testimony that a person of ordinary skill in the art would use an optical microscope, not an SEM, to gauge the relative smoothness of an etched contact lens.

[2] We hold that smooth means smooth enough to serve the inventor's purposes, *i.e.*, not to inflame or irritate the eyelid of the wearer or be perceived by him at all when in place. Accordingly, we vacate the district court's conclusion that the surface of the HYDROCURVE lenses are not smooth or unaffected, and remand for a determination of infringement based on the proper construction of and proper test for smooth.

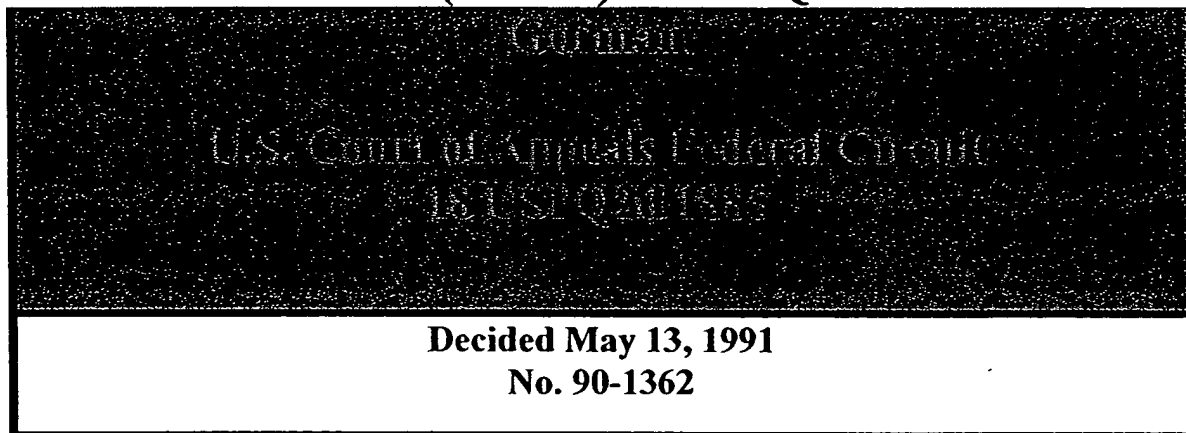
### **Conclusion**

We vacate the district court's determination that the '814 patent is invalid and remand for a reconsideration of validity in light of the presumption of validity and the *Graham* findings on obviousness. We further vacate the decision of noninfringement and remand for proper claim construction and infringement analysis.

### **VACATED AND REMANDED**

**FULL TEXT OF CASES (USPQ2D)**

All Other Cases

**In re Gorman (CA FC) 18 USPQ2d 1885 In re****Headnotes****PATENTS****1. Patentability/Validity - Obviousness - Combining references (§ 115.0905)**

Patent and Trademark Office's reliance on teachings of large number of references in rejecting patent application for obviousness does not, without more, weigh against holding of obviousness on appeal, since criterion is not number of references, but whether references are in fields which are same as or analogous to field of invention, and whether their teachings would, taken as whole, have made invention obvious to person skilled in that field.

**2. Patentability/Validity - Construction of claims (§ 115.03)****Patentability/Validity - Obviousness - In general (§ 115.0901)**

Claim which describes features of invention in great detail is nevertheless obvious in view of prior art, since claim that is narrowly and specifically drawn must still meet requirements of 35 USC 103, and details listed in claim are shown in references and thus do not contribute to unobviousness.

**3. Patentability/Validity - Obviousness - Relevant prior art - Particular inventions (§ 115.0903.03)****Patentability/Validity - Obviousness - Combining references (§ 115.0905)**

Application claim for candy sucker on stick, molded in elastomeric mold in shape of human thumb, is obvious in view of prior art, since all elements of claim, including molded lollipop having chewing gum base plug, with elastomeric mold serving as product wrapper, and candy in shape of human thumb, are shown in prior art references in various subcombinations, used in same manner and for same purpose as in claimed invention.

**Case History and Disposition:**

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**Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.**

**Patent application of Jeffrey B. Gorman and Marilyn Katz, serial no. 06/882,480 (composite food product). From decision of Board of Patent Appeals and Interferences upholding examiner's rejection of all claims in application, applicants appeal. Affirmed.**

**Attorneys:**

**Thomas W. Tolpin, Highland Park, Ill., for appellant.**

**Teddy S. Gron, associate solicitor (Fred E. McKelvey, solicitor, with him on brief), for appellee.**

**Judge:**

**Before Rich, Newman, and Rader, circuit judges.**

**Opinion Text****Opinion By:**

**Newman, J.**

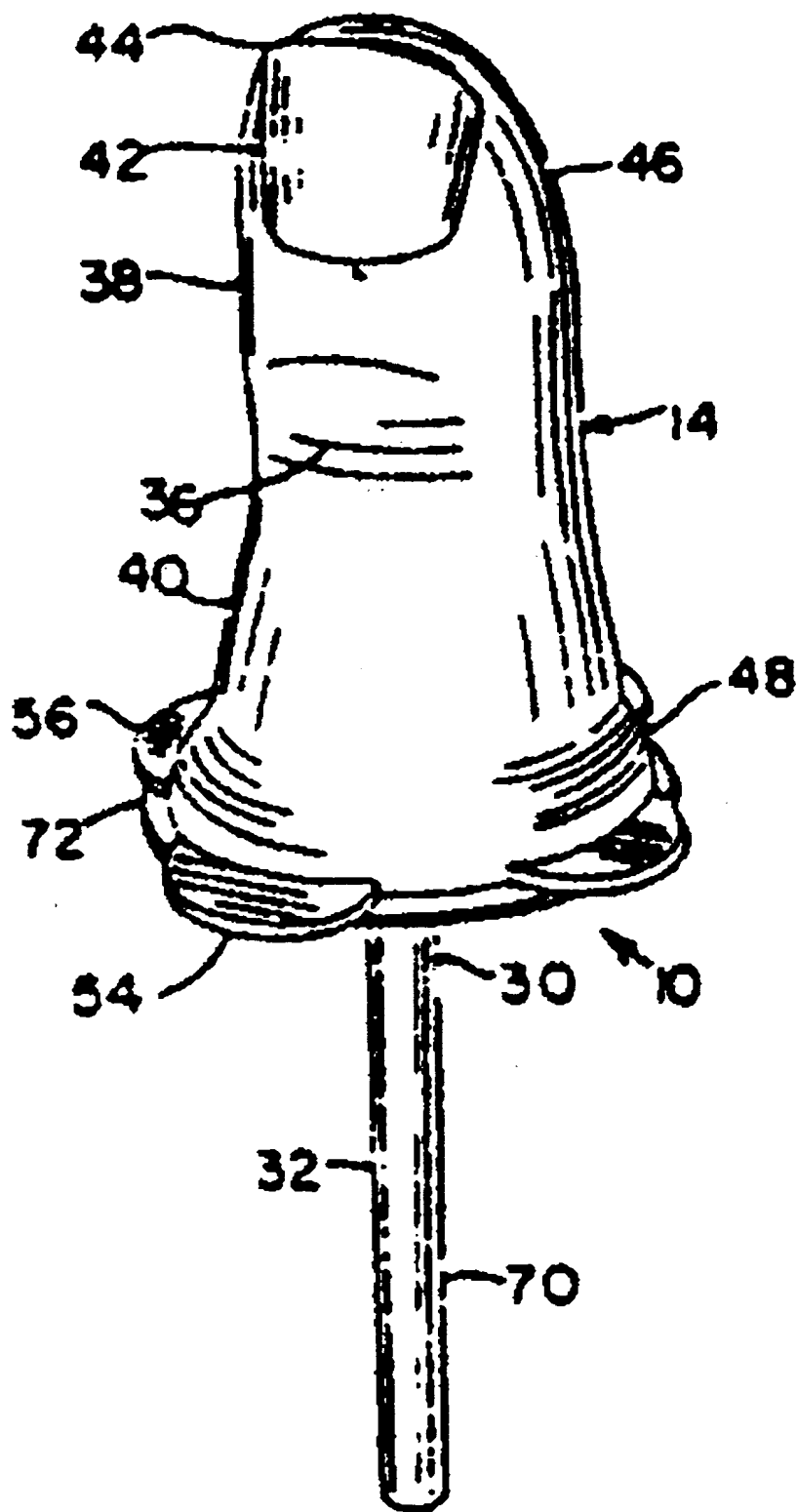
Jeffrey B. Gorman and Marilyn Katz (hereinafter "Gorman") appeal the decision of the United States Patent and Trademark Office, Board of Patent Appeals and Interferences (the "Board") denying patentability to all the claims of Gorman's patent application Serial No. 06/882,480, entitled "Composite Food Product." We affirm.

### ***The Invention***

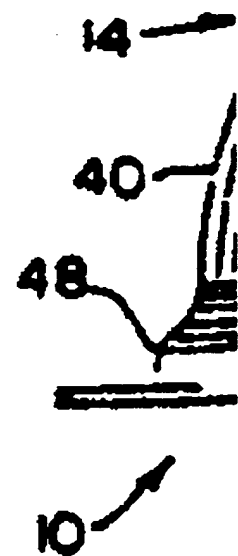
The claimed invention is a composite candy sucker on a stick, molded in an elastomeric mold in the shape of a human thumb. During the manufacturing process liquid candy is poured into the mold, and an edible plug of bubble or chewing gum or chocolate or food-grade wax is poured into the mold after the candy has hardened, serving as a seal for the end portion of the candy. A paper or plastic disc abuts and covers the plug. The mold serves as a cover that can be removed from the candy by means of protruding flanges. The cover is described as a "toy and novelty item".

Figure 1 shows the invention in the form in which it is marketed. Figure 2 shows the cover partially removed to reveal the candy portion (12) and the chewable or edible plug (58):

FIG. 1



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The claims describe the product in detail, as is apparent from claim 16, the claim pressed by Gorman in this appeal:

16. A composite food product, comprising:  
a candy core, said candy core being in a generally liquified form when formulated,

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heated, blended and poured into a mold and in a substantially thumb-shaped hardened form when cooled and removed from said mold;  
said thumb-shaped hardened form comprising said candy core positioned along a vertical axis and comprising a rigid joint-shaped portion, a rigid upper portion extending upwardly from said rigid joint-shaped portion along said vertical axis, and a rigid lower portion extending downwardly from said rigid joint-shaped portion along said vertical axis, said upper portion having a rigid finger nail-shaped portion with an upper rigid tip providing a rigid top end of said thumb-shaped hardened form and a rigid convex back extending rearwardly and downwardly from said rigid tip, and said rigid lower portion having a rigid bottom end and defining a recessed opening comprising a handle-receiving socket about said vertical axis;  
a removable resilient shell comprising a substantially thumb-shaped, elastomeric material selected from the group consisting of rubber and flexible plastic, said shell providing a mold for receiving and molding said liquified candy form,  
a removable outer protective cover positioned about and covering said hardened form comprising said candy core, and  
a toy and novelty item for placement upon the thumb of the user when removed from said hardened form comprising said candy core;  
said thumb-shaped elastomeric material comprising said removable resilient shell comprising a flexible joint-shaped portion, a flexible upper portion extending upwardly from said flexible joint-shaped portion along said vertical axis, and a flexible lower portion extending downwardly from said flexible joint-shaped portion along said vertical axis, said upper portion having a flexible finger nail-shaped portion with an upper flexible tip providing a flexible top end of said shell and a flexible convex back extending rearwardly and downwardly from said flexible tip, and said flexible lower portion having an enlarged open ended diverging base, said base having a larger circumference and transverse cross-sectional area than other portions of said shell and providing the bottom of said shell, said open ended base defining a plug-receiving chamber and an access opening for entrance of said liquified form and discharge of said hardened candy form, and a set of substantially symmetrical arcuate lobes extending radially outwardly from said base, said lobes being circumferentially spaced from each other and providing manually grippable flange portions to facilitate manual removal of said shell from said core;  
a plug positioned in said plug-receiving chamber adjacent said bottom of said shell, said plug abutting against the bottom of said core and providing a cap for substantially plugging and sealing the open end of said mold and cover to help enclose said candy core, and said plug comprising a food grade material selected from the group consisting of bubble gum, chewing gum, chocolate, and food grade wax;  
a handle having a connecting portion connected to said plug and said candy core and positioned in said plug-receiving opening and having a manually grippable handle

portion extending downward from said connecting portion along said vertical axis; and a substantially planar annular disk for abuttingly engaging and removably seating against said base and said lobes adjacent said plug, said disk defining a central axial hole for slidably receiving said handle portion and having an outer edge with a maximum span larger than said access opening but less than the maximum diameter of said symmetrical set of lobes to substantially minimize the interference with manually gripping of said manual grippable flange portions of said lobes, said disk being of a material selected from the group consisting of paper, paperboard, and plastic, and providing a removable closure member and seal for substantially closing said access opening and sealing said plug and said candy core within said shell.

The claims were rejected in view of thirteen references. The primary references, patents to Siciliano, Copeman, and Pooler, show ice cream or candy molded in a plastic, rubber or elastomeric mold. In Siciliano and Copeman the mold also serves as the product wrapper. In Siciliano the ice cream is poured into the mold, a stick is inserted, the ice cream is hardened, and a cardboard cover seals the area between the stick and the elastomeric wrapper. Copeman and Kuhlke show candy lollipops molded in elastomeric molds. Copeman states that the mold may take "varying shapes, such as in the form of fruit, or animals" and Kuhlke discusses the desirability of sealing candy from the outside air. In Siciliano, Copeman and Kuhlke, the mold is peeled from the confection prior to use.

The two Nolte patents teach that gripping flanges may be placed on an ice cream wrap

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per to facilitate removal. Ahern and Knaust each show a disc-shaped seal or cover for a frozen confection. Ahern shows the cover in conjunction with ice cream on a stick. Harris shows a hollow thumb-shaped lollipop into which the thumb is inserted, and Craddock shows a thumb-shaped confection supported on a disc-shaped handle; in both cases without the other elements shown by Gorman. Fulkerson shows a candy coating surrounding a block of ice cream, and a candy plug for retaining liquid syrup inside a cavity in the ice cream. Webster shows chewing gum entirely enclosing a liquid syrup product. Spiegel shows a chocolate layer having an alcohol diffusion barrier to plug the end of a plastic container of liqueur. Fulkerson, Webster and Spiegel all suggest the greater appeal to consumers of providing two different components in the same confection.

The Board found that all of the features of Gorman's product were known to the art, and that various combinations of these elements existed in known similar structures. The Board concluded that the applicant's claimed combination was suggested by and would have been obvious in light of the references.

### ***Discussion***

#### ***A***

Each element of the Gorman claims is in the prior art, separately or in sub-combination. Gorman argues that when it is necessary to combine the teachings of a large number of references in order to support a rejection for obviousness under 35 U.S.C. §103, this of itself weighs against a holding of obviousness.

[1] The criterion, however, is not the number of references, but what they would have

meant to a person of ordinary skill in the field of the invention. In *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987), the court held that a combination of about twenty references that "skirt[ed] all around" the claimed invention did not show obviousness. In other instances, on other facts, we have upheld reliance on a large number of references to show obviousness. Compare *In re Miller*, 159 F.2d 756, 758-58, 72 USPQ 512, 514-15 (CCPA 1947) (rejecting argument that the need for eight references for rejection supported patentability) with *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1149, 219 USPQ 857, 860 (Fed. Cir. 1983) (where teachings relied upon to show obviousness were repeated in a number of references, the conclusion of obviousness was strengthened). See also, e.g., *In re Troiel*, 274 F.2d 944, 947, 124 USPQ 502, 504 (CCPA 1960) (rejecting appellant's argument that combining a large number of references to show obviousness was "farfetched and illogical").

Determination of whether a new combination of known elements would have been obvious to one of ordinary skill depends on various facts, including whether the elements exist in "analogous art", that is, art that is reasonably pertinent to the problem with which the inventor is concerned. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986). When the references are all in the same or analogous fields, knowledge thereof by the hypothetical person of ordinary skill is presumed, *In re Sernaker*, 702 F.2d 989, 994, 217 USPQ 1, 5 (Fed. Cir. 1983), and the test is whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention. See *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990) (quoting *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986)).

The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the applicant's invention. As in all determinations under 35 U.S.C. §103, the decisionmaker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps.

*Interconnect Planning*, 774 F.2d at 1143, 227 USPQ at 551. The references themselves must provide some teaching whereby the applicant's combination would have been obvious.

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## B

Gorman argues that the references showing ice cream in a mold or wrapper on a stick and the references showing candy in a mold or wrapper on a stick are not analogous, for they require different conditions of production. However, the Copeman reference shows the

close relationship of these arts, stating that his elastomeric mold may be used for "frozen confections and other solid confections". We conclude that the ice cream on a stick and candy on a stick arts are analogous, and that the Siciliano, Copeman, Pooler, and Kuhlke references show or suggest Gorman's candy on a stick and covered with an elastomeric mold, for which the thumb-shape is shown by Harris or Craddock.

The suggestion of providing a layer of chewing gum, chocolate or the like, surrounding the candy core in the area not covered by the mold, to seal the candy and provide a second food product, is provided by Fulkerson, Webster, or Spiegel. The paper disc adjacent the base of the candy structure is shown in Ahern and Knaust. Harris and Craddock both show thumb-shaped candy. Gorman argues that the prior art does not suggest using the thumb-shaped cover as a toy after the candy is removed. However, Copeman states that his rubber mold may be used as a "toy balloon" after the candy is removed. Gorman argues that Craddock teaches away from the claimed invention because of Craddock's admonition that lollipops on sticks are dangerous to children. However, candy on a stick is too well known for this caution to contribute to unobviousness.

[2] Claim 16 recites details such as a "joint-shaped portion", a "finger nail portion", an "upper portion", a "lower portion" and a "convex back", as descriptive of the thumb shape. Such details are shown in the references and do not contribute to unobviousness. A claim that is narrowly and specifically drawn must nevertheless meet the requirements of §103:

The mere fact that a claim recites in detail all of the features of an invention (i.e., is a "picture claim") is never, in itself, justification for the allowance of such a claim.

Manual of Patent Examining Procedure, §706 (Rev. 6, Oct. 1987) at p. 700-6; *In re Romito*, 289 F.2d 518, 129 USPQ 359 (CCPA 1961) (rejecting a "picture claim").

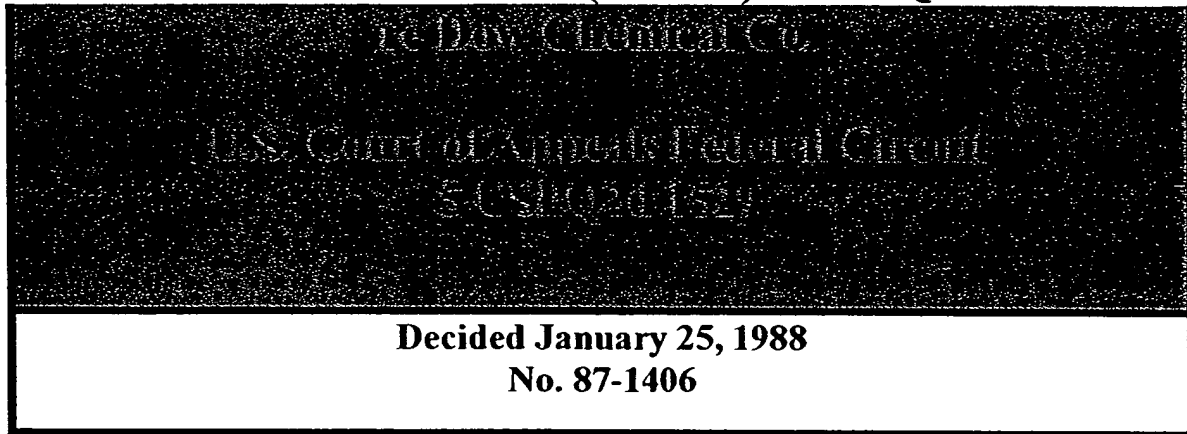
[3] Applying the principles of *Graham v. John Deere & Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), we discern all of the elements of claim 16, used in substantially the same manner, in devices in the same field of endeavor. The various elements Gorman combined: the molded lollipop with a chewing gum plug, with the mold serving as the product wrapper; and candy in the shape of a thumb; are all shown in the cited references in various sub-combinations, used in the same way, for the same purpose as in the claimed invention. The Board did not, as Gorman argues, pick and choose among isolated and inapplicable disclosures in the prior art. Rather, the claim elements appear in the prior art in the same configurations, serving the same functions, to achieve the results suggested in prior art. *In re Sernaker*, 702 F.2d at 994, 217 USPQ at 5. The large number of cited references does not negate the obviousness of the combination, for the prior art uses the various elements for the same purposes as they are used by appellants, making the claimed invention as a whole obvious in terms of 35 U.S.C. §103.

The Board's decision is *AFFIRMED*.

- End of Case -

**FULL TEXT OF CASES (USPQ2D)**

All Other Cases

**In re Dow Chemical Co. (CA FC) 5 USPQ2d 1529 In****Headnotes****PATENTS****1. Patentability/validity -- Obviousness -- Evidence of (§ 115.0903)**

**Patentability/validity -- Obviousness -- Secondary considerations (§ 115.0907)**  
Board of Patent Appeals and Interferences erred in rejecting as obvious claims for invention of impact resistant rubber-based resin suitable for molding and extrusion containing preferred ingredients styrene, maleic anhydride, and synthetic diene rubbers, since none of prior art references cited by patent holder and PTO suggest that any process could be used successfully in such three-component system to produce resin having desired properties, and since board did not give fair evidentiary weight to expert's skepticism concerning invention, or to five to six years necessary to produce invention, in determining obviousness issue.

**Particular Patents -- Chemical -- Rubber Based Resins**  
3,919,354, Moore, Lehrer, Lyons and McKeever, impact resistant polymers of a resinous copolymer of an alkenyl aromatic monomer and unsaturated dicarboxylic anhydride, holding of obviousness reversed.

**Case History and Disposition:**

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**Appeal from the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences.**

**Reexamination of Patent No. 3,919,354, held by The Dow Chemical Company. From decisions rejecting all claims of patent as obvious, patent holder appeals. Reversed.**

**Attorneys:**

**Douglas N. Deline, Midland, Mich. (Berndt W. Sandt with him on the brief) for appellant.**

**John H. Raubitschek, associate solicitor, Arlington, Va. (Joseph F. Nakamura, solicitor, and Fred E. McKelvey, deputy solicitor, with him on the brief) for appellee.**

**Judge:**

**Before Smith, Nies, and Newman, Circuit Judges.**

**Opinion Text****Opinion By:**

**Newman, Circuit Judge.**

Dow Chemical Company appeals the decisions of the United States Patent and Trademark Office Board of Patent Appeals and Interferences, No. 86-3426 (Feb. 25, 1987) and No. 662-81 (Mar. 25, 1986), together rejecting all the claims on reexamination of United States Patent No. 3,919,354 entitled "Impact Resistant Polymers of a Resinous Copolymer of an Alkenyl Aromatic Monomer and an Unsaturated Dicarboxylic Anhydride.". We reverse.

***The Rejection***

The invention is an impact resistant rubber-based resin having improved resistance to heat distortion. Claim 28, the broadest claim on appeal, is illustrative:

28. A polymer suitable for molding and extrusion, of substantially improved resistance to mechanical shock and impact, the polymer consisting essentially of the polymerization product of

a. a monovinyl alkenyl aromatic monomer containing up to 12 carbon atoms and having the alkenyl group attached directly to the benzene nucleus, the al

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kenyl aromatic compound being present in a proportion of from about 65 to 95 parts by weight and from 35 to 5 parts by weight of an unsaturated dicarboxylic acid anhydride readily copolymerizable therewith, and  
b. from 5 to 35 parts by weight of a diene rubber per 100 parts of (a) plus (b), the rubber consisting essentially of 65 to 100 weight percent butadiene, or isoprene and up to 35 weight percent of an alkenyl aromatic hydrocarbon as the sole other monomer in the rubber, the rubber having a glass temperature not higher than 0° C., the rubber being in the form of a plurality of particles having diameters within the range of 0.02 to 30 microns dispersed throughout a matrix of polymer of alkenyl aromatic monomer and the anhydride, at least a major portion of the rubber particles containing distinct occlusions of the polymer of (a), with the further limitation that the polymer of (a) is a nonequimolar random copolymer.

The preferred ingredients are styrene, maleic anhydride, and synthetic diene rubbers, and our discussion will be in these terms, as was the Board's.

The Board's decision that the claimed invention would have been obvious in terms of 35 U.S.C. §103 was based on the combination of two references: a 1966 article by Molau and Keskkula entitled "Heterogeneous Polymer Systems IV. Mechanism of Rubber Particle Formation in Rubber-Modified Vinyl Polymers", and Baer U.S. Patent No. 2,971,939. Also discussed were Farmer U.S. Patent No. 2,275,951 and a publication by Bacon and Farmer entitled "The Interaction of Maleic Anhydride with Rubber", although the Board stated that the rejection was sustainable without relying on either of these references.

### ***The Prior Art***

The Molau/Keskkula article shows the preparation of a resin having high impact strength by dissolving synthetic diene rubber in styrene and polymerizing the styrene. This reference teaches that phase inversion is necessary to the formation of these moldable, extrudable resins. Baer prepares nonequimolar random maleic anhydride-styrene copolymers by a technique whose salient feature is adding the maleic anhydride slowly to polymerizing styrene under controlled conditions.

Farmer shows the reaction among natural rubber, styrene, and maleic anhydride, and also states that maleic anhydride reacts directly with the rubber. The Bacon and Farmer article also shows the reaction of maleic anhydride with natural rubber. These products, according to Dow's evidence and as found by the Board, do not have a dispersed rubber phase containing occlusions, and are not moldable.

Dow argues that the Board has engaged in hindsight reconstruction of the claimed invention. To support its position Dow refers to several scientific publications and other references, in addition to those cited by the PTO, and evidence submitted by declaration and deposition.

The first group of references to which Dow refers shows the reaction of maleic anhydride with natural or synthetic rubbers. These references show both intermolecular and intramolecular reactions between maleic anhydride and the various rubbers, but not a grafted rubber, which is said by Dow to characterize its product. Additional references are cited by Dow to show that maleic anhydride is much more reactive with diene-type synthetic rubbers than with natural rubber, and that the reaction with the synthetic rubbers is difficult to control and the product is unpredictable.

Another reference cited by Dow, the *Encyclopedia of Science and Technology*, states the general rule, derived from experience with acrylonitrile, that copolymers with synthetic diene rubbers have elevated glass transition temperatures; Dow advises that this is a highly undesirable property for a high-impact strength resin.

Another series of references cited by Dow shows several known techniques of reacting styrene and maleic anhydride to prepare nonequimolar copolymers, all different from the technique shown in the Baer patent.

### ***Analysis***

The Board held that the claimed product results from the application of the Baer technique to a styrene-maleic anhydride polymer system which includes synthetic diene rubber, and that it would have been obvious to do that which these inventors did if one wanted to increase the heat stability of a known high impact styrene rubber resin.

The crux of Dow's argument is that no reference shows or suggests that these references should or could be combined successfully. Indeed, the Board agreed, stating that "[i]t is not apparent from the evidence whether rubber and maleic anhydride would have been expected to react *in the process suggested by the combined disclosure of Molau and Baer . . .*" (Emphasis in original).

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Dow also points out, referring to the Keskkula evidence, that it was believed that these products could not be made by the mass polymerization techniques of the prior art. Dow asserts that no reference, including Baer, suggested that the Baer technique could produce the requisite phase inversion in a system containing diene rubber, and could produce a diene-rubber containing resin that could be molded and had the other desired high-impact and thermal properties.

Dow refers to the Farmer patent, cited by the examiner and the Board, which shows that the reaction of styrene, maleic anhydride, and natural rubber forms a product that is unsuitable as a molding resin. Dow argues that Farmer leads away from the Dow invention, in that Farmer obtains precisely the "runaway" reaction, and undesirable product, that Keskkula believed was characteristic of reactions involving styrene, maleic anhydride, and rubbers. Dow points to Dr. Keskkula's Report to Dow management, written in 1966 at about the time the present invention was made, pointing out the many problems in attempting to produce the three-component product that these inventors later succeeded in producing.

In response, the Commissioner argues that even though an expert polymer scientist, Dr. Keskkula, "personally may have been surprised by the invention at the time it was made, it does not necessarily follow that the invention would have been unobvious to one of ordinary skill in the art." The Commissioner suggests that one less encumbered by knowledge of the need for phase inversion, as described in the Molau/Keskkula article, might have achieved the Dow product by combining the references in the way suggested by the Commissioner. Reflecting on this theory of invention, we observe that such a person did not do so, despite the decades of experimentation with these components, and the recognition of need, as evidenced by the many references cited by both sides. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.



Cir. 1984).

The Board held that Dow's statement in the patent specification that it was known that styrene/maleic anhydride copolymers had improved heat resistance as compared with styrene rubbers, made it prima facie obvious to combine these three components. Indeed, the record shows that such combinations had previously been made, in various ways, but without producing the product here desired. That there were other attempts, and various combinations and procedures tried in the past, does not render obvious the later successful one. The PTO's reliance on Dow's "admission" of longfelt need as prima facie evidence of obviousness is contrary to logic as well as law. Recognition of need, and difficulties encountered by those skilled in the field, are classical indicia of unobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966); *Custom Accessories v. Jeffrey-Allan Industries*, 807 F.2d 955, 960, 1 USPQ2d 1196, 1199 (Fed. Cir. 1986). Further, a patent applicant's statement of the purpose of the work is not prior art.

The Board thus concluded that although one would not know in advance whether the Baer technique would work at all in the presence of diene rubber, or produce a moldable high-impact product, if it did succeed it would have been obvious. The Board criticized Keskkula's evidence for not stating whether, after these inventors proposed the procedure here at issue, Keskkula would have expected the maleic anhydride to react preferentially with the diene rubber or with the styrene and to what effect on the impact properties of the product. The PTO argues that unless the prior art is shown to have led one of ordinary skill to expect the Baer technique to fail, the applicant's burden is not met. This is not the criterion. That these inventors eventually succeeded when they and others had failed does not mean that they or their colleagues must have expected each new idea to fail. Most technological advance is the fruit of methodical, persistent investigation, as is recognized in 35 U.S.C. §103 ("Patentability shall not be negated by the manner in which the invention was made").

The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. See *Burlington Industries v. Quigg*, 822 F.2d 1581, 1583, 3 USPQ2d 1436, 1438 (Fed. Cir. 1987); *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1987); *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 1013, 217 USPQ 193, 200 (Fed. Cir. 1983); *In re Rinehart*, 531 F.2d 1048, 1053-54, 189 USPQ 143, 148 (CCPA 1976). Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure.

In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill is charged

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with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention. The Commissioner argues that since the PTO is no longer relying on Farmer or the Bacon and Farmer article, the applicant is creating a "straw man". It is indeed pertinent that these references teach against the present invention. Evidence that supports, rather than negates, patentability must be fairly considered.

[1] The PTO presents, in essence, an "obvious to experiment" standard for obviousness. However, selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure. *Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). Of the many scientific publications cited by both Dow and the PTO, none suggests that any process could be used successfully in this three-component system, to produce this product having the desired properties. The skepticism of an expert, expressed before these inventors proved him wrong, is entitled to fair evidentiary weight, see *In re Piasecki*, 745 F.2d 1468, 1475, 223 USPQ 785, 790 (Fed. Cir. 1984); *In re Zeidler*, 682 F.2d 961, 966, 215 USPQ 490, 494 (CCPA 1982), as are the five to six years of research that preceded the claimed invention. The evidence as a whole does not support the PTO's conclusion that the claimed invention would have been obvious in terms of 35 U.S.C. §103.

**REVERSED**

**- End of Case -**